

any other person from adopting the same name for any other similar publication." And in *Clement v. Maddick* (a), in which case the plaintiffs were the publishers of "Bell's Life," and the defendants the originators of a "Penny Bell's Life," it was said by Stuart, V.-C., that "This is an application in support of the right to property. It has been argued on behalf of the defendants that, unless a fraudulent intention is made out, the plaintiffs are not entitled to an injunction. That is a view of the law to which I cannot accede. Lord Cottenham, in the case of *Millington v. Fox* (b), has declared that where a trade mark has been innocently and even unconsciously made use of to the injury of another, the owner of the trade mark is entitled to the protection of this Court."—"The defendants' whole case appears to rest on the fact that they intended to commit no fraud; that they had no fraudulent intention in adopting the words 'Bell's Life,' and thought that by prefixing the word 'Penny' to the title they had sufficiently warned the public that they were not purchasing the plaintiffs' paper. But the absence of fraudulent intention is no defence against an application to the Court for an injunction by the person whose property has been injured," and where deception is probable, an injunction will be granted (c). In *Walter v.*

(a) 1 Giff. 98.

(b) 3 My. & Cr. 338.

(c) Thus, injunctions were granted in the following cases:—*Edmonds v. Benbow*, Dig. 33 ("The Real John Bull" imitated by "The Old Real John Bull"); *In re The Edinburgh Correspondent Newspaper*, Ct. of Sess. Cas. 1st Ser. I. (new ed.) 407 n. ("The Edinburgh Correspondent," name copied); *Constable & Co v. Brewster*, Ct. of Sess. Cas. 1st Ser. III. 215 (new ed. 152) ("The Edinburgh Philosophical Journal" by "The New Series of the Edinburgh Philosophical Journal"); *Pronett v. Mortimer*, 2 Jur. N. S. 414

("The John Bull and Britannia" by "The True Britannia"); *Ingram v. Stiff*, 5 Jur. N. S. 947 ("The London Journal" by "The London Daily Journal"); *Chance v. Shepard*, Dig. 317 ("The Bedfordshire Express and General Advertiser for the Counties of Cambridge, Hertfordshire, Huntingdonshire, and Middlesex" by "The Bedfordshire Express and General Advertiser for the County"); *Corns v. Griffiths*, W. N. 1873, p. 93 ("The Iron Trade Circular—Ryland's" by "The Iron Trade Circular—edited by Samuel Griffiths"); *Metzler v. Wood*, 8 Ch. D. 606 ("Hemy's Royal Modern Tutor

Emmott (a), however, the Court of Appeal did not take the same view as to the jurisdiction in such cases being founded on property, and Cotton, L. J., said that "the principle upon which the Court has to decide these cases is this: It is not a question of property; it is the question whether what has been done by the defendant is in reason calculated to induce people to take his goods as those of the plaintiff, or, in other words, to pass off his goods, whatever they may be, as the goods of the plaintiff." And Bowen, L. J., said, "The principle which is involved seems to me to be the right of the Court, and the duty of the Court, to prevent damage being done to the business of a person who is lawfully carrying on his business, by acts, conduct, or representations, consisting either of acts or language, which are calculated to deceive the public, and persons who otherwise would deal with the plaintiff." However, even in this case it was not suggested that a fraudulent intention was necessary to enable relief to be given; and if that is so, the question whether property is or is not involved seems of little practical importance.

for the Pianoforte" by "Hemy's New and Revised Edition of Jousse's Royal Standard Pianoforte Tutor"); *Hutchings v. Sheard*, W. N. 1881, p. 20 ("The Violin School, by J. D. Loder" by "J. D. Loder's Celebrated Violin School, edited, revised, and enlarged by T. Westrop"); *Primrose Press Agency v. Knowles*, L. J. N. of C. 1886, p. 43 ("Church and State" in each case); *Reed v. O'Meara*, 21 L. R. Ir. 216 ("The Grocer and Oil Trade Review" imitated by "The Grocer and Wine Merchant and Irish Brewer and Distiller." An injunction was granted to restrain the word "Grocer," into which the plaintiffs' title was commonly abbreviated, from being used as the first and principal part of the defendants' title); *Matsell v. Flanagan*, 2 Abb. Pr. N. S. 459; *R. Cox*, 367 ("The National Police Gazette" by "The

United States Police Gazette"); *Potter v. McPherson*, 28 N. Y. Sup. Ct. 559 ("Payson, Dunton, and Scribner's National System of Penmanship" by "Independent National System of Penmanship"); *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306 ("Beatty's Headline Copy Book" imitated by "Beatty's New and Improved Headline Copy Book"); *Carey v. Goss*, 11 Ont. Rep. 619 ("The Commercial Traveller and Mercantile Journal," commonly abbreviated to "The Commercial Traveller," and "The Traveller," by "The Traveller"). And see *Keene v. Harris*, 17 Ves. 338; *Walter v. Head*, 25 Sol. J. 742, 757 (imitations of "The Times"), and *American Grocer Publishing Association v. Grocer Publishing Co.*, 32 N. Y. Sup. Ct. 598 (imitations of "The American Grocer").

(a) 54 L. J. Ch. 1059.

Even if the theory that there is property in the name of a newspaper is admitted, that right is not invaded without a probability of deception being produced.

But deception must be probable.

While, however, the fact that the defendant has adopted a title calculated to deceive is sufficient to entitle the plaintiff to his remedy, without it being necessary for him to go into the defendant's motives, he must prove the probability of deception, and if he cannot do this he will fail, even though there may be circumstances pointing to a fraudulent intention. Thus, where the proprietors of the "Era," one of the principal writers in which paper used the pseudonym of "Touchstone," sought to restrain the publication of "Touchstone, or the New Era," and alleged certain further resemblances between the two papers, the Court of Appeal rescinded the injunction which had been granted, on the ground that no deception could occur (a). And where the plaintiff sought to restrain the defendant from using the name "Post Office Directory," and it was

(a) *Ledger v. Ray*, Dig. 550. And no injunctions were granted in *Bradbury v. Beeton*, 39 L. J. Ch. 57 ("Punch" and "Punch and Judy"); *Dicks v. Yates*, 18 Ch. D. 76 ("Splendid Misery, or East End and West End, by C. H. Hazlewood," and "Splendid Misery, by the author of Lady Audley's Secret, Vixen, &c."); *Dale v. Smith*, W. N. 1882, p. 145 ("The Plumber and Decorator and Journal of Gas and Sanitary Engineering" and "The Decorator, Plumber, and Gasfitter's Journal"); *Dale v. General Newspaper Co.*, 1 Times L. R. 177 (same as above, and "The Plumbing and Decorating, Sanitary, Water, and Gas Engineering Chronicle"); *Coven v. Hulton*, 46 L. T. N. S. 897 ("The Newcastle Daily Chronicle" and "The Sporting Chronicle and Prophetic Bell"); *Walter v. Emmott*, 54 L. J. Ch. 1059 ("The Mail" and "The Morning Mail." Here the style and price of the two papers were very different); *Jaffray v. Emmott*, V. C. B., July 3rd, 1885 ("The Birmingham

Daily Mail" and "The Morning Mail"); *Borthwick v. The Evening Post, Ltd.*, 37 Ch. D. 449 ("The Morning Post" and "The Evening Post"); *Brett v. Bowles*, L. J. N. of C. 1890, p. 43; affirmed by C. A. April 30th, 1890 ("The Princess' Novelettes" and "The Princess"); *Snowden v. Noah*, Hopk. 347, R. Cox, 1 ("The National Advocate" and "The New York National Advocate"); *Bell v. Locke*, 8 Paige, 75, R. Cox, 11 ("The Democratic Republican New Era" and "The New Era"); *Stephens v. De Conto*, 30 N. Y. Super. Ct. 343, R. Cox, 442 ("La Cronica" and "El Cronista"); *Osgood v. Allen*, 1 Holmes, 185 ("Our Young Folks, an Illustrated Magazine for Boys and Girls," and "Our Young Folks' Illustrated Paper"); *Talbot v. Moore*, 13 N. Y. Sup. Ct. 106 ("The Little Red Book" and "The Red and White Book"); *Dunaway Publishing Co. v. North-West Printing Co.*, 11 Oreg. 322 ("The New North-West" and "The North-West News").

shown that the name had been used by others than the plaintiff, and that the defendant had had the assistance of post office servants, it was held that no injunction could be granted (a). So, where both plaintiff and defendant sold under the name of "Castle Album" albums illustrated with pictures of castles, it was held that the name was descriptive of the thing, and that, even if the name were capable of appropriation at all, no injunction would be granted to protect it, unless it were proved that it was recognised as denoting exclusively the plaintiff's albums (b). Even if the title is not descriptive, and has been taken without alteration by the defendant, no injunction will be granted unless the plaintiff's paper has been long enough on sale to have acquired some reputation under the name (c). And the plaintiff must come with clean hands (d).

Although the title of a periodical publication as a newspaper, magazine, or almanack, most closely resembles a trade mark, on account of its repeated and continued use from time to time upon articles of a certain class, the protection afforded by the Court is extended to the title of any kind of literary production. Thus, the publishers of "The Birthday Scripture Text Book" succeeded in obtaining an injunction against persons who had brought out "The Children's Birthday Text Book," Lord Romilly, M. R., remarking that the defendants were not entitled to publish a work "with such a title, or in such form as to binding or general appearance, as to be a colourable imitation of that of the plaintiffs" (e). And so, where the title of a song was imitated in such a manner as to

Titles of literary works protected generally.

(a) *Kelly v. Byles*, 13 Ch. D. 682.

(b) *Sohove v. Schminoke*, 33 Ch. D. 546.

(c) *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 Ch. D. 139.

(d) *Talbot v. Judges*, 3 Times L. R. 398.

(e) *Maack v. Petter*, L. R. 14 Eq. 431. See *Weldon v. Dicks*, 10 Ch. D. 247. Also *Estes v. Williams*,

22 Bl. C. C. 364; *Estes v. Belford, Clarke & Co.*, 30 U. S. Pat. Gaz. 99; *Estes v. Leslie* (1), 23 Bl. C. C. 476; *ib.* (2), 29 Fed. Rep. 91; *Estes v. Worthington* (3), 24 Bl. C. C. 371; in all of which cases the plaintiffs were the American grantees from the original English publishers of an exclusive right in the publication.

be calculated to induce the public to buy the spurious publication in mistake for the genuine, the continuance of the fraud was restrained (a).

Incidents of title of publication.

The right which exists in the title of a publication is a right of property (b), a chattel interest (c), capable of assignment (d) or bequest (e), passing, in the event of its proprietor's bankruptcy, to his trustee, but incapable of seizure by a sheriff (f), and which, in the event of a dissolution of partnership between joint proprietors, must be sold for the purpose of the proceeds of the sale being included in the assets of the partnership (g).

No copyright in title.

Although the term copyright has been sometimes applied to the right in the title of a publication (h), there "cannot in general be any copyright in the title or name of a book" (i), but copyright and trade mark are things "totally distinct" (k), and registration under the Copyright Acts gives no further right to protection than exists independently of such registration (l).

(a) *Chappell v. Sheard*, 2 K. & J. 117; *Chappell v. Davidson*, *ib.* 123. But in *Isaacs v. Daly*, 39 N. Y. Super. Ct. 511, it was held that no injunction could be granted to restrain the use of the word "Charity" as the name of a play, the word being one of general application, and the use by the defendant *bonâ fide*.

(b) *Clement v. Maddick*, 1 Giff. 98; *Kelly v. Hutton*, L. R. 3 Ch. 708. But this was disputed in *Walter v. Emmott*, 54 L. J. Ch. 1059.

(c) Per Wood, L. J., in *Kelly v. Hutton*, *ubi supra*.

(d) *Longman v. Tripp*, 2 Bos. & P. N. R. 67; *Ex parte Foss*, 2 De G. & J. 230; *Kelly v. Hutton*, L. R. 3 Ch. 708; *Clowes v. Hogg*, W. N. 1870, p. 268; *ib.* 1871, p. 40; *Ward v. Beeton*, L. R. 19 Eq. 207; *Snowden v. Noah*, Hopk. 347; R. Cox, 1.

(e) *Keene v. Harris*, 17 Ves. 338. In *McCormick v. McCubbin*, Ct. Sess. Cas. 1 Ser. I. 541 (New Ed. 496) it was held by the Court of Session that the executors of the proprietor of a half-share in a

newspaper were entitled to proceed to a sale of his share.

(f) *Ex parte Foss*, 2 De G. & J. 230.

(g) *Bradbury v. Dickens*, 27 Beav. 53; *Dayton v. Wilkes*, 17 How. Pr. 510; R. Cox, 224.

(h) *E.g.* per Lord Romilly, M. R., in *Mack v. Petter*, L. R. 14 Eq. 431, per Malins, V.-C., in *Weldon v. Dicks*, 10 Ch. D. 247, per Bacon, V.-C., in *Dicks v. Yates*, 18 Ch. D. 76.

(i) Per James, L. J., in *Dicks v. Yates*, 18 Ch. D. 76. And see *Kelly v. Hutton*, L. R. 3 Ch. 708; *Correspondent Newspaper Co. v. Saunders*, 11 Jur. N. S. 540; *Primrose Press Agency v. Knowles*, L. J. N. of C. 1886, p. 43; *Schoro v. Schmincke*, 33 Ch. D. 546; *Licensed Victualers' Newspaper Co. v. Bingham*, 38 Ch. D. 139; *Osgood v. Allen*, 1 Holmes 185.

(k) Per Jessel, M. R., in *Dicks v. Yates*, 18 Ch. D. 76. In *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306, it was said that the name of a newspaper was not a trade mark.

(l) *Maxwell v. Hogg*, L. B. 2 Ch

Just as a trade mark must, in order to be entitled to protection, be affixed to a vendible article in the market (a), so a title of a publication must be actually used. The mere intention, previous to publication, of using a particular name as the title of a literary work, even if followed by the registration of the proposed title as copyright, the advertisement of the forthcoming work, or the actual preparation of its contents, confers no right to protection, for, "in the case of advertisement, followed by publication, the party publishing has given something to the world, and there is some consideration for the world's giving him a right; but in the case of mere advertisement, he has neither given, nor come under any obligation to give, anything to the world, so that there is a total want of consideration for the right which he claims" (b). So, in one case (c), the defendants had registered their newspaper at Stationers' Hall on December 24th, 1885, but did not publish the first number till January 16th, 1886; while in the meantime the plaintiffs had registered on January 1st, 1886, and begun to sell on January 2nd, 1886, a newspaper under the same name, and it was held that an injunction must be granted for the protection of the plaintiffs, who had been the first to actually use the title. The user must, however, be substantial (d). Where, on the other hand, a book has been once published under a particular title, it seems that the right in the title remains, notwithstanding that the book has been long out of print, and has, in fact, been treated as obsolete (e).

Must be actual user.

307. In the American case of *Jollie v. Jaques*, 1 Bl. C. C. 618, it was, however, held that the right to the title of a work, the copyright of which turned out to be invalid, must fail with the copyright. See *Osgood v. Allen*, 1 Holmes 185; *Isaacs v. Daly*, 39 N. Y. Super. Ct. 511; *Seoville v. Toland*, 6 West. L. J. 84; and *Hirsch v. Jonas*, 3 Ch. D. 584.

(a) Or registered, since the Trade Marks Act of 1875.

(b) Per Turner, L. J., in *Maxwell v. Hogg*, L. R. 2 Ch. 307. And see *Correspondent Newspaper Co. v. Saunders*, 11 Jur. N. S. 540.

(c) *Primrose Press Agency v. Knowles*, L. J. N. of C. 1886, p. 43.

(d) *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 Ch. D. 139.

(e) *Weidon v. Dicks*, 10 Ch. D. 247. Compare *Estes v. Worthington* (3), 24 Bl. C. C. 371.

CHAPTER IX.

GOODWILL.

Value of goodwill.

So early as the time of Lord Hardwicke (a) it was fully recognised that the goodwill of a trade might be of considerable value, and by the beginning of the present century it was said at the bar (b) to be a matter of common experience that contracts for the sale of a goodwill were enforced by actions at law at every sittings.

Connection between goodwill and trade marks.

The connection between goodwill and trade marks is very intimate. Thus, where in a suit for specific performance of a contract for sale of a business (c), one of the subjects of the contract was "goodwill, &c.," Romilly, M. R., said that those words united such things as were necessarily connected with and belonged to the goodwill, many of which were easily pointed out; for instance, the use of trade marks. Such things would be included in the words "et cætera," and would be included in the conveyance. The sale of a business carries with it the goodwill and trade marks (d), and the sale of a business and goodwill

(a) *Giblett v. Read*, 9 Mod. 459.
(b) *Bunn v. Guy*, 4 East, 190.
(c) *Cooper v. Hood*, 26 Beav. 293.
(d) *Shipwright v. Clements*, 19 W. R. 599; *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15-33 (per Lord Blackburn); *Merry v. Hoopes*, 111 N. Y. 415; *Gago v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306. And see *Hall v. Barrows*, 4 De G. J. & S. 150. In *Young v. Jones Bros. & Co.*, 3 Hughes 274, the American Court held the contrary. In *Churton v. Douglas*, Johns. 174, V.-C. Wood went so far as to say that the question of trade mark was in fact the same as the question of firm name, which, it was obvious,

was an important part of the goodwill, and in *Young v. Jones Bros. & Co.*, *ubi supra*, it was said that "rights in the trade mark are analogous to rights in the goodwill of a partnership." See, too, *England v. Curling*, 8 Beav. 129; *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202; *Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 57 Barb. 526, R. Cox, 599; *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321, R. Cox, 559; *Solier v. Johnson*, 111 Mass. 238; *Witt-haus v. Braun*, 44 Md. 303; *Ex parte Young*, Dig. 537; *Fulton v. Sellers*, 4 Brews. 42; *Hazard v. Caswell*, 47 N. Y. Super. Ct. 537.

carries with it the right to the trade name (a), and the words "assets and effects of every kind and nature," in a bill of sale of a business, cover the trade marks used in the business (b). Again, a trade mark cannot exist in gross and apart from the goodwill of the business with which it has been connected (c).

This close connection was fully recognised in the Trade Marks Registration Act, 1875 (d), by the second section of which it was provided that a registered trade mark should be assigned and transmitted only in connection with the goodwill of the business concerned in such particular goods or classes of goods, and should be determinable with such goodwill. By the third section the right of the registered proprietor to the exclusive use of the trade mark was made subject to the provisions in respect of its connection with the goodwill. These provisions are now repeated in §§ 70 and 76 of the Patents Act, 1883 (e).

"Goodwill, I apprehend," said Wood, V.-C., in the important case of *Churton v. Douglas* (f), "must mean every advantage, every positive advantage, if I may so express it, as contrasted with the negative advantage of the late partner not carrying on the business himself, that has been acquired by the old firm in carrying on its business, whether connected with the premises in which the business was previously carried on, or with the name of the late firm, or with any other matter carrying with it

Connection recognised by Registration Act of 1875, and Patents Act, 1883.

What constitutes goodwill.

(a) Per James, L. J., in *Levy v. Walker*, 10 Ch. D. 436. See *Thompson v. Mackinnon*, 2 Steph. Dig. 726.

(b) *Morgan v. Rogers*, 19 Fed. Rep. 596. And see *Russia Cement Co. v. Le Page*, 147 Mass. 206; *Hoxie v. Chaney*, 143 Mass. 592; *Mackinnon v. Thompson*, 5 Can. Leg. News 396.

(c) *Cotton v. Gillard*, 44 L. J. Ch. 90; *In re Wellcome*, 32 Ch. D. 213; *Smith v. Fair*, 14 Ont. Rep. 729; *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321, R. Cox, 559;

Derringer v. Plate, 29 Cal. 292, R. Cox, 324; *Witthaus v. Braun*, 44 Md. 303; *Taylor v. Bemis*, 4 Biss. 406; *Kidd v. Johnson*, 100 U. S. Rep. 617; *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455; *Morgan v. Rogers*, 19 Fed. Rep. 596.

(d) 38 & 39 Vict. c. 91.

(e) 46 & 47 Vict. c. 57.

(f) *Johns*, 174. And see per Hagens, J., in *McGowan Bros. Pump & Machine Co. v. McGowan*, 2 Cine. 313.

the benefit of the business,"—"Very frequently the goodwill of a business or profession, without any interest in land connected with it, is made the subject of sale, though there is nothing tangible in it" (a). And it carries with it the benefit of such matters as a covenant by a servant not to carry on a similar business within prescribed limits (b).

Formerly
treated as
always local.

Previously to the case of *Churton v. Douglas* (c), the language of various eminent judges as to what constituted "goodwill" had rather tended to connect the goodwill with the premises on which the business was carried on, than with the business carried on there, probably because that language, though in general terms, was directed to the circumstances of the case then in course of decision (d). Thus, Lord Eldon, C., in *Cruttwell v. Lye* (e), describes goodwill as "nothing more than the probability that the old customers will resort to the old place" (f). Leach, M. R., describes it (g) as "an advantage attaching to the possession of the house" in which the business had been carried on; and Lord Langdale, M. R. (h), as "the chance or probability that custom will be had at a certain place of business in consequence of the way in which that business has been previously carried on" (d). In *King v. Midland Railway Co.* (i), Giffard, V.-C., gave effect to this view by holding that the assignees in liquidation of a mortgagor, whose business premises were taken by a railway company, were entitled to no part of the purchase

(a) Per Pollock, C. B., in *Potter v. The Commissioners of Inland Revenue*, 10 Ex. 147.

(b) *Jacoby v. Whitmore*, 49 L. T. N. S. 335; *Showell v. Winkup*, 60 L. T. N. S. 389.

(c) Johns, 174.

(d) See *Churton v. Douglas*, *ubi supra*.

(e) 17 Ves. 335.

(f) In this case Sir A. Pigott, in the course of his argument, said that "goodwill" was "the advant-

age belonging to a house long accustomed to carry on a particular trade." See, too, per Plumer, V.-C., in *Harrison v. Gardner*, 2 Madd. 198.

(g) In *Chissum v. Doves*, 5 Russ. 29.

(h) In *England v. Downs*, 6 Beav. 269.

(i) 17 W. R. 113. See *Rutter v. Daniel*, 30 W. R. 724, 801; *Mitchell v. Read* (2), 26 N. Y. Sup. Ct. 418.

money, as having been paid in respect of the goodwill of the business, as against the mortgagee of the premises, whose debt exceeded the purchase money; but that the goodwill was incident to the mortgaged premises and passed with them.

The judgment in *Churton v. Douglas* has now established Not so now. that the dictum of Lord Eldon in *Cruttwell v. Lye* (a) must be read as meaning that goodwill is the probability that the old customers will buy the old goods from the old firm or their successors in business, whether the means of identification be the place of business or otherwise (b). The customers of a large wholesale house cannot be supposed to pay much attention to the exact site of the establishment; and "there may even be a species of goodwill which may be the subject of bargain and sale, although not dependent on the business being carried on in any particular place: for instance, in the case of what are called quack medicines" (c).

While, however, there may be a species of goodwill not intimately connected with a particular spot, in many trades Local connection important. there can hardly be any goodwill apart from the premises on which business has been carried on. Thus, "it is quite plain that the goodwill of a public-house passes with the public-house. In such a case the goodwill is the mere habit of the customers resorting to the house. It is not what is called a personal goodwill" (d). Such a goodwill carries with it the public-house licences, since without them the business cannot be carried on (e). And wherever

(a) 17 Ves. 335.

(b) And compare *Labouchere v. Dawson*, L. R. 13 Eq. 322; *Cooper v. Metropolitan Board of Works*, 25 Ch. D. 472.

(c) Brett, J., in *Llewellyn v. Rutherford*, L. R. 10 C. P. 456. The goodwill of a newspaper is another example. See *Boon v. Moss*, 70 N. Y. 465, and the observations of Lindley, L. J., in his work on Partnership. See, too, *Potter v. The*

Commissioners of Inland Revenue, 10 Ex. 147; *Hurver v. Dannenhoffer*, 82 N. Y. 499; and *Barker v. Connecticut Mutual Life Insurance Co.*, 15 Fed. Rep. 312.

(d) Per Jessel, M. R., in *Ex parte Punnett*; *In re Kitchin*, 16 Ch. D. 226. See *Mitchell v. Read* (2), 26 N. Y. Sup. Ct. 418, and *Mason v. Queen*, 23 Scot. L. Rep. 641.

(e) *Rutter v. Daniel*, 30 W. R. 724, 801.

there is a connection between the goodwill and a particular locality it will be of great consequence; and a house of little value in itself, at a rack-rent, may have a peculiar value attached to it from the fact of a long-established business having been carried on there (a).

Another view
of goodwill.

Looked at from another point of view, the goodwill may be said to be the money value of what has just been described as the goodwill (b).

Goodwill in
learned pro-
fessions.

While the value of most businesses is determined partly by the personal qualifications of the proprietor, partly by those of his subordinates, partly (sometimes principally) by local situation, partly, it may be, by yet other considerations, there is one class of business in which the personal character and ability of the head of the establishment are of paramount and almost exclusive importance. That class comprehends the medical and legal, or "learned" professions.

Division into
personal and
local.

Adverting to this distinction, Sir J. Cross, in *Ex parte Thomas* (c), divided goodwill into personal and local, adding that there might be a goodwill partly personal and partly local (d). But the employment of the word "local" as descriptive of one of the two principal heads under which goodwill falls seems open to objection, on the ground that it tends to produce the misconception exposed and removed by Vice-Chancellor Wood, in *Churton v. Douglas* (e), and to unduly narrow the meaning to be assigned to "goodwill," which, as has been seen, comprehends, not merely the advantage of local situation, but every positive advantage connected with an established trade.

(a) *Parsons v. Hayward*, 31 L. J. Ch. 666; *Llewellyn v. Rutherford*, L. R. 10 O. P. 456. See *Cooper v. Metropolitan Board of Works*, 25 Ch. D. 472, per Cotton, L. J.

(b) *Austen v. Boys*, 2 De G. & J. 626; *Llewellyn v. Rutherford* (Brett, J.), *ubi supra*.

(c) 2 Mont. D. & De G. 204; and

see *Ex parte Punnett*, 16 Ch. D. 226.

(d) This division corresponds to that of trade marks into personal and local, made by Romilly, M. R., in *Hall v. Barrows*, 32 L. J. Ch. 548, which, however, was not indorsed by Lord Westbury, C. See 4 De G. J. & S. 150.

(e) *Johns*. 174.

The two classes of goodwill may more satisfactorily be distinguished, from the classes of pursuit to which they respectively relate, as the goodwill of a profession on the one hand, and that of a trade on the other. It is, indeed, true that the goodwill of a trade, the more usual kind, possesses so many characteristics which that of a profession has not, that the latter has been thought to be hardly entitled to the name of goodwill at all (a), and in *Arundell v. Bell* (b), Jessel, M. R., went so far as to say that "there is nothing analogous to the goodwill in an ordinary trade, which you can sell, in the case of a partnership of living solicitors;" but, on the other hand, there are points of resemblance in which both classes are governed by the same general rule, and there is a convenience in following an established phraseology.

In *Bunn v. Guy* (c), the Lord Chancellor was impressed by the difference between the goodwill of a profession and that of a trade, and caused the opinion of the Court of King's Bench to be taken as to whether a contract by a practising attorney (among other things) to relinquish his business and recommend his clients to two other attorneys, for valuable consideration, and not to practise within certain limits, and to permit them to use his name for a certain time, was good at law, so that the vendor could recover in an action. The answer was that the contract was good in law.

This decision did not long remain uncriticised. In *Bozon v. Farlow* (d), Grant, M. R., refused to grant specific performance of an agreement for the sale of an attorney's business, the terms of the agreement not being sufficiently specified to enable the Court to give the

(a) See *Auston v. Boys*, 2 De G. & J. 626, and *Bain v. Munro*, Ct. Sess. Cas. 4th Ser. V. 416, per Lord Curriehill.

(b) 52 L. J. Ch. 537. And see per Denman, J., in *James v. James* (2), 60 L. T. N. S. 569.

(c) 4 East, 190, in 1803. See the medical cases of *Rawlinson v. Clarke*, 14 M. & W. 187; *Smith v. Smith*, 4 Wend. 468; *Butler v. Burleson*, 16 Vt. 176.

(d) 1 Mer. 459.

Division into goodwill of profession and of trade.

Contract by attorney to transfer goodwill enforced.

Decision doubted.

purchaser the proper return for his money, and he took the opportunity of questioning the propriety of a sale of an attorney's business, which depended so much on the incumbent's own character. And in *Farr v. Pearce* (a), Leach, V.-C., strongly supported the personal character of a profession as contrasted with a commercial business.

Sale of
solicitor's
practice.

Where, however, a solicitor had actually sold his practice for valuable consideration, and undertaken not to practise as a solicitor in Great Britain for twenty years, Lord Langdale, M. R., granted an injunction to restrain him from so practising, and from endeavouring to induce any persons who were the clients of the former and then present firm to cease to employ that firm (b). But an assignment of the goodwill of a solicitor's practice does not carry with it the right to his clients' papers (c).

*Thornbury v.
Bevill.*

In a case (d) which was "not quite a case of dissolution of partnership, but something between a dissolution of the partnership and a purchase of an attorney's business and firm name," Knight-Bruce, V.-C., having refused specific performance of the alleged contract, on the ground of non-acceptance by the plaintiff, said that, "notwithstanding the case of *Bunn v. Guy* (e), from which he did not mean to express dissent, decided as it was by judges of high authority, he was not prepared to say that it was fit that a Court of Equity should enforce an agreement between two solicitors that one on retiring from the business should permit the other to carry on the business in his name. Whether such an agreement were or were not within the strict policy of the law, it might be doubtful whether the Court of Chancery ought to assist it."

Partnership
between
solicitors
dissolved.

But where, on a dissolution by two solicitors of a *bonâ fide* partnership between them, it was agreed that one should carry on the business under the old firm name,

(a) 3 Madd. 74.

(b) *Whittaker v. Howe*, 3 Beav. 383.

(c) Per Denman, J., in *James v. James*, 60 L. T. N. S. 569.

(d) *Thornbury v. Bevill*, 1 Y. & C.

Ch. 554.

(e) 4 East, 190.

paying the other certain annuities, it was held by Wood, V.-C., that the agreement contained nothing illegal or contrary to public policy (a).

Again, on a dissolution of a professional partnership, a retiring partner is not entitled to compensation in respect of his share in the goodwill (b), and a surviving partner may continue the business (c). Rights on dissolution.

In *Spicer v. James* (d), a country attorney having died intestate, his administrator carried on the business until the intestate's son came of age, when he handed over the business to the son. The son becoming insolvent, a bill for an account of profits, and insisting that a sum was due to the intestate's estate in respect of the goodwill, was filed against the administrator by a creditor of the son, but was dismissed by Leach, M. R., on the ground that the goodwill of an attorney's business was not a subject of administration. So, in *Arundell v. Bell* (e), the Court of Appeal decided that the estate of a solicitor, who had retired from a partnership and shortly afterwards died, was not entitled to any allowance in respect of his interest in the goodwill of the business; and Jessel, M. R., said that "as a general rule there is nothing in the nature of a partnership asset to be sold which can fairly be termed goodwill in a ordinary partnership between solicitors." Goodwill of deceased solicitor.

Where, however, the widow of a surgeon-dentist, being one of his executors, sold the goodwill of his business with an introduction to patients, Knight-Bruce, V.-C., held that either the whole, or, at all events, some part of the price paid, belonged to the testator's estate (f). But in the similar Scotch case of *Bain v. Munro* (g), it was held by the Lord Ordinary and Court of Session that the price which was paid was in fact the price of the widow's Estate of professional man interested in proceeds of goodwill.

(a) *Aubin v. Holt*, 2 K. & J. 66.

(b) *Austen v. Boys*, 2 De G. & J. 626; *Farr v. Pearce*, 3 Madd. 74.

(c) *Ib.* And see *Milner v. Reed*, Dig. 328; *Chappell v. Griffith*, 53 L. T. N. S. 459.

(d) Collyer on Partnership, 2nd ed., p. 104.

(e) 52 L. J. Ch. 537.

(f) *Smale v. Graves*, 3 De G. & S. 706.

(g) Ct. Sess. Cas. 4th Ser. V. 416.

recommendation, and that she was entitled to retain it for her own benefit.

Goodwill of professional business.
Recapitulation.

The goodwill of a professional business may, in short, be sold, and a breach of a contract to sell may be a ground for damages, but the authorities are against the enforcement of the specific performance of such a contract, though when the sale is complete, the terms of the sale will be carried into execution. Such a goodwill, in the case of a partnership, survives to the surviving partner, and is not a subject of compensation to an outgoing partner. Special stipulations will, however, be enforced. Such a goodwill will not be considered in the administration of the proprietor's estate unless actually sold; but if that has been done, the price paid or some part of it may be attributed to the estate.

Goodwill of a trade.

"The goodwill of a trade," said Tindal, C. J. (a), "is a subject of value and price. It may be sold (b), bequeathed (c), or become assets in the hands of the personal representatives of a trader" (d). A sale may be conditional (e), and may be effected by a mortgagee (f). Though incapable, by reason of its incorporeal nature, of seizure by a sheriff (g), goodwill is "goods and chattels within the Bankruptcy Acts (h), and may be dealt with by the trustee in bankruptcy just as the bankrupt's other property" (i). It is also "property" within the Stamp Acts (k).

(a) In *Hitchcock v. Coker*, 6 Ad. & E. 438-54.

(b) See *Darby v. Whitaker*, 4 Dr. 139; *Churton v. Douglas*, Johns. 174; *Cooper v. Hood*, 26 Beav. 293; *Hudson v. Osborne*, 39 L. J. Ch. 79; *Shipwright v. Clements*, 19 W. R. 539; *Howe v. Searing*, 10 Abb. Pr. 264; R. Cox, 244.

(c) See *Kecne v. Harris*, 17 Ves. 338; *Robertson v. Quiddington*, 28 Beav. 529.

(d) See *Worrall v. Hand*, Peake 105; *Dakin v. Cope*, 2 Russ. 170; *Chissum v. Dewes*, 5 Russ. 29; *McCormick v. McCubbin*, Ct. Sess. Cas. 1st Ser. I. 541.

(e) *Boon v. Moss*, 70 N. Y. 465.

(f) *Ex parte Punnett; In re Kitohin*, 16 Ch. D. 226.

(g) *Ex parte Foss*, 2 De G. & J. 230; *Holmore v. Smith*, 35 Ch. D. 436.

(h) *Longman v. Tripp*, 2 Bos. & P. N. R. 67; *Ex parte Foss*, *ubi supra*.

(i) See *Hudson v. Osborne*, 39 L. J. Ch. 79; *Hegeman & Co. v. Hegeman*, 8 Daly, 1; *Iowa Seed Co. v. Dorr*, 70 Iowa 481.

(k) *Potter v. The Commissioners of Inland Revenue*, 10 Ex. 147. And see *Morgan v. Perhamus*, 36 Ohio St. 517.

The valuable character of goodwill is not confined to a few trades, but is recognised throughout the commercial world. Thus, among the cases on this subject which have come before the Courts, instances are to be found in which the traders were public-house keepers (a), brewers (b), bankers (c), tailors (d), mercers (e), dyers (f), milliners (g), upholsterers (h), pencil-makers (i), tobacco-brokers (k), snuff-makers (l), paper-makers (m), provision merchants (n), cheesemongers (o), glass-blowers (p), glass-stainers (q), manufacturing chemists (r), commission agents (s), iron-masters (t), carriers (u). The goodwill of a newspaper or magazine, consisting of the right to use the title under which reputation has been acquired by a publication, is another instance of valuable goodwill (x).

“The name of a firm,” says Wood, V.-C., in *Churton v. Douglas* (y), “is a very important part of the goodwill of the business carried on by the firm. A person says, ‘I have always bought good articles at such a house

Universally
valuable.

Firm name
part of good-
will.

(a) *Coslake v. Till*, 1 Russ. 376; *Spratt v. Jeffery*, 10 B. & C. 249; *Ex parte Thomas*, 2 Mont. D. & De G. 294; *Treed v. Mills*, L. R. 1 C. P. 39; *Llewellyn v. Rutherford*, L. R. 10 C. P. 456; *Ex parte Punnett*; *In re Kitchin*, 16 Ch. D. 226.

(b) *Cooper v. Watson*, 3 Doug. 413; *Wade v. Jenkins*, 2 Giff. 509; *Hall v. Hall*, 20 Beav. 139.

(c) *Smith v. Everett*, 27 Beav. 446.

(d) *Newling v. Dobell*, 38 L. J. Ch. 111; *Parsons v. Hayward*, 31 L. J. Ch. 666.

(e) *Morris v. Moss*, 25 L. J. Ch. 194.

(f) *Bryson v. Whitehead*, 1 S. & S. 74.

(g) *Shackle v. Baker*, 14 Ves. 468.

(h) *Chisum v. Deves*, 5 Russ. 29.

(i) *Banks v. Gibson*, 34 Beav. 566.

(k) *Davies v. Hodgson*, 25 Beav. 177.

(l) *Hammond v. Douglas*, 5 Ves. 539.

(m) *Potter v. The Commissioners of Inland Revenue*, 10 Ex. 147.

(n) *Scott v. Mackintosh*, 1 V. & B. 503.

(o) *Hudson v. Osborne*, 39 L. J. Ch. 79.

(p) *Featherstonhaugh v. Fenwick*, 17 Ves. 298.

(q) *Scott v. Rowland*, 20 W. R. 508.

(r) *Turner v. Major*, 3 Giff. 442.

(s) *Macdonald v. Richardson*, 1 Giff. 81.

(t) *Cooper v. Hood*, 26 Beav. 293; *Hall v. Barrows*, 4 De G. J. & S. 150.

(u) *Crutwell v. Lye*, 17 Ves. 335.

(x) *Giblett v. Read*, 9 Mod. 459; *Keens v. Harris*, 17 Ves. 338; *Longman v. Tripp*, 2 Bos. & P. N. R. 67;

Ex parte Foss, 2 De G. & J. 230; *Marshall v. Watson*, 25 Beav. 501;

Bradbury v. Dickens, 27 Beav. 53; *McCormick v. McCubbin*, Ct. Sess.

Cas. 1st Ser. I. 541; *Snowden v. Noah*, Hopk. 347; R. Cox, 1;

Dayton v. Wilkes, 17 How. Pr. 510; R. Cox, 224.

(y) *Johns*. 174.

of business; I know it by that name, and I send to the house of business identified by that name for that purpose.' There are cases every day in this Court with reference to the use of the name of a particular firm, connected generally, no doubt, with the question of trade mark. But the question of trade mark is in fact the same question. The firm stamps its name on the articles. It stamps the name of the firm which is carrying on the business on each article, as a proof that they emanate from the firm; and it becomes the known firm to which applications are made, just as much as when a man enters a shop in a particular locality. And when you are parting with the goodwill of a business, you mean to part with all that good disposition which customers entertain towards the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it. You cannot put it anything short of that. That the name is an important part of the goodwill of a business is obvious, when we consider that there are at this moment large banking firms, and brewing firms, and others, in this metropolis, which do not contain a single member of the individual name exposed in the firm" (a).

Sale of goodwill.

Goodwill is a subject of sale (b), and may fetch a considerable price. There was formerly a doubt whether a contract for the sale of a goodwill would be specifically enforced in Equity (c), but this question was set at rest

(a) And see *Lewis v. Langdon*, 7 Sim. 421; *Banks v. Gibson*, 34 Beav. 566; *Bond v. Milbourn*, 20 W. R. 197; *Scott v. Rowland*, 20 W. R. 508; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Levy v. Walker*, 10 Ch. D. 436; *Beazley v. Soares*, 22 Ch. D. 660; *Gray v. Smith*, 43 Ch. D. 208; *Rogers v. Taintor*, 97 Mass. 291; *Sohier v. Johnson*, 111 Mass. 238; *Peterson v. Humphrey*, 4 Abb. Pr. 394; R. Cox, 212; and *Howe v. Searing*, 10 Abb. Pr. 264; R. Cox, 244.

(b) See, among other cases, *Bunn v. Guy*, 4 East, 190; *Smalo v.*

Graves, 3 De G. & S. 706; *Cooper v. Hood*, 26 Beav. 293; *Bradbury v. Dickens*, 27 Beav. 53; *Churton v. Douglas*, Johns. 174; *Ex parte Punnett*; *In re Kitchin*, 16 Ch. D. 226; *Buckingham v. Waters*, 14 Cal. 246; *Williams v. Wilson*, 4 Sandf. Ch. 379; *Barker v. Connecticut Mutual Life Insurance Co.* 15 Fed. Rep. 312.

(c) *Baxter v. Connolly*, 1 Jac. & W. 580. And see *Coslake v. Till*, 1 Russ. 376; *Bozon v. Farlow*, 1 Mer. 459; *Cassidy v. Motcalf*, 1 Mo. App. 593.

by Kindersley, V.-C., in *Darbey v. Whitaker* (a). "It is said there can be no specific performance of a contract to purchase a goodwill. No doubt you cannot have a specific performance of a contract to purchase a goodwill alone, unconnected with business premises, by reason of the uncertainty of the subject-matter. But when a goodwill is entirely or mainly annexed to the premises, and the contract is for the sale of the premises and goodwill, there is not the slightest ground for doubt that such a contract is a fit matter for a decree in a suit for specific performance." It seems, however, that there may be cases in which a contract for sale of a goodwill would be specifically enforced, the business and goodwill being included together, though there was no such dependence on the business premises (b). Such would be the case with the goodwill of a quack medicine or a newspaper, which is practically independent of locality (c). The connection between the business and the goodwill is such that the sale of the business (d), or of a share in the business (e), as a going concern, carries with it the goodwill, or the corresponding share in the goodwill, even without its being specifically mentioned, and so does the sale of a hotel or public-

(a) 4 Dr. 139. As to the relation between the lease of a trader's premises and the goodwill of his business, see *Dougherty v. Van Nostrand*, Hoff. 68.

(b) Thus, Romilly, M. R., says in *Robertson v. Quidington*, 28 Beav. 529: "Goodwill is never a tangible thing unless it is connected with the business itself, from which it cannot be separated. I never knew a case in which it has been so treated." In *England v. Downs*, 6 Beav. 269, and *Morris v. Moss*, 25 L. J. Ch. 194, the goodwill of a business was held, under the circumstances, to pass with the stock, and not with the premises. And see *Woodward v.*

Lazar, 21 Cal. 448; *R. Cox*, 300. In *Llewellyn v. Rutherford*, L. R. 10 C. P. 456, the price of the goodwill was held to belong to the previous lessee, under the contract between him and the lessor.

(c) See *Bryson v. Whitehead*, 1 S. & S. 74; *Llewellyn v. Rutherford*, L. R. 10 C. P. 456 (per Brett, J.); *Snowden v. Noah*, Hopk. 347; *R. Cox*, 1.

(d) *Shipwright v. Clements*, 19 W. R. 599. And see *Rolt v. Bulmer*, W. N. 1878, p. 119; *Reynolds v. Bullock*, 47 L. J. Ch. 773; *Poon v. Moss*, 70 N. Y. 465.

(e) *Churton v. Douglas*, Job 174.

house (a). And if the goodwill is sold, the trade name goes with it (b).

Rights of
vendor of
goodwill.

After sale
may set up
new business.

As to the rights of the vendor after the sale of his business and goodwill, "it has been settled that there is no implied covenant of any kind" (c), and in the absence of any express restrictive covenant, the vendor is at liberty to set up a business of precisely the same description as that of which he has sold the goodwill, and that next door to the place where his former business was carried on, and to state his connection with that former business (d); but he is not entitled to represent that he is carrying on the same identical business, either by direct representations, or by assuming the trade name under which the business he has sold acquired its reputation, or the trade marks by which its goods have become known in the market (e); nor can he after the sale give a right to others to use the trade marks (f). If the trade name consisted simply of the vendor's own name, the restraint upon his continuing to use that name will have to depend upon the evidence of that user being fraudulent (g), but in the absence of such evidence, the *bonâ fide* use by a man of his own name will not be prohibited (h). But

(a) *Ex parte Punnett; In re Kitchen*, 16 Ch. D. 226.

(b) *Banks v. Gibson*, 34 Beav. 566; *Churton v. Douglas*, *ubi supra*; *Levy v. Walker*, 10 Ch. D. 436; *Gray v. Smith*, 43 Ch. D. 208.

(c) *Hudson v. Osborne*, 39 L. J. Ch. 79. And see *Harrison v. Gardner*, 2 Madd. 198; *Churton v. Douglas*, Johns. 174.

(d) *Clark v. Leach*, 32 Beav. 14; *Hookham v. Pottage*, L. R. 8 Ch. 91; *Shipwright v. Clements*, 19 W. R. 599; *Cassidy v. Metcalf*, 1 Mo. App. 593.

(e) *Shackle v. Baker*, 14 Ves. 468; *Cruttwell v. Lye*, 17 Ves. 335; *Kennedy v. Lee*, 3 Mer. 441-52; *Sedon v. Senate*, 2 V. & B. 220; *Harrison v. Gardner*, 2 Madd. 198; *Churton v. Douglas*, Johns. 174;

Hudson v. Osborne, 39 L. J. Ch. 79; *Labouchere v. Dawson*, L. R. 13 Eq. 322; *Ginesi v. Cooper*, 14 Ch. D. 596; *Leggott v. Barrett*, 15 *ib.* 306; *Walker v. Mottram*, 19 *ib.* 355; *Dawson v. Beeson*, 22 *ib.* 504; *Mossey v. Mason*, 18 Grant Up. Can. Ch. 453; *Peltz v. Eichele*, 62 Mo. 171; *Bergamini v. Bastian*, 35 La. Ann. 60; *Myers v. Kalamazoo Buggy Co.*, 54 Mich. 215; *Hoxie v. Chaney*, 143 Mass. 592; *Frazer v. Frazer Lubricator Co.*, 121 Ill. 147; *Porter v. Mumford & Gorman*, 65 Ga. 11.

(f) *Sohl v. Geisendorf*, 1 Wils. (Ind). 60.

(g) *Churton v. Douglas*, Johns. 174; *Holloway v. Holloway*, 13 Beav. 209.

(h) *Burgess v. Burgess*, 3 De G.

where the trade name in question consisted of the name of the defendant, John Douglas, with the addition "and Co.," it was held that the use of that was an important ingredient in the case, as proving fraudulent intention (a). And so where the name of the firm had been "Benjamin Finch & Co.," and on dissolution B. Finch agreed to carry on business only under his own name, he was restrained from trading as "Benjamin Finch & Co." (b).

The rights of the vendor of a business and goodwill with respect to soliciting his former customers and dealing with them has been the subject of much difference of judicial opinion. In *Labouchere v. Dawson* (c) Lord Romilly, M. R., laid down a stringent rule, saying that when the vendor of a goodwill has established a new firm for the purpose of carrying on a business similar to that which has been sold, "the new firm is entitled to publish any advertisement he pleases in the papers, stating that he is carrying on such business. He is entitled to publish any circulars to all the world to say that he is carrying on such a business; but he is not entitled, either by private letter, or by a visit, or by his traveller or agent, to go to any person who was a customer of the old firm, and solicit him not to continue his business with the old firm, but to transfer it to him, the new firm" (d). And Jessel, M. R., was of opinion that this doctrine should be extended so as to entitle the purchaser of the goodwill of a business to restrain the vendor from having any dealings

Solicitation
of former
customers.

M. & G. 896; *Bond v. Milbourn*, 20 W. R. 197; *Turton v. Turton*, 42 Ch. D. 128.

(a) *Churton v. Douglas*, *ubi supra*, and see *Fullwood v. Fullwood* (1), W. N. 1873, p. 185; *Devlin v. Devlin*, 69 N. Y. 212; *Zimmerman v. Erhard*, 83 N. Y. 74; *Hegeman & Co. v. Hegeman*, 8 Daly, 1. In *Bond v. Milbourn*, 20 W. R. 197 (very shortly reported) it seems that the plaintiff would have been entitled to an injunction at all

events against the use of the words "and Co." by the defendant, if that had been the relief prayed.

(b) *Day v. Finch*, 25 Sol. J. 354.

(c) L. R. 13 Eq. 322. See *Selby v. Anchor Tube Co.*, W. N. 1877, p. 131. Also *Angier v. Webber*, 14 Allen 211; *Dwight v. Hamilton*, 113 Mass. 175; *Munsey v. Butterfield*, 133 Mass. 492.

(d) As to the surrender of a business by A "for the benefit" of B, see *Clark v. Leach*. 32 Beav.

with his former customers, irrespective of whether he had solicited their custom or not (a).

Leggott v. Barrett.

The restrictions thus imposed on the vendor have been gradually removed, until it may now be said that nothing is left of them. The first step in this direction was taken by the Court of Appeal in *Leggott v. Barrett* (b), in which case it was held that the vendor could not be restrained from dealing with his old customers, even where he had solicited a renewal of their custom.

Walker v. Mottram.

The question next arose with reference to the case in which the goodwill has not been voluntarily alienated by the person entitled to it, and the distinction between this case and the case of a voluntary sale was clearly pointed out in *Walker v. Mottram* (c), in which Jessel, M. R., and the Court of Appeal held that a trader, the goodwill of whose business had been sold by his trustees in liquidation, could not be prevented from actually soliciting his former customers. "An assignment of a business and its goodwill, without more, appears to us," said Lush and Lindley, L.JJ., "to pass now just as much as and no more than in the days of Lord Eldon. As against the assignor it confers on the assignee the exclusive right to carry on the business assigned, and, as incidental to this, it also confers on him the exclusive right to represent himself as carrying on that business, and consequently the right, not only to sue the assignor for damages if he has infringed these rights, but also to restrain him from infringing them if he manifests an intention to infringe them. Moreover, to this extent a bankrupt who does not concur in his trustee's assignment is in no better position than a bankrupt who does. Every bankrupt, whether he concurs or not, is bound by every lawful disposition of his property by the trustee, and whatever rights such a

14; and also *Harrison v. Gardner*, 2 Madd. 198; and *Churton v. Douglas, Johns*. 174.

(a) *Ginesi v. Cooper & Co.*, 14 Ch. D. 596.

(b) 15 Ch. D. 306.

(c) 19 Ch. D. 355.

disposition confers on a purchaser must be respected by the bankrupt, whether he joins in the conveyance or not. But, in our opinion, the right of a purchaser of the goodwill of a business from the trustee in bankruptcy does not extend to restrain the bankrupt (even if he joins in the conveyance) from *bonâ fide* commencing a fresh business, and from seeking assistance in it from his old friends and customers. It would, in our opinion be contrary to the policy of the bankruptcy laws to extend *Labouchere v. Dawson* (a) to such a case. It is not necessary to overrule that decision; we leave it where it is, that is to say, it will still be applicable to voluntary sales. But we do not think it ought to be extended to alienations which are compulsory" (b). On this principle it was held by the Court of Appeal in *Dawson v. Beeson* (c) that an expelled partner was entitled to solicit the customers of his old firm.

The final step was taken by Baggallay and Cotton, L. JJ., in *Pearson v. Pearson* (d), in which it was definitely laid down that *Labouchere v. Dawson* (a) was wrongly decided, and that a vendor of a business and goodwill cannot, in the absence of an express restrictive covenant, be restrained from soliciting the old customers of the business. This decision appears to conclude the question, so far as the Supreme Court is concerned (e); but after the great fluctuation of judicial opinion, the express dissent of Lindley, L. J., from the decision, and the forcible arguments of Jessel, M.R., in the opposite direction, it seems too much to say that this point can be regarded as finally settled without a judgment of the House of Lords.

Although there is no implied covenant on the sale of a goodwill, without more, that the vendor will not set up

Vendor
restrained,

(a) L. R. 13 Eq. 322.

(b) See *Helmbold v. Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Hegeman & Co. v. Hegeman*, 8 Daly 1; *Iowa Seed Co. v. Dorr*, 70 Iowa, 481.

(c) 22 Ch. D. 504.

(d) 27 Ch. D. 145.

(e) See *Vernon v. Hallam*, 34 Ch. D. 748. And compare *Bergamini v. Bastian*, 35 La. Ann. 60; *Bassett v. Percival*, 5 Allen 345; *Hoxie v. Chaney*, 143 Mass. 592.

though no
express cove-
nant.

a similar business in the same neighbourhood, yet where a vendor had received in payment for his share of a goodwill a sum calculated by arbitrators upon the understanding (to which he had assented) that he would not carry on business in the same street, it was held to be contrary to Equity that he should carry on business in that street, and he was accordingly enjoined (a).

Express
restrictive
covenant
usual.

In the sale of a business and goodwill, it is customary to insert an express restrictive covenant, which will be binding on the vendor, restraining him from setting up the same trade within a certain limit of time or space, or using his name or allowing it to be used for that purpose (b); and this has become so usual that where (c), in a contract for sale, one of the items was "goodwill, &c.," Romilly, M. R., held that in the "&c." would be included, amongst other things, a covenant by the vendor not to carry on a similar business in Great Britain, for a reasonable time, to be limited in the conveyance, having regard to the nature of such undertakings. Such a covenant may even have the effect of compelling the vendor to quit his trade altogether for the period specified, as was held by Lord Mansfield, C. J., and the Court of King's Bench, in *Cooper v. Watson* (d); and it has been held that a breach of a covenant "not to carry on or be

(a) *Harrison v. Gardner*, 2 Madd. 198. See *Cassidy v. Metcalf*, 1 Mo. App. 593.

(b) *Cooper v. Watson*, 3 Doug. 413; *Bryson v. Whitehead*, 1 S. & S. 74; *Williams v. Williams*, 2 Swanst. 253; *Whittaker v. Howe*, 3 Beav. 383; *Turner v. Evans*, 2 De G. M. & G. 740; *Newling v. Dobell*, 38 L. J. Ch. 111; *Wolmershausen v. O'Connor*, 36 L. T. N. S. 921; *Hawlinson v. Clarke*, 14 M. & W. 187; *Rolfe v. Rolfe*, 15 Sim. 88; *Shipwright v. Clements*, 19 W. R. 599; *Lee v. Ehrhart*, 19 L. T. N. S. 637; *Hagg v. Darley*, 47 L. J. Ch. 567; *Vickery v. Weloh*, 19 Pick. 523; *Smith v. Smith*, 4 Wend. 468;

Sander v. Hoffman, 64 N. Y. 248; *Peltz v. Eichele*, 62 Mo. 171; *Butler v. Burlison*, 16 Vt. 176; *Baumgarten v. Broadway*, 77 N. Car. 8; *Woods v. Sands*, Dig. 467; *Morgan v. Perhamus*, 36 Ohio St. 517; *Williams v. Wilson*, 4 Sandf. Ch. 379; *Gillis v. Hall*, 2 Brews. 342; *R. Cox*, 580; and similarly upon the sale of a trade mark together with the right to manufacture according to a secret recipe: *Filkins v. Blackman*, 13 Bl. C. C. 440.

(c) *Cooper v. Hood*, 26 Beav. 293. See *Jacoby v. Whitmore*, 49 L. T. N. S. 335.

(d) 3 Doug. 413.

concerned or interested in" a certain business, was committed by the vendor entering into the service of a nephew, who carried on the same trade, under the same name, within the proscribed limits (a). Again, a covenant not to carry on a certain business directly or indirectly within the counties of C., A., and M., was broken by soliciting orders on three occasions within C., though the offices of the new business were outside the limits (b). A vendor of a business, who has covenanted not to carry on such a business, will not be allowed to do so under the pretext of acting as a commission merchant (c), and the fact that former customers have requested the vendor to supply them does not prevent his so doing from being a breach of his covenant (d). But where the defendant was shown to have so acted in a few instances only, and with the plaintiff's knowledge and consent, and in fact at his request, it was held that there was no breach (e).

In an American case (f) it was held that a person who had retired from a firm by sale of his interest, and had agreed not to trade in C. under the old firm name, but had nevertheless traded there under the same name, and had solicited former customers of the firm, must pay damages calculated, not upon the total amount of improper solicitation of such customers, but upon the amount of business which could be proved to have been lost through such solicitation.

"Where a man sells the goodwill of a trade, and covenants to make it as profitable as he can, the actual profit made is not that which the vendee is bound to take; but he will have an action of covenant, if he can establish his

Damages in respect of improper solicitation.

Covenant to make profitable.

(a) *Newling v. Dobell*, 38 L. J. Ch. 111. See *Rolfe v. Rolfe*, 15 Sim. 88, and compare *Lee v. Ehrhart*, 19 L. T. N. S. 637, where there was held to be no breach.

(b) *Turner v. Evans*, 2 De G. M. & G. 740. And see *Smith v. Smith*, 4 Wend. 468; *Butler v.*

Burleson, 16 Vt. 176; *Sander v. Hoffman*, 64 N. Y. 248.

(c) *Richardson v. Peacock*, 26 N. J. Eq. 40.

(d) *Sander v. Hoffman*, *ubi sup.*

(e) *Rawlinson v. Clarke*, 14 M. & W. 187.

(f) *Burckhardt v. Burckhardt*, 36 Ohio St. 261.

title to more, through the default of the vendor" (a). But no such covenant will be implied where it is not expressed; thus the sale of the goodwill of a school involves no personal effort on the part of the vendor to influence the attendance of pupils (b). Where a servant has covenanted not to carry on a business similar to his master's within certain limits, the benefit of the covenant passes to a purchaser of the goodwill of the business (c).

Rights of
purchaser of
goodwill.

The purchaser of a business and goodwill is entitled to all the advantages of the reputation and connection of the business as previously conducted, except such benefit as the vendor, on setting up a *bonâ fide* new business, as he is at liberty to do if there is no covenant to the contrary, may derive from the fact of his being known to have belonged to the former business; and the purchaser is entitled to restrain the vendor by injunction from interfering with what he has sold. With respect to the right of the purchaser to continue to trade under the old trade name, it has been thought that, at all events if it consisted in whole or in part of the name of the vendor, injury (d), or at least inconvenience (e), might result to the latter from its continued use by the purchaser, and in *Scott v. Rowland* (f) Wickens, V.-C., granted an injunction to restrain the purchaser of the business of "John Scott & Co." from trading under that name. So in *Thynne v.*

(a) Per Lord Eldon, C., in *Scott v. Mackintosh*, 1 V. & B. 503.

(b) *McCord v. Williams*, 96 Penn. St. 78.

(c) *Jacoby v. Whitmore*, 49 L. T. N. S. 335; *Showell v. Winkup*, 60 L. T. N. S. 389.

(d) Per Wickens, V.-C., in *Scott v. Rowland*, 20 W. R. 508, and Hall, V.-C., in *Levy v. Walker*, 10 Ch. D. 436. See *Chatteris v. Isaacson*, 57 L. T. N. S. 177; *Thynne v. Shore*, 89 L. T. (Journal) 84.

(e) Per Wood, V.-C., in *Churton v. Douglas*, Johns. 174.

(f) 20 W. R. 508. And see *Lewis v. Langdon*, 7 Sim. 421;

Turner v. Major, 3 Giff. 442; *Dence v. Mason*, 41 L. T. N. S. 573; *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202-12; *Howe v. Searing*, 10 Abb. Pr. 264, R. Cox, 244; *Peterson v. Humphrey*, 4 Abb. Pr. 394, R. Cox, 212; *McGowan Bros. Pump and Machine Co. v. McGowan*, 2 Cinc. 313; *Reeves v. Denicke*, 12 Abb. Pr. N. S. 92. In *Tudor v. Tudor*, W. N. 1873, p. 72, and *Probasco v. Bouyon*, 1 Mo. App. 241, there was an express contract. For decisions on the Massachusetts Gen. Stat. c. 56, requiring the concurrence of an ex-partner or his personal representatives in the continued use of his

Shove (a), where the business had been carried on in the name of "A. Thynne." In *Banks v. Gibeon* (b), however, Romilly, M. R., said that the firm name was an asset of the business, and would pass as a trade mark upon a sale of the business and goodwill; and it seems that the question of the purchaser's right to use the name, where it can be done without injury to the vendor, must now be taken to be settled in the affirmative by the decision of the Court of Appeal in *Levy v. Walker* (c), in which Jessel, M. R., and James and Bramwell, L. JJ., denied that any liability could be occasioned to the vendor by the use of his name, and held that the plaintiff (Mrs. Levy), who, while Miss Charbonnel, had traded in partnership with the defendant as "Charbonnel & Walker," was not entitled to restrain the defendant, who had bought the goodwill of the business as a going concern, from continuing to use the old name. James, L. J., said: "It should never be forgotten in these cases that the sole right to restrain anybody from using any name that he likes in the course of any business he chooses to carry on is a right in the nature of a trade mark: that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not—which is intended to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent misstatement, deprive me of the profits of the business which would otherwise come to me.' That is the principle, and the sole principle, on which this Court

name by the continuing or surviving partners, see *Bowman v. Floyd*, 85 Mass. 76; *Rogers v. Taintor*, 97 *ib.* 291; *Morse v. Hall*, 109 *ib.* 409; *Hallett v. Cumston*, 110 *ib.* 29; *Solier v. Johnson*, 111 *ib.* 238. By the New York statute the purchaser of a business and goodwill is not entitled to trade under the old name, but only to describe himself as successor to the old firm. See *Hegeman & Co. v. Hegeman*, 8 Daly, 1.

(a) 89 L. T. (Journal) 84.

(b) 34 Beav. 566.

(c) 10 Ch. D. 436. And see *Webster v. Webster*, 3 Swanst. 490 n.; *Clark v. Leach*, 32 Beav. 14; *Bond v. Milbourn*, 20 W. R. 197; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Coulson & Sons v. Coulson & Co.*, 3 Times L. R. 846; *Tussaud v. Tussaud*, 38 W. R. 440; *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244; *Booth v. Jarrett*, 52 How. Pr. 169; *Woods v. Sands*, Dig. 467; *Mossop v. Mason*, 18 Grant Up. Can. Ch. 453.

interferes. The Court interferes solely for the purpose of protecting the owner of a trade or business from a fraudulent invasion of that business by somebody else. It does not interfere to prevent the world outside from being misled into anything. If there is any misleading, that may be for the Criminal Courts of the country to take notice of, or for the Attorney-General to interfere with; but an individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he has a right to restrain any one else from injuring his business by using that name. . . . But there is another point upon which I myself cannot entertain any doubt: which is this,—that the assignment of the goodwill and business of Charbonnel & Walker did convey the right to use the name of Charbonnel & Walker, and the exclusive right to use that name, as between the vendor and the purchaser of that business. Whether it would prevent another person from afterwards using the name of Charbonnel, I do not say; but the trade name, made up of parts of two real names, as the Master of the Rolls says, the trade name of Charbonnel & Walker (whether it was entirely a fictitious name can make no difference) was the name of the business, and that business was sold. That was a name with which every article sold might have been impressed, just as in the case of *Millington v. Fox* (a), where the name was continued as part of the designation of the article sold. I think it right to say that the sale of the goodwill and business conveyed the right to the use of the partnership name as a description of the articles sold in that trade, and that that right is an exclusive right as against the person who sold it, and an exclusive right as against all the world, so that no other person could represent himself as carrying on the same business.” But where a partner retiring without assigning the goodwill to the continuing partner, the latter cannot continue to use the name of the retiring partner (b).

(a) 3 My. & Cr. 338.

(b) *Gray v. Smith*, 43 Ch. D. 208.

The purchaser of the goodwill is, *à fortiori*, entitled to represent himself as continuing the old business: thus, where the business of John Douglas & Co. was sold, it was held that the purchasers alone had the right to describe themselves as "late John Douglas & Co.," and the vendor was restrained from calling his new firm "John Douglas & Co.," that being an interference with that right (a). But a purchaser has no right to use the name of the business he has bought in such a way as to create confusion in the minds of the public (b); and it is a fraud for a person to purchase the goodwill of a small business in order to gain a right to use a name generally identified with a different and important business (c). In *Warner v. Warner* (d) it was held that not only had the purchaser of the goodwill of a business in proprietary medicines the right to continue to use the old name, but that the change of the name to the purchaser's own name, so as to assimilate it to the name of an old rival business, should be restrained by injunction. And where a business has been carried on under a name somewhat resembling that under which a similar old-established business is carried on, the purchaser of the newer business must not change the name of his business so as to assimilate it to that of the older business (e). The mortgagee of the goodwill of a business, including the right to use the name under which the business is carried on, has no such right in that name as to be able to restrain the use of it by another person, if he has himself never traded under it (f).

Rights of purchaser.

Where, in a purchase of a business and goodwill, it was

Implied contract to keep up business.

(a) *Churton v. Douglas*, Johns. 174. And see *Lewis v. Langdon*, 7 Sim. 421; *McGowan Bros. Pump and Machine Co. v. McGowan*, 2 Cinc. 313; *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244. But see *Howe v. Searing*, 10 Abb. Pr. 264; *R. Cox*, 244; *Reeves v. Denioke*, 12 Abb. Pr. N. S. 92; *Young v. Jones Bros. & Co.*, 3 Hughes, 274.

(b) *Chinn v. Thomas*, 5 Vict. L. R. Eq. 188.

(c) *Perks v. Hall & Co.*, W. N. 1881, p. 111.

(d) 5 Times L. R. 359.

(e) *Holt v. Smith*, 4 Times L. R. 329.

(f) *Beazley v. Soares*, 22 Ch. D. 660.

agreed that the purchaser should pay the vendor at the end of each of the first ten years a certain proportion of the profits, but there was no special agreement by the purchaser to keep up the business, it was held by Erle, C. J., and the Court of Common Pleas, that the purchaser had entered into an implied contract to keep up the business, at all events for the ten years over which the instalments were to extend (a). It seems that while such an implied contract would give a right to damages if broken, it could not be specifically enforced in Equity (b), though carrying on a similar business under a different style could be restrained (c).

Goodwill of mortgaged property.

In some cases questions have been raised with respect to the ownership of the goodwill of a business carried on on mortgaged premises. This has most frequently been when the mortgaged premises have been taken under compulsory powers, so that it has been necessary to decide to whom, or in what proportions, the purchase money was payable. The principle which governs such cases was thus laid down by Cotton, L. J. (d). "Goodwill is a word of which few people understand the meaning. It is obvious that to certain kinds of goodwill a mortgagee will be entitled. The goodwill which attaches to a house increases the value of that house, and therefore the mortgagee is entitled to that. By that I mean, for instance, there is a well-known public-house, and from its position being well known, people go to it; or a well-known shop, from its being situated in a good thoroughfare, people go to it. The goodwill is attaching to the house, and adds to the value of the house. But there may

(a) *McIntyre v. Belcher*, 14 C. B. N. S. 654. Compare *Harrison v. Gardner*, 2 Madd. 198.

(b) *Lewis v. Langdon*, 7 Sim. 421.

(c) *Evans v. Hughes*, 18 Jur. 691. And see *Turner v. Major*, 3 Giff. 442.

(d) *Cooper v. Metropolitan Board*

of Works, 53 L. J. Ch. 109 (this passage is given rather less fully at 25 Ch. D. 479), and see *Chissum v. Dewes*, 5 Russ. 29; *King v. Midland Railway Co.*, 17 W. R. 113; *Pile v. Pile*, 3 Ch. D. 36; *Ex parte Purnett*; *In re Kitchen*, 16 ib. 226.

be other goodwills attaching to the personal reputation which a man has made for himself. That, of course, does not go to the mortgagee, but is a thing personal to the man whose skill and whose name have acquired that goodwill. It does not follow at all that because it is called 'goodwill' the mortgagee will be entitled to it. So far as it is incident to the house, and is connected with the house, and increases the value of the house, it goes as part of the value of the house to the mortgagee."

In a case of partnership, the goodwill of a business, newspaper, &c., including the firm name, is partnership assets, and, on a sale of the partnership business, must be sold with it, for the benefit of the partners or their creditors (a), and a receiver may be appointed until the sale (b).

Goodwill is partnership assets.

On a dissolution of partnership the business and goodwill may be disposed of in three different ways: by sale, for the benefit of the partners or their creditors; by the whole concern, including the trade name, being taken by one partner at a valuation; or by a simple division of the tangible assets of the partnership, in which case each is at liberty to use the trade name just as the partnership did previously (c), or at all events to state his connection with the old firm (d). But where a partnership was entered into for a certain term, an injunction was granted to restrain one of the partners from carrying on business with others under the old partnership name, the partnership term not having expired (e).

Disposal on dissolution.

(a) *Bradbury v. Dickens*, 27 Beav. 53; *Banks v. Gibson*, 34 Beav. 566; *Hall v. Barrows*, 4 De G. J. & S. 150; *McCormick v. McCubbin*, 1 Ct. Sess. Cas. 1st ser. I. 541; *Dayton v. Wilkes*, 17 How. Pr. 510; R. Cox, 224.

(b) *Marten v. Van Schaick*, 4 Paige, 479; *Williams v. Wilson*, 4 Sandf. Ch. 379.

(c) *Banks v. Gibson*, 34 Beav. 566; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Levy v. Walker*, 10 Ch. D. 436; *Fenton v. Levy*, 29 Sol.

J. 735; *Chappell v. Griffith*, 53 L. T. N. S. 459; *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2) 51 How. Pr. 455; *Myers v. Kalamazoo Buggy Co.*, 54 Mich. 215; *Smith v. Imus*, 32 Alb. L. J. 455.

(d) *Clark v. Leach*, 32 Beav. 14; *Hookham v. Pottage*, L. R. 8 Ch. 91; *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202; *Peterson v. Humphrey*, 4 Abb. Pr. 394; R. Cox, 212. See *Matthews v. Hodgson*, 2 Times L. R. 899.

(e) *England v. Curling*, 8 Beav. 127.

Compensation governed by articles.

On a dissolution of a partnership governed by articles, the retiring partner will not be entitled to compensation for his share in the goodwill, except in accordance with the articles (a). Thus, in a case where provision was not made for such compensation, it was held that the premises on which the business had been carried on for many years, and which the continuing partner was entitled on dissolution to take at a valuation, were to be valued without regard to the fact of previous occupation, as, if that were taken into account, it would have the effect of making the partner in question pay for the goodwill (b).

What terms include goodwill.

But for a retiring partner to be entitled to compensation for his share in the goodwill, it is not necessary for the word "goodwill" to be mentioned in the article governing the distribution of the partnership property. In *Hall v. Hall* (c), indeed, it was held that a provision in the articles for the valuation, on the determination of the partnership, of the "property, credits and effects," and "the stock in trade and effects," did not include the goodwill; and so in *Dickson v. McMaster & Co.* (d), with respect to the term "stock in trade, goods, chattels and effects." But those cases must be taken to be overruled by the cases in which the terms "stock belonging to the partnership" (e), "property and effects" (f), and "effects and things" (g), have been held to include goodwill.

Steuart v. Gladstone.

Where, however, the partnership articles of a firm of commission merchants provided that a retiring partner

(a) *Hall v. Hall*, 20 Beav. 139; *Kennedy v. Lee*, 3 Mer. 441-52; *Farr v. Pearce*, 3 Madd. 74; *Steuart v. Gladstone*, 10 Ch. D. 626.

(b) *Burfield v. Rouch*, 31 Beav. 241. But see *Dougherty v. Van Nostrand*, Hoff. 68.

(c) 20 Beav. 139.

(d) 18 Ir. Jur. 202.

(e) *Hall v. Barrows*, 4 De G. J. & S. 150.

(f) *Reynolds v. Bullock*, 47 L. J. Ch. 773.

(g) *Barrow v. Barrow*, 27 L. T. N. S. 431; *Rolt v. Bulmer*, W. N. 1878, p. 119; and see *Shipwright v. Clements*, 19 W. R. 599. Where the interest of a deceased partner is purchased by the surviving partner at a valuation, under the Ohio statute, the value of the goodwill must be included. *Rammelsberg v. Mitchell*, 29 Ohio St. 22.

should receive the share in the partnership property to which he was entitled upon the basis of annual accounts taken, under another article, of the partnership "estate and effects," provision being made thereby for a fair valuation and appraisal of all the particulars included in such accounts, which might be in their nature susceptible of valuation, but no mention being made of the goodwill of the business, it was held by the Court of Appeal that, the share of partners in the goodwill of a commission business not being ordinarily estimated in calculating their annual shares of profits, and that not having been the practice in the case before them, the goodwill could not be taken into account and valued as being included in the partnership "estate and effects" (a).

On the other hand, where the articles of partnership provided that the goodwill should belong to the partners in the proportion of their shares in the business, but should not be taken into account in the accounts of the partnership, and that on the determination of the partnership a general account and valuation of the property and effects of the partnership should be taken, the partnership being dissolved by the death of one of the partners, it was held by Stuart, V.-C., that the goodwill must be included in the valuation of the partnership property (b).

In *Featherstonhaugh v. Fenwick* (c), it was decided that on a dissolution of a partnership, not provided for by articles, one partner could not secure to himself the whole benefit of the goodwill by claiming to take the share of the other at a valuation, or requiring him to remove his proportion from the premises, or clandestinely obtaining a renewal to himself of the lease of the premises occupied by the partnership; but where the goodwill goes with the premises, it has been held in America that the partners

Goodwill included in valuation.

One partner cannot monopolise goodwill, when no articles.

(a) *Stewart v. Gladstone*, 10 Ch. D., 626.

(b) *Wade v. Jenkins*, 2 Giff. 509.

(c) 17 Ves. 298; and so in *Mit-*

shell v. Read (1), 61 N. Y. 128. As to a trade mark, see *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54.

who quit the premises have no claim in respect of goodwill against a partner who remains on the premises (a); and where, under a power contained in the articles, a majority of the partners in a firm expelled another partner, it was decided that in the valuation of the amount to which he was entitled, the value of the goodwill could not be taken into account (b).

Estate of dead partner shares in partnership profits until settlement.

If, after a dissolution of partnership by the death of a partner, "the surviving partners think proper to make that which is in Equity the joint property of the deceased and them the foundation and plant of increased profit, if they do not think proper to settle with the executors and put an end to the concern, they must be understood to proceed upon the principle which regulated the property before the death of their partner" (c); that is to say, capital belonging to the estate of the deceased partner having been risked, such a proportion of the total profits as are attributable to that capital will belong to that estate.

Subject to circumstances.

But in the computation of what profits are attributable to that capital a variety of circumstances have to be taken into consideration: thus, "the nature of the trade, the manner of carrying it on, the capital employed, the state of the account between the partnership and the deceased partner at the time of his death, the conduct of parties after his death, all of which may materially affect the rights of the parties" (d).

Similarly with goodwill.

In the same manner, on the death of a partner, the

(a) *Musselman and Clarkson's Appeal*, 62 Penn. St. 81.

(b) *Stewart v. Gladstone*, 10 Ch. D. 626.

(c) Per Lord Eldon, C., in *Crawshay v. Collins*, 15 Ves. 227. And see *Featherstonhaugh v. Fenwick*, 17 Ves. 298; *Heathcote v. Hulme*, 1 Jac. & W. 122; *Brown v. De Tastet*, Jac. 284; *Cook v. Collingridge*, Jac. 607; *Macdonald v.*

Richardson, 1 Giff. 81; and *Parsons v. Hayward*, 31 L. J. Ch. 666.

(d) Per Wigram, V.-C., in *Willett v. Blanford*, 1 Hare, 253. And see *Simpson v. Chapman*, 4 De G. M. & G. 154, where these remarks were highly approved by Turner, L. J., and it was held that, under the circumstances of the case, nothing was due to the estate of the deceased partner.

goodwill ought, if there is no provision regulating its destination in such an event, to be sold for the benefit of the partnership, and if that is not done, the continuing partners will have to account to the estate of the deceased partner for his share in the goodwill.

There is, indeed, a distinct decision (a) by Lord Loughborough, C., that upon a dissolution of a partnership without articles the goodwill survives to the surviving partner. This position was, however, doubted by Lord Eldon, C., in *Crawshay v. Collins* (b); and it is now thoroughly established that the goodwill is partnership assets. "The goodwill of a trade, although inseparable from the business, is an appreciable part of the assets of a concern, both in fact and in the estimation of a Court of Equity. Accordingly, in reported cases, Lord Eldon held that a share of it properly and as of right belonged to the estate of the deceased partner. It does not survive to the remaining partners, unless by express agreement; but it may by agreement, as it may be agreed that any particular portion of the partnership assets shall so survive. Goodwill manifestly forms a portion of the subject-matter which produces profits, which constitutes partnership property, and which is to be divided between the surviving partners and the estate of the deceased partner, according to the terms of the contract, and when that is silent, according to their shares in the concern" (c). The share of the deceased partner in the concern is not, however, the sole guide to the interest of his estate in the goodwill. The various circumstances alluded to by Wigram, V.-C., in *Willett v. Blanford* (d) must be

Goodwill does not survive.

(a) *Hammond v. Douglas*, 5 Ves. 539. And see *Lewis v. Langdon*, 7 Sim. 421; *Robertson v. Quidington*, 28 Beav. 529; *Young v. Jones Brothers & Co.*, 3 Hughes, 274.

(b) 15 Ves. 227.

(c) Per Romilly, M. R., in *Wedderburn v. Wedderburn*, 22 Beav. 84. And see *Macdonald v.*

Richardson, 1 Giff. 81; *Bradbury v. Dickens*, 27 Beav. 53; *Smith v. Everett*, 27 Beav. 446; *Hall v. Barrows*, 4 De G. J. & S. 150; *McCormick v. McCubbin*, Ct. Sess. Cas. 1st ser. I. 541; *Dougherty v. Van Nostrand*, Hoff. 68; *Dayton v. Wilkes*, 17 How. Pr. 510; *R. Cox*, 221. (d) 1 Hare, 253.

considered. Thus, where at the time of the death of one of two partners the partnership was insolvent, and the deceased partner indebted to the partnership, and the surviving partner subsequently carried on the business with such energy and success that he was able at a later period to sell the goodwill for £1700, it was held by Jessel, M. R., that the surviving partner was only liable to account to the estate of his deceased partner for the value of a moiety of the goodwill at the time of the latter's death (a).

Firm name.

With respect to the trade name, Shadwell, V.-C., in *Lewis v. Langdon* (b), expressed an opinion that it survived, but the decision in that case only amounted to this: that one of three executors of a deceased partner in the firm of "Brookman & Langdon" had no right to set up in business as "Brookman & Langdon," and that the surviving partner, who was carrying on business as "James Lewis & Co., successors to Brookman & Langdon," had sufficient interest in the name of the old firm to restrain an unauthorised use of it (c); and it seems that one member of a firm cannot, on the death of his partner, monopolise all the benefit to be derived from the use of the firm name (d), although, if he purchases the interest of his deceased partner from the latter's executors, he will be entitled to the exclusive use of the old firm name (e).

Firm continued by certain partners.

When, on a dissolution of partnership, the goodwill of the business becomes the property of some of the former partners, with it they acquire the right of representing

(a) *Broughton v. Broughton*, 44 L. J. Ch. 526. And compare *Simpson v. Chapman*, 4 De G. M. & G. 154.

(b) 7 Sim. 421. See *Milner v. Reed*, Dig. 328.

(c) In this respect, *Hine v. Lart*, 10 Jur. 106, and *Dent v. Turpin*, 2 J. & H. 139, seem to be in point, as in those cases the plaintiff had a

certain right, but not an exclusive right, in the trade marks. See *Scott v. Scott*, 16 L. T. N. S. 143.

(d) A decided opinion to this effect is expressed in Lindley on Partnership. And see *Fenn v. Bolles*, 7 Abb. Pr. 202.

(e) *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244.

their remodelled business as being the continuation of the old one; and they are at liberty to express this by styling themselves "B. & C., late A. and B.," or "B. & C., successors to A. & B.," or by using any similar words (a). If they continue to use the style of the old business, "A. & B.," as before, then, as regards the partner by whose retirement or death the dissolution has been brought about, it does not appear that he or his estate will be exposed to loss or inconvenience, or that he or his representatives have any ground for complaint (b); and, as regards the public, it seems that the use of the old name does not, as a rule, constitute any false representation, the only statement being that the new firm is carrying on the business of the old one (c). Such continued user, however, will not be permitted when it can be only for an improper and fraudulent purpose, and in order to deceive the public (d); nor where the partnership has been only contrived with a view to giving the purchaser of a professional business the means of appropriating to himself the personal reputation of the vendor (e).

When a partner has retired from a business, his share and interest therein being taken over by the continuing partners, or when, on the death of a partner, the partnership business has been sold, the retiring or surviving partner, as the case may be, has full liberty to set up a precisely similar business to that which the partnership carried on, but he must not represent it to be the same

Rights on dissolution by retirement or by death and sale of goodwill.

(a) *Churton v. Douglas*, Johns. 174; *Lewis v. Langdon*, 7 Sim. 421; *Hookham v. Pottage*, L. R. 8 Ch. 91; *Peterson v. Humphrey*, 4 Abb. Pr. 394; *R. Cox*, 212; *McGowan Brothers' Pump & Machine Co. v. McGowan*, 2 Cinc. 313; *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244; *Young v. Jones Brothers & Co.*, 3 Hughes, 274. But see *Reeres v. Denicke*, 12 Abb. Pr. N. S. 92.

(b) See *Levy v. Walker*, 10 Ch. D. 436, and cases at p. 345-6, *supra*.

(c) *Banks v. Gibson*, 34 Beav. 566; *Aubin v. Holt*, 2 K. & J. 56. And see *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244; *Probasco v. Bouyon*, 1 Mo. App. 241; *Oakes v. Tonsmierre*, 4 Woods, 547.

(d) *Denco v. Mason*, Dig. 534; 41 L. T. N. S. 573.

(e) *Thornbury v. Beville*, 1 Y. & C. Ch. 554. And see *Oakes v. Tonsmierre*, 4 Woods, 547.

business (a). To use the language of Fry, J., in *Mogford v. Courtenay* (b) "the rights of a late partner who has no interest in the goodwill of the old business, to carry on trade are somewhat refined. They amount shortly to this—that he may carry on a similar trade or similar business; he cannot carry on the identical business. He is at liberty to do everything which flows from the right to carry on a similar business; he is prohibited or liable to be restrained from doing anything which conduces to his carrying on the identical business; but what acts come within either of those classes is a question of very considerable nicety." To this extent the rights of an expelled partner are the same as if he had retired voluntarily (c). In the valuation, therefore, of the share of a retiring or dead partner, which is to be taken over by the surviving partner, this fact should be taken into consideration, as it may materially affect and even destroy the value of the share (d); and when the business is to be sold, that fact should be stated in the particulars of sale, in order that the purchaser may be able to buy with a full knowledge of the facts (e). In *Smith v. Everett* (f), the survivor of two partners in a banking business sold the business, and it was held that the estate of the deceased partner was entitled to a share of so much of the purchase money as was attributable to the goodwill. Romilly, M. R., directed that this value should be ascertained, regard being had to the facts that: 1st, the partnership premises belonged to the survivor;

(a) *Kennedy v. Lee*, 3 Mer. 441-52; *Harrison v. Gardner*, 2 Madd. 198; *Churton v. Douglas*, Johns. 174; *Hall v. Barrons*, 4 De G. J. & S. 150; *Clark v. Leach*, 32 Beav. 14; *Bond v. Milbourn*, 20 W. R. 197; *Hookham v. Pottage*, L. R. 8 Ch. 91; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191; *Wolmershausen v. O'Connor*, 36 L. T. N. S. 921; *Leggott v. Barrett*, 15 Ch. D. 306; *Rammelsberg v. Mitchell*, 29 Ohio St. 22; *Cottrell v. Babcock Printing*

Press Manufacturing Co., 35 Alb. L. J. 129.

(b) 45 L. T. N. S. 303.

(c) *Dawson v. Beeson*, 22 Ch. D. 504.

(d) *Mellersh v. Keen*, 28 Beav. 453; *Davies v. Hodgson*, 25 Beav. 177; *Rammelsberg v. Mitchell*, *ubi supra*.

(e) *Cook v. Collingridge*, Jac. 607; *Hall v. Barrons*, 4 De G. J. & S. 150. And see the form settled by the L.J.J. in *Johnson v. Helleley*, 2 De G. J. & S. 446.

(f) 27 Beav. 446.

2ndly, the survivor had the right to carry on the business of a banker on the same premises after the sale of the goodwill; 3rdly, the sole right of issuing bank notes survived to him.

Unless he has specially contracted not to do so (a), a retiring or surviving partner may advertise generally the facts that he was connected with the former business, and that he is establishing a new business, and is not debarred from soliciting the customers of his former firm (b), and he may style himself "formerly" or "late" of the firm, and, if he occupies the premises formerly occupied by the firm, may state that they were so occupied; but he may not describe himself as "successor to" the old firm.

Retiring or surviving partner may state former connection.

A retiring partner may advertise the discontinuance of his participation in a periodical issued by the partnership, but he is not at liberty to advertise its discontinuance generally, any more than he might represent the partnership to have ceased to carry on business, upon his own retirement (c). And where an ex-partner knowingly allowed his former firm to continue to use his name, it was held that he was estopped from denying his partnership as against a person who had acted in the belief that he was still a partner (d).

And the termination of that connection.

While, however, a retiring partner is not at liberty to depreciate the property, his share in which has passed to others (e), a partner who has bought the share of his partner may, even before the purchase is in all respects

Necessary announcements may be made.

(a) *Wolmershausen v. O'Connor*, 36 L. T. N. S. 921.

(b) *Pearson v. Pearson*, 27 Ch. D. 145; *Vernon v. Hallam*, 34 Ch. D. 748. See *Bradbury v. Dickens*, 27 Beav. 53; *Clark v. Leach*, 32 Beav. 14; *Labouchere v. Dawson*, L. R. 13 Eq. 322; *Graveley v. Winchester*, Seton, 4th ed., 257; *Burrows v. Foster*, 1 N. R. 156; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191; *Leggott v. Barrett*, 15 Ch. D. 306; *Walker v. Mottram*, 19 *ib.* 355; *Dawson v. Beeson*, 22 *ib.* 504;

Morgan v. Schuyler, 79 N. Y. 490.

(c) *Bradbury v. Dickens*, 27 Beav. 53. In *England v. Curling*, 8 Beav. 129, an injunction was granted to restrain a partner from publishing notices of the dissolution of the partnership during the term for which it was to subsist.

(d) *Richards v. Hunt*, 65 Ga. 342. So in *Backus v. Taylor*, 84 Ind. 503.

(e) *Bradbury v. Dickens*, *ubi supra*.

completed, publish statements which are necessary to induce others to join him, and to enable him to carry on the business, though, in the opinion of the selling partner, that may have a prejudicial effect on what is still in a sense the partnership property (a).

Business carried on in separate districts.

Where two partners, having been in the habit of carrying on the partnership business, each in a separate district, agreed to dissolve partnership, the premises, stock, and goodwill to be sold, or until sale to vest in a receiver, Stuart, V.-C., restrained one partner from carrying on the business on his own account in one district, and directed him to account for the profits (b).

Right of election protected.

Again, where it was provided by the partnership articles that, on the death of one of the partners, his personal representative should have the right to elect, within three months, to take the deceased partner's share in the business, Wood, V.-C., restrained the surviving partner from carrying on the business under any other firm or style than that used in the lifetime of the deceased partner, for three months, or until election by his representative (c). But it seems that though the Court can restrain the surviving partner from carrying on the business in any other name, it has no means of compelling him to carry it on in the original name (d).

Valuation of goodwill.

The value of a goodwill, or share of a goodwill, is usually estimated at so many years' purchase upon the amount of the profits (e); thus, in *Mellersh v. Keen* (f), it was fixed at one year's purchase of the net annual profits, calculated on an average of three years (g).

(a) *Marshall v. Watson*, 25 Beav. 501.

(b) *Turner v. Major*, 3 Giff. 442.

(c) *Evans v. Hughes*, 18 Jur. 691.

(d) *Lewis v. Langdon*, 7 Sim. 421.

(e) *Austen v. Boys*, 2 De G. & J. 626.

(f) 28 Beav. 453.

(g) As to other circumstances to be considered, see *Smith v. Everett*, 27 Beav. 446; *Johnson v. Helleley*, 34 Beav. 63; 2 De G. J. & S. 446.

APPENDIX A.

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883-8, AND THE RULES AND INSTRUCTIONS THEREUNDER.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883 (a).
46 & 47 VICT., c. 57.

*An Act to amend and consolidate the Law relating to Patents for
Inventions, Registration of Designs, and of Trade Marks.*

[25th August, 1883.]

BE it enacted by the Queen's most excellent Majesty, by and
with the advice and consent of the Lords spiritual and tem-
poral, and Commons, in this present Parliament assembled,
and by the authority of the same, as follows:

PART I.

Part I.

PRELIMINARY.

Preliminary.

1. This Act may be cited as the Patents, Designs, and Trade
Marks Act, 1883. Short title.

2. This Act is divided into parts, as follows:—

Division of
Act into
parts.

Part I.—PRELIMINARY.

Part II.—PATENTS.

Part III.—DESIGNS.

Part IV.—TRADE MARKS.

Part V.—GENERAL.

3. This Act, except where it is otherwise expressed, shall
commence from and immediately after the thirty-first day of
December, one thousand eight hundred and eighty-three (b). Commence-
ment of Act.

(a) The parts of this Act which have been expunged by the later Acts
are printed in italics, and the provisions which have been introduced are
printed in brackets.

(b) The Act of 1888, except where otherwise provided, commenced on the
1st January, 1889 (§ 28).

PART II. (SECS. 4-46).

PATENTS.

PART III. (SECS. 47-61).

DESIGNS (*a*).

(*a*) For § 51, requiring articles bearing a registered design to be marked so as to denote the fact of registration, see Appendix p. 596.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

Application
for registra-
tion.

62.—(1.) The comptroller (*a*) may, on application by or on behalf of any person (*b*) claiming to be the proprietor (*c*) of a trade mark (*d*), register the trade mark (*e*).

(2.) The application (*f*) must be made in the form set forth in the first schedule to this Act, or in such other form (*g*) as may be from time to time prescribed (*h*), and must be left at, or sent by post to *the Patent Office in the prescribed manner* [such place and in such manner as may be prescribed] (*i*).

(3.) The application must be accompanied by the prescribed number of representations (*k*) of the trade mark, and must state the particular goods or classes of goods (*l*) in connection with which the applicant desires the trade mark to be registered.

(4.) The comptroller may, if he thinks fit (*m*), refuse to register a trade mark (*n*); but any such refusal shall be subject to appeal to the Board of Trade (*o*), who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (*p*), if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid (*q*).

[(6.) Where an applicant for the registration of a trade mark otherwise than under an International Convention is out of

the United Kingdom at the time of making the application, he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.]

The amendments in this section were made by § 8 of the Act of 1888.

(a) The Comptroller General of Patents, Designs, and Trade Marks:—
§ 117.

(b) "Person" includes a body corporate, § 117, Rule 41. There is no limitation to British subjects, and the practice hitherto has been to grant registration to aliens. See, however, *In re Riviere & Co.*, 26 Ch. D. 48. By § 103 a certain priority is given to foreign applicants who have applied for registration in their own countries.

(c) By "claiming to be the proprietor" nothing more is meant than "claiming to be the first to adopt," whether there has been any user or not. The doubt expressed in *In re Anderson*, 54 L. J. Ch. 1084, *Edwards v. Dennis*, 30 Ch. D. 454, and *In re Lyndon*, 32 Ch. D. 109, is now removed: *In re Hudson*, 32 Ch. D. 311. Since by § 77 a trade mark cannot be protected until either it has been registered or registration has been refused, it hardly seems that there can be any effective proprietorship until registration has been granted, or, in the case of an old mark—i.e., a mark used before August 13th, 1875—refused.

(d) As to what is a trade mark, see § 64, *infra*, and Ch. 2.

(e) As to the mode of registration, see Rules 32-35. By Rule 33, if an applicant dies before registration, the trade mark may be registered for the successor to the goodwill of his business.

(f) For the mode of making application, see Rules 7-16. By § 81 (3) applications for registration of Hallamshire cutlery marks must be made to the Cutlers' Company.

(g) Form F in the second Schedule to the Rules is substituted for Form F in the Schedule to the Act. See Rules 4, 5.

(h) "Prescribed," i.e., by the Rules. See § 117.

(i) See Rule 16.

(k) Four in classes 23-35; three in other classes. See Rule 13 and Form G.

(l) The application may be for any goods in a class: see Form F. But it should be only for the particular goods for which the applicant has used or is about to use the mark: *Edwards v. Dennis*, 30 Ch. D. 454. For the classification of goods, see Rule 6 and the Third Schedule to the Rules.

(m) The comptroller's discretion to allow the registration of a trade mark is limited by §§ 69, 72, 73 (see per Cotton, L. J., in *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278, and per Pearson, J., in *In re Price's Patent Candle Co.*, 27 Ch. D. 681). And, further, "the question whether the comptroller shall, in the exercise of the discretion which the Act gives to him, register a trade mark, is a very different question from any of the questions upon a trade mark that can be raised. He is quite within his duty, and he is quite entitled, if he thinks that—either because there are words in it, the exclusive use of which would be calculated to deceive, or otherwise—there is a sufficient reason, to say, 'No; I do not think it is proper to register this trade mark'" (per Kay, J., in *In re Dunn*, 41 Ch. D. 489, and see *In re Marks & Tellefsen*, 79 L. T. (Journal) 247; *In re Speer*, 55 L. T. N. S. 880). It is, however, to be observed that in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 497, Lord Blackburn, referring to § 5 of the Act of 1875, by which it was provided that the Court "may" direct registration of a trade mark to which a claimant is entitled, said, "I

cannot construe this section as meaning anything else than that, where the Court of Chancery is satisfied that the applicant is a person who is for the time being entitled to the exclusive use of a trade mark in accordance with law, and that the trade mark is one within the definition in the Act, the Court is, *ex debito justitiæ*, to rectify the register, just as it would, before the Act of 1875, have been bound *ex debito justitiæ*, on similar proof, to prevent any one infringing the trade mark shown to be his property." And his lordship went on to say that, though the burden of proof lay upon the person making the application, yet if he did produce such proof as would, in the opinion of the Court, entitle him to an injunction, he did not think that the Court had any discretion to consider whether the registration would be inconvenient. If the comptroller has an absolute discretion to reject any mark he thinks fit, the result may be, in the case of an old mark, to destroy a very valuable property without redress. In any event the comptroller is forbidden to refuse registration without giving the applicant an opportunity of being heard : § 94.

(n) Before refusing to register a mark, the comptroller is to give the applicant ten days' notice of a time when he may be heard personally or by his agent. § 94 and Rules 17-19.

(o) See Rules 20-26 and Form H.

(p) As to limited registration, see note (e) to § 72 *infra*.

(q) The Court is the High Court of Justice in England : § 117. The Court has no jurisdiction to deal with an application which the comptroller has refused, except upon an appeal to the Board of Trade and a reference of the matter by the Board to the Court : *In re Normal Co., Ltd.*, 35 Ch. D. 231. But the Board should refer the matter to the Court : *Ib.* On the matter coming before the Court all objections can be taken, whether originally raised by the comptroller or not : *In re Sanitas Co., Ltd.*, 58 L. T. N. S. 164. When the comptroller refuses an application, and the matter is taken to the Court, the usual rule is to make the applicant pay the comptroller's costs, whether successful or unsuccessful : *In re Van Duzer*, 34 Ch. D. 623. See Rule 44 as to entering orders of the Court on the register.

Limit of time for proceeding with application.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned* (a) [the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned].

(a) This provision was first made by the edition of March 1883, of the Rules under the old Acts. The amendments in this section were made by § 9 of the Act of 1888. By the combined operation of this section and § 113 all applications not completed within twelve months by the applicant's default lapse, whether they were pending at the date of this Act or have been made subsequently : *In re Hayward & Co.*, 54 L. J. Ch. 1003. And this is so, though the default was occasioned by the neglect of the applicant's agent, and not of the applicant himself : *Jackson & Co. v. Napper*,

35 Ch. D. 162. But a trade mark registered in 1885, in pursuance of an application made in 1879, was allowed to remain on the register, subject to certain disclaimers, and to the entry of a note on the register making the five years for the purposes of § 76 run from 1885 and not from 1879: *In re Hayward & Co.*, 54 L. J. Ch. 1003. An application which has been abandoned may afterwards be renewed, at all events where the applicants are not personally in default: *Jackson & Co. v. Napper*, 35 Ch. D. 162; *In re Bancroft & Co.*, 5 P. R. 209. In *In re United Vineyards Proprietors Co.*, Stirling, J., Nov. 8th, 1889, an application made in 1876 had lapsed in consequence of the applicants having failed to comply with a request from the registrar for the payment of the final fee, the letter containing such request having miscarried. The applicants supposed that the mark had been registered, and took no further step. In 1882 a somewhat similar new mark was registered for the same goods by another firm. In 1889 the mistake was discovered by the original applicants, and they at once made a fresh application. The matter was referred to the Court, and it was held that, the mark having been used long before 1875, the registration should proceed, notwithstanding that the firm registered in 1882 refused to consent, while not appearing to actively oppose.

64.—(1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars (a):* Conditions of registration of trade mark.

- (a.) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner (b);*
or
- (b.) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark (c);* or
- (c.) *A distinctive (d) device, mark, brand, heading (e), label (f), ticket, or fancy word or words not in common use (g).*

(2.) *There may be added to any one or more of these particulars any letters, words or figures, or combination of letters, words or figures, or of any of them.*

(3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.*

[64.—(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

- (a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or
- (b.) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or
- (c.) A distinctive device, mark, brand, heading, label, or ticket; or
- (d.) An invented word or invented words (h); or

(e.) A word or words having no reference to the character or quality of the goods, and not being a geographical name (*i*).

(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them (*k*); but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3.) Provided as follows :

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business ; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof ;

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act (*l*.)]

The amendments in this section were made by § 10 of the Act of 1888.

(a) This section is enlarged from § 10 of the Act of 1875. The essential particular is that which causes a mark which, without it, would not be a registrable trade mark, to be a registrable trade mark ; it is that by virtue of which registration is granted to a mark ; and when the validity of an alleged trade mark is being considered by the Court, "the first duty cast upon the Court is to ascertain whether some one or more than one of the essential particulars of a trade mark, as defined by the Act, is found to exist, so that the mark may be described with one or more than one essential particular or particulars which distinguish it : " Per Earl Cairns, C., in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479. This being so, it is provided by § 92 that, though non-essential particulars of registered trade marks may be altered with the leave of the Court, essential particulars may not be. Where, therefore, two trade marks had been registered, one of which contained the name of the firm in ordinary type, and the other contained it printed in the form of a signature, Jessel, M. R., allowed a firm who had acquired the trade mark by assignment to substitute their own name for the name printed in ordinary type, but refused to allow any alteration of the signature in the second mark : *In re Dewhurst*, M. R., June 11th, 1880. See also *In re Murphy & Co.*, W. N. 1890, p. 84. A trade mark which does not contain any essential particular, and is therefore not registrable, does not become a good trade mark by remaining five years on the register : *In re Palmer* (1), 21 Ch. D. 47 ; (3) 24 Ch. D. 504 ; *In re Ralph*, 25 Ch. D. 194 ; *In re Leonard & Ellis*, 26 Ch. D. 288 ; *In re Lloyd & Sons*, 27 Ch. D. 646 ; *In re Wragg*, 29 Ch. D. 551 ; *Edwards v. Dennis*, 30 Ch. D. 454 ; *Wood v. Lambert*, 32 Ch. D. 247 ; *In re Spencer*, 54 L. T. N. S. 659. So in Victoria : *Lewis v. Klapproth*, 11 Vict. L. R. (E.) 214 ; *Wolfe v. Alsop* (2), 12 Vict. L. R. (E.) 421 ; *Wolfe v. Lang & Co.*, 13 Vict. L. R. 162. The defini-

tion section in the Canada statute is wider, so that cases on this section must be applied with caution in Canada: *Smith v. Fair*, 14 Ont. Rep. 729.

(b) See *ante*, p. 26. The name of an individual in ordinary type is not made distinctive by having the descriptive name of the goods added: *In re Gianacis*, 58 L. J. Ch. 782; *In re Hannay*, 7 P. R. 46.

(c) See *ante*, p. 36; and *In re Dewhurst*, M. R., June 11th, 1880. Registration of a signature, together with a descriptive word, gives no exclusive right in the descriptive word: *Watt v. O'Hanlon*, 4 P. R. 1.

(d) See *ante*, p. 37. The word "distinctive" applies to all the varieties of marks mentioned in this subsection. Per Cotton, L. J., in *Waterman v. Ayres*, 39 Ch. D. 29; and per Chitty, J., in *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274. The distinctiveness which is required cannot consist solely in colour: *In re Hanson*, 37 Ch. D. 112.

(e) A word used alone is not a heading: per Earl of Selborne, C., in *In re Leonard & Ellis*, 26 Ch. D. 288-95.

(f) The label itself must be distinctive, so that a label with the name of the proprietors in ordinary type and words descriptive of the goods is not a distinctive label: *In re Price's Patent Candle Co.*, 27 Ch. D. 681; nor can words which are descriptive or common to the trade be such a label: *Great Tower St. Tea Co. v. Smith*, 6 P. R. 165. A label was held to be distinctive in *In re Bryant & May, Ltd.*, 4 Times L. R. 675; and see *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72. The registration of a distinctive label does not give an exclusive right to descriptive words appearing on it: *In re Hudson*, 32 Ch. D. 311; *In re Atkins Filter & Engineering Co., Ltd.*, 3 P. R. 164; *Symington & Co. v. Footman, Pretty, & Co.*, 56 L. T. N. S. 696; *Watt v. O'Hanlon*, 4 P. R. 1; nor to words common to the trade registered in connection with it: *British Tea & Trading Association, Ltd. v. Cooke*, V. C. B., June 8th, 1886. And where applicants applied for registration of a label containing descriptive words, and contended that their registration would give them a right to the descriptive words, the opinion of the Court of Appeal negating the claim was stated in the order of the Court allowing the registration to proceed: *In re Hudson*, 32 Ch. D. 311.

(g) See *ante*, p. 44. Fancy words were not registrable under the old Act: *Ex parte Stephens*, 3 Ch. D. 659; and see *Rose v. Evans*, 48 L. J. Ch. 618. A fancy word cannot be made out of that which is not one by prefixing the word "the": *In re Stapley & Smith*, 29 Ch. D. 877. An old mark is not considered to be in common use unless it has been used by more than three firms, but the leave of the Court is necessary for the second or third registration of the same, or substantially the same, old mark. See note (e) to § 72 and § 74.

(h) See *ante*, p. 47.

(i) See *ante*, p. 48.

(k) "Figures" mean numerals. See *Ex parte Stephens*, 3 Ch. D. 659. When it is wished to register the same essential (or "material," by which the same thing appears to be meant) particular, with a number of varying additions, the proper course is to register the marks as a series, under § 66, *q.v.* See also note (e) to § 72 *infra*. Inasmuch as the parts of a combination mark which are not within the definition of "essential particulars" are not entitled to registration or protection when standing alone, it seems that there cannot well be infringement of a combination mark unless the essential particular is taken. See *In re Hudson*, 32 Ch. D. 311; *In re Atkins Filter & Engineering Co., Ltd.*, 3 P. R. 164; *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274; *Watt v. O'Hanlon*, 4 P. R. 1. In *In re Horsburgh*, 53 L. J. Ch. 237, where a registered trade mark consisted of a distinctive device and a descriptive word, it was held that substantially the same descriptive word might be registered by another

firm with a different device, from which it follows that the use of the second trade mark would be no infringement of the first.

There will not be registered as new marks or prominent parts of new marks—(See Instructions, par. 30, *infra*):—

The Royal Arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of the Queen, or of any member of the Royal Family.

Representations of the Royal Crown.

The National Arms or Flags of Great Britain. (See *Ex parte Davids & Co.*, 16 U. S. Pat. Gaz. 94, as to the American practice.)

Prize or exhibition Medals were also formerly excluded, but are now admitted. (As to these, see *Batty v. Hill*, 1 H. & M. 264; *Taylor v. Gillies*, 59 N. Y. 331; *In re Bush & Co.*, 10 U. S. Pat. Gaz. 164; *In re Brook*, 26 W. R. 791; *In re Farina* (2), 27 W. R. 456.)

Old marks.

(l) See *ante*, 48. The wording of this subsection is wider than that of the corresponding provision in § 10 of the Act of 1875. *E.g.*, a single letter may now be registered as an old mark, though it was formerly excluded from registration: *In re Mitchell* (1), 7 Ch. D. 36. An old mark must be registered as a whole, and in the exact form in which it has been actually used. Thus, in *In re Royal Baking Powder Co.*, W. N., 1880, p. 49, the applicants were not allowed to register the word "Royal," or the words "Royal Baking Powder," apart from the rest of the label with which they had been used. So in *In re Simpson, Davies & Sons*, M. R., January 12th, 1881, the registration of a trade mark consisting of a cross would have been held to be wrongful, by reason of the points of the cross registered being differently shaped from the points of the cross used, had it not been proved that there had been user in both forms. So in *Russell & Sons, Limited v. Smith*, M. R., June 18th, 1880, it was held that registration was wrongful because the user had been of a rough outline of a crown, and the registration was of an elaborate crown, with all the shading filled in. And see cases at p. 49. On the other hand, in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479, the House of Lords directed registration of the essential particular, omitting the immaterial additions. Now, by §§ 64, 74, the entire mark would be registered, with a disclaimer of the additions. Where blanks are left in the marks as registered, there is nothing to prevent the proprietor from filling them up in actual use: *Newman v. Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.); *Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

The words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To Counterfeit this is Forgery," will not be registered under the Acts. See Instructions, par. 29, *infra*. Nor will pictorial representations of goods to which the marks are to be applied, or names of persons in the possessive case in combination with the names of goods. See p. 462, *infra*. As to ornamental or coloured groundwork, see Instructions, par. 28.

Connection of trade mark with goods.

65. A trade mark must be registered for particular goods or classes of goods (a).

(a) This comes from § 2 of the Trade Marks Registration Act, 1875. The appropriation of a trade mark to particular goods or classes of goods was not new. See *Hall v. Barrows*, 4 De G. J. & S. 150; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Somerville v. Schembri*, 12 App. Cas. 453. See Rule 6 and Schedule 3 to the Rules with respect to the classification of goods for the purposes of the Act, also per Pearson, J., in *In re Lyndon*, 32 Ch. D. 109, and per North, J., in *Hart v. Colley*, 44 Ch. D. 193. The Third

Schedule divides the various descriptions of goods into fifty classes. By the Rules under the Act of 1875 it was provided that where a trade mark was registered, a similar trade mark should not be registered in the name of another proprietor for any goods in the same class without the leave of the Court; but this requirement of the leave of the Court is now limited to cases in which the second application is in respect of the same goods or description of goods (see § 72). Under the old Act, registration for part of a class was granted to old marks: in *Ex parte Barrows*, W. N. 1877, p. 119; L. J. N. of C. 1877, p. 110; *In re Lysaght*, Dig. 623; *In re Rabone*, Dig. 643; *In re Ashton & Sons*, V.-C. H., February 26th, 1881; and to new marks in *In re Jelley Son, & Jones*, 51 L. J. Ch. 639; *In re Braby & Co.*, 21 Ch. D. 223; and *In re Clark & Co.*, 27 Sol. J. 398 (though in this case the mark was common for other goods in the class); and refused to a new mark in *In re Hargreaves*, 11 Ch. D. 669. And see *In re De Otaduy*, W. N. 1885, p. 177; *In re Metcalf*, 31 Ch. D. 454. Registration ought to be applied for only in respect of goods for which the mark is used or intended to be used: *Edwards v. Dennis*, 30 Ch. D. 454. In cases of Sheffield marks within § 81 (2) the Cutlers' Co. are to register old marks for all the metal goods in § 81, though they may have been used for some only of such goods: per North, J., in *In re Lambert*, 61 L. T. N. S. 138. If a mark is used for other goods than those in respect of which it is registered, even though in the same class, such user may be restrained if a similar mark has been used and registered by another firm in respect of those other goods: *Upper Assam Tea Co. v. Herbert & Co.*, C. A. July 3rd, 1889. In America, registration of the same mark in the same class may be granted to different persons if the goods are different: *Sorg. v. Walsh*, 16 U. S. Pat. Gaz. 910. It has been held under the United States Statute of 1870 (now replaced by that of 1881) that registration in respect of too wide a class of goods is bad altogether: *Smith v. Reynolds* (2), 10 Bl. C. C. 100; S. C. (3), 13 *ib.* 458.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately (a).

(a) This section is entirely new, but a mode of registration bearing a resemblance to that for which provision is here made was suggested by the Court of Appeal as the right one in *In re Barrows*, 5 Ch. D. 353, and was occasionally adopted. See note (e) to § 72, *infra*, and cases there cited. In some cases, however, this form of registration was not considered satisfactory by the applicant, usually because, the different combinations not being individually registered, the registered proprietor was unable to get such a certificate of registration as would enable him to obtain registration in foreign countries. In *In re Fox & Co.*, V.-C. H., May 7th, 1881, Hall, V.-C., allowed a person who had registered a device together with a word (which, under the Act of 1875, could not be an essential particular in a new trade mark) to obtain a separate registration of the same device with

Registration of a series of marks.

a different word, so that the same one essential particular was separately registered twice over, with additions which, for the purposes of the Act, were immaterial. After this decision, separate registration was generally granted by the registrar to marks which would more properly have been registered in a series, or, as it was more generally called, by representation. The concluding words of this section render separate registration unnecessary, but there is nothing to prevent it.

The only rules specially relating to applications for registration of a series of trade marks are Rule 14 (by which a representation of each trade mark included in the series is to be placed on the application form and on each of the half-sheets containing the additional representations required by Rule 13), and Rule 30, relating to the mode of advertisement.

Trade marks
may be regis-
tered in any
colour.

67. A trade mark may be registered in any colour [or colours], and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour [or colours] (a).

The amendments in this section were made by § 11 of the Act of 1888.

(a) In the old Acts and Rules no mention was made of colour, on account of the difficulty of properly advertising marks applied for in colour. See per Jessel, M. R., in *In re Robinson*, 29 W. R. 31. A trade mark registered in black and white consisted of the device registered, whatever might be the colour in which it was used, and it was therefore regarded as entitled to protection in whatever colour it might be used, and against rival marks in whatever colour: *Nuthall v. Vining*, C. A., Jan. 21st, 1880. There it was said that, in cases of alleged infringement, the true test of comparison was to compare the designs of the two trade marks in the same size and free from colour, and that similarities in respect of colour would only be regarded in order either to prove fraud, or to turn the scale when the question of infringement, leaving colour out of sight, was very difficult to decide. In *Hanson v. British Tea and Trading Association, Limited*, V. C. B., April 9th, 1884, C. A., June 19th, 1884, a label had been used, which, as registered under the Act of 1875, was divided into three parallel stripes of equal width, of which the outer ones were shaded and the middle one was left white, and which had the words " ' Red, white, and blue ' label " printed across it, and the name of the plaintiffs at the foot, and which, in actual use, was coloured with the French tricolour; and though it was registered without colour, an injunction was granted to restrain the use of a label similarly coloured and containing the same words. But where a fresh application was made to register the same label for other goods under this Act, registration was refused by the comptroller, and his refusal was upheld by the Court, on the ground that the distinctiveness required in a mark tendered for registration could not consist solely in colour: *In re Hanson*, 37 Ch. D. 112. When the question was whether a trade mark sent in for registration was too similar to one already registered for registration to be permitted, and the trade mark already on the register was in practice used in colour, the question was taken into consideration whether the subsequent trade mark, if similarly coloured, would be likely to cause deception: *In re Worthington*, 14 Ch. D. 8. In *In re Jeffrey & Co.*, Stirling, J., May 18th, 1888, the applicants for registration were allowed to bind themselves by a note on the register not to use the trade mark in black colour, nor in so dark a hue as to resemble black; and in *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888, the register was rectified by consent by adding a note that the registered proprietor was only to use his mark in blue and white.

In Canada the same effect as that provided by this section is given to registration in colour: *Smith v. Fair*, 14 Ont. Rep. 729; and in the United States also a trade mark cannot consist in colour alone: *Ex parte Landreth*, 31 U. S. Pat. Gaz. 1441; *Fleischmann v. Starkey*, 25 Fed. Rep. 127.

In some exceptional cases, under the Act of 1875, trade marks were found to be incapable of advertisement or registration in black and white, the only peculiarity being the combination of colours, *e.g.*, where coloured threads were twisted in the wick of a candle, or combined in the selvage of a piece of stuff. In such cases the marks were registered by deposit, actual specimens of the marked article being sent in to the registrar and deposited by him at the Patent Museum. For instance, there were so deposited specimens of certain marks for worsted stuffs in Class 34, numbered 5844 to 5850, and consisting of selvages containing distinctive coloured threads. See "Trade Marks Journal," Vol. II., No. 51, p.88. The use of colour being very frequently of importance in the cotton trade, it was decided that all marks for goods in the cotton classes (23-5) should be registered by deposit. When a trade mark was thus registered by deposit, the actual thing deposited, colour included, constituted the trade mark, so that in questions of infringement the point was whether the device, plus colour, was imitated in the offending mark with sufficient exactness to deceive. And the same rule was applied in registration cases, colour being taken into consideration in estimating the degree of resemblance. Thus, in *In re Robinson*, 29 W. R. 31, a device of a silver rupee being already registered, another applicant sought to obtain registration of a device of a gold mohur, and this was granted, on the ground that all that was registered was a silver coin, notwithstanding that if the second mark were to be coloured silver, deception would be probable. In such cases it was held that the proper manner of regarding the colour was a question for the trade, and that if, in the opinion of the trade, deception might arise, the Court would act on that opinion: *Mitchell v. Henry*, 15 Ch. D. 181. See also *In re Christiansen*, 3 P. R. 54, as to the opinion of the trade. Besides the cases above referred to, see *In re Orr-Ewing*, 8 Ch. D. 798, 4 App. Cas. 479; *In re Brook*, 26 W. R. 791; and *In re Jones Bros. & Co.* V.-C. H., July 10th, 1880.

The present section appears to have the effect of giving trade marks registered by deposit at the Patent Office Library, or registered in pursuance of an application accompanied by coloured representations, the same advantages as registration in black and white, so that for the future the colour of a trade mark registered in colour will not, except in very exceptional cases, such as that of the coloured selvage, be a part of the mark, but after one trade mark is so registered, another will not be entitled to be used or registered, if it would be likely to be mistaken for the first, on the supposition that the first mark was used in any different colour from that in which it was registered.

See Rules 13 and 27 as to the deposit of specimens of trade marks.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller (a), [unless the comptroller refuse to entertain the application] (b). Advertisement of application.

The amendments in this section were made by § 12 of the Act of 1888.

(a) "The object of the advertisement is to give to persons who might be claimants of the trade mark proposed to be registered the opportunity of coming forward and objecting:" per Hall, V.-C., *In re Meikle*, 24 W. R. 1067. Consequently, as was there held, when a refusal of the comptroller

to register a trade mark is overruled, the only order that can be made is an order for him to proceed with the application, so that the usual course of advertisement, &c., may be followed. This course was adopted by Hall, V.-C., in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479, and subsequent cases. It is not, however, incumbent on persons to see the advertisement, so that if a common mark has been registered, in consequence of the firms interested in opposing it having failed to see the advertisement of the application, they are able to obtain the removal of the mark from the register, with costs, on application within a reasonable time after the registration was brought to their knowledge: *In re Hyde & Co.*, 7 Ch. D. 724. See *In re Palmer* (3), 24 Ch. D. 504; *In re Kuhn & Co.*, 53 L. J. Ch. 288; *Edwards v. Dennis*, 30 Ch. D. 454; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Wood v. Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659.

As to the mode of advertisement, see Rules 27-30.

(b) This exception was no doubt inserted in consequence of the case of *Ex parte Saxlehner*, Q. B. D., July 7th, 1887, in which the comptroller refused to advertise applications by Saxlehner for the registration of certain trade marks, on the ground that similar marks were already registered in the name of the Apollinaris Co., so that registration could not be granted and advertisement was useless; but on application by Saxlehner the Q. B. Div. granted a rule to show cause why a mandamus to advertise should not issue. The matter does not appear to have been further contested, and the marks were advertised in the "Trade Marks Journal" for July 27th, 1887..

Opposition to registration.

69.—(1.) Any person (a) may within *two months* [one month or such further time, not exceeding three months, as the comptroller may allow] of the *first* advertisement of the application, give notice in duplicate at the Patent Office of opposition (b) to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

(2.) Within *two months* [one month] after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter-statement (c) in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) *If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.*

(4.) *If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court (d).*

[(3.) If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who

gave notice of opposition, and shall, after hearing (e) the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear (e) the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid (f).

(5.) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom.]

(a) This section comes from the old rules. The amendments were made by § 13 of the Act of 1888.

There is no limitation of the right of opposing to persons who can themselves claim registration: *In re Riviere & Co.*, 26 Ch. D. 48; nor is there any limitation of the right of opposing on the ground of similarity to proprietors of trade marks registered for the same goods, or even for goods in the same class, as the goods for which the applicant is seeking to register. But an opposition on this ground would, of course, not succeed unless the two marks would come into collision in some way when being used. Thus, in *In re Simpson, Davies & Sons*, M. R., Jan. 12th, 1881, the application was for registration in class 22 for railway waggons, and the successful opposition was by a firm registered in class 4 for coal, whose trade mark was used by placing it on the waggons in which the coal was conveyed and sold. And in *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278, a mark applied for in respect of wines was not allowed to be registered on account of its similarity to a mark already registered for spirits. But in *In re Dunn*, 41 Ch. D. 439, the opposition failed because a mark used for baking-powder could not be mistaken for a mark used for powder for an effervescing drink. The opposition may be by a person with whom the applicant has covenanted not to use the mark. See the Victorian case of *Ex parte Grist & Bowring*, 11 Vict. L. R. 630.

If what is desired is, not to have the registration altogether refused, but to have it limited by the addition of a note stating, e.g., that the mark is only to be used in trade with a particular country, and the applicant is willing to consent to such limitation, it is not necessary to go through the process of entering a notice of opposition, but an order directing that the mark, if registered, is to be registered with the addition of a note to the desired effect, may be obtained by the applicant on an *ex parte* application: *In re Keep Brothers*, 26 Ch. D. 187.

(b) See pp. 470, 492 for notice of opposition. The practice in opposition cases is prescribed by Rule 31. The notice of opposition may be amended under rule 54, even after the counter-statement has been put in: *R. v. Comptroller*, Q. B. D., May 3rd, 1890.

(c) pp. 482, 496, *infra*.

(d) This being the time at which the case stood for the determination of the Court, it was held that the costs of the previous proceedings in the office could not be given to a successful opponent: *In re Brandreth*, 9 Ch. D. 618; *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278. Where a claim had been wrongfully set up to use a certain trade mark, the claimants were ordered to pay the costs of cross adjourned summonses, as well as of an action which had been brought to enforce the right, even though they had not actually used the mark in question: *Davis v. Tylor*, M. R., April 24th, 1879. In *In re Hudson*, 32 Ch. D. 311, no costs of an opposed application were given to successful applicants, on the ground that they had caused the litigation by the manner in which they had put forward their case. By the rules under the Act of 1883 the proceedings subsequent to the case standing for the determination of the Court were to take the form of an application by the applicant to the Court by summons for leave to register. Now the proceedings are assimilated to those in the case of an unopposed application for registration, and the rights of the parties are decided by the comptroller, with an appeal to the Board of Trade, who may refer the case to the Court. Under the old Acts and Rules the opponent was required to take out a summons for directions, which almost always resulted in the applicant being directed to apply for leave to register. See *In re Simpson, Davies & Sons*, 15 Ch. D. 525; also *In re Johnston*, 43 L. T. N. S. 672. See rule 46 as to notifying the order of the Court to the comptroller.

(e) It seems that if, for any reason, an opponent is not heard, his course is to apply for a mandamus: see per Bowen, L. J., in *In re Lambert*, 61 L. T. N. S. 138.

(f) See Rules 20-26, and compare § 62. On an opposed application coming before the Court, the Court has full jurisdiction to decide as to the validity of the mark, notwithstanding that the comptroller has originally, under § 62, passed it for registration: *In re Arbenz*, 35 Ch. D. 248. And where an application is opposed by a competent person, all questions as to the validity of the mark are open to the consideration of the Court. It remains to be decided what costs the Court now has power to award; but it would appear that the Court can give the costs of the appeal, but not of the proceedings before the comptroller. See note (d) *supra*.

Assignment
and trans-
mission of
trade mark.

70. A trade mark, when registered, shall be assigned and transmitted (a) only in connection with the goodwill (b) of the business concerned in the particular goods or classes of goods for which it has been registered (c), and shall be determinable with that goodwill (d).

(a) This section comes from § 2 of the Act of 1875. As to assignment and transmission, see Rules 36-40 and 61, and Form K in the Second Schedule to the Rules. See, too, Ch. 3, *supra*.

Assignments and transmissions are to be entered in the register: see §§ 78, 87, *infra*. By § 4 of the Act of 1875, it was enacted that every proprietor registered in respect of a trade mark subsequently to the first registered proprietor should, as respected his title to that trade mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor. This enactment is not now repeated, the same result being effected by generalising the language of § 76. Compare the American case of *Walton v. Crowley*, 3 Bl. C. C. 440; R. Cox, 166.

(b) As to the connection between trade marks and the goodwill of the business, see *Cooper v. Hood*, 26 Beav. 293; *Churton v. Douglas*, Johns. 174; *Shipwright v. Clements*, 19 W. R. 599, and *Cotton v. Gillard*, 44 L. J. Ch. 90; and the American cases of *Sohier v. Johnson*, 111 Mass. 238;

Witthaus v. Braun, 44 Md. 303; *Taylor v. Bemis*, 4 Biss. 406; *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54, and S. C. (2), 51 How. Pr. 455; *Morgan v. Rogers*, 19 Fed. Rep. 596; *McVeagh v. Valencia Cigar Factory*, 32 U. S. Pat. Gaz. 1124; *Oakes v. Tonsmierre*, 4 Woods 547; *Smith v. Fair*, 14 Ont. Rep. 729. Where a trade mark has been placed on the register, but no business exists in which it is used, the mark cannot be assigned, since there is no goodwill to be assigned with it. *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98. See *In re Parina* (4), 44 L. T. N. S. 99. In *In re Wellcome*, 32 Ch. D. 213, the English agents of an American firm had registered in their own names two trade marks used by the latter, and subsequently assigned them to them; and it was held by Chitty, J., that the assignment, being an assignment to the persons entitled to the goodwill of the business for the purposes of which the trade marks had been registered, it was an assignment of the trade marks in connection with the goodwill, within this section, notwithstanding that the persons originally registered had no interest in the goodwill. As to goodwill, see ch. 9, ante.

(c) "An assignee has no exclusive right to a trade mark unless the assignment is of a business co-extensive with the trade mark as registered" (per Fry, L. J., in *Edwards v. Dennis*, 30 Ch. D. 454). And an assignment of a trade mark with a goodwill consequently gives the assignee no right in the trade mark in connection with any goods other than those to which the goodwill extends: *Ib.*

(d) It would appear that, since a trade mark is to determine when the goodwill of the business in connection with which it has been used determines, the registration should also be determined upon that event happening. So long as the registration continues, there is, under § 75, public use of the mark, which might be thought to imply the existence of a goodwill. It will, however, be noticed that sub-section 1 of § 90 only gives power to expunge an entry made without sufficient cause, so that it would appear that an entry made at a time when a goodwill was in existence is not within the wording of the sub-section. However this may be, registration of a trade mark is, by § 76, only evidence of the proprietor's right, *subject to the provisions of the Act*. Rule 34 of the old Trade Mark Rules (re-numbered 33 in the edition of March 1883) gave power to the Court, on the application of any person aggrieved, to remove any trade mark from the register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor was not engaged in any business concerned in the goods within the same class as the goods with respect to which the trade mark was registered; and under this rule a trade mark was removed from the register in *In re Ralph*, 25 Ch. D. 194.

A patentee is carrying on business, and has, therefore, an existing goodwill, as long as he receives royalties from licensees, though he does not himself manufacture: *In re Ralph, ubi supra*. This rule is not re-enacted, but there is no reason to suppose that this omission is due to an intention to allow a trade mark to be protected after the goodwill has determined, and after, by this section, the mark has itself determined.

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court (a). Conflicting claims to registration.

(a) This section comes from § 5 of the Act of 1875. Rules 42-45 direct that the mode of submission to the Court shall be by special case.

This was also provided by the Rules under the old Acts, and *Allsopp v. Walker*, Dig. 545, was heard on special case, and in *Ex parte Grimshaw*, W. N. 1877, p. 24, Hall, V.-C., refused to order otherwise. It was, however, found to be so difficult in practice to settle the statement of facts that in all cases of rival claim the practice was adopted of applying to the Court by way of motion or summons, asking at the same time for the leave of the Court to have the matter decided in that way, and it is believed that after the first year or two from the passing of the Act of 1875 there is no instance of a special case to be found. *Allsopp v. Walker* was a case in which the registration of a trade mark was objected to on the ground of its similarity to another trade mark, but the cases which this section and the rules under it appear to be really intended to govern are cases in which not similar, nor even identical, trade marks are claimed, but in which *the same* trade mark is claimed, *e.g.*, where a partnership has been dissolved and a question has arisen between the former co-partners as to the way in which the trade marks of the partnership have been transmitted.

Restrictions
on registra-
tion.

72.—(1.) Except where the Court has decided (*a*) that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register (*b*) in respect of the same goods or description of goods (*c*) a trade mark identical with one already on the register with respect to such goods or description of goods.

(2.) [Except as aforesaid] (*d*) the comptroller shall not register (*b*) with respect to the same goods or description of goods (*c*) a trade mark *so nearly resembling* [having such resemblance to] a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive (*e*).

The amendments in this section were made by § 14 of the Act of 1888.

(*a*) This section comes from § 6 of the Act of 1875, by which the "special leave" of the Court was required for such subsequent registration. Of this leave of the Court, Jessel, M.R., said in *In re Jelley, Son & Jones*, 51 L. J. Ch. 639, that it "is not a capricious leave. It merely means that the second man must show his title." The same principle will still govern the decisions of the Court, which will be obtained on motion or adjourned summons. It is for the Court to judge as to the similarity, so that registration may be granted notwithstanding the adverse decision of the Manchester Committee of Experts (see notes to cotton rules, *infra*), or refused, notwithstanding the favourable decision of a foreign Court (*In re Farina* (2), 27 W. R. 456). "The Court" being the High Court of Justice, an order of the House of Lords should be made an order of the High Court of Justice. See *In re Orr-Ewing* (2), 28 W. R. 412.

(*b*) The comptroller's discretion to allow registration is limited by this section: *In re Price's Patent Candle Co.*, 27 Ch. D. 681; *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278.

(*c*) The prohibition of § 6 of the old Act was of registration "in respect of the same goods or *classes* of goods." The alteration in the language confines the prohibition to cases in which the goods are substantially the same, so that it no longer applies to cases of different goods which happen to be grouped together in the same class. Even under the old Act registration was sometimes granted to similar marks for different goods included in the same class, when no clashing could take place. See note (*a*) to § 65, and note (*a*) to § 69.

(*d*) Before the introduction of these words by the Act of 1888 the pro-

hibition was absolute ; but it was held that the Court had a certain discretion where the case was not precisely covered by this section : *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278.

(e) The meaning of the words "calculated to deceive" was considered in *In re Lyndon*, 32 Ch. D. 109, in which Fry, L. J., said that "the words 'calculated to deceive' import at first sight a design to deceive ; but I think it plain, from the rest of the section and the decisions of the Courts, that a mark is within the section 'calculated to deceive' when that mark, fairly used, is so like a mark on the register, also fairly used, as that the one is likely to be mistaken for the other." And Bowen, L. J., said "a trade mark is calculated, by its resemblance to another already on the register, to deceive, if in the course of its legitimate use in the trade it is likely to do so." In *In re Farina* (1), 26 W. R. 261, Hall, V.-C., appears to have thought that a mark ought only to be refused registration as being 'calculated to deceive' if it bore such a resemblance to the earlier mark that an injunction would be granted to restrain the use of it ; but in *In re Marks & Tellefsen*, 79 L. T. (Journal) 247, Pearson, J., considered that the question in such cases was, not whether an injunction would necessarily be granted to restrain the use of the mark applied for, but whether it so nearly resembled the earlier mark as to be likely in the future to give rise to litigation ; and in *In re Speer*, 55 L. T. N. S. 880, Kay, J., took the same view, and went on to explain that the comptroller would be right in refusing to register a mark which was so composed as to be likely to cause the goods to which it was applied to be known by the same name in the market as the goods to which the older mark was applied. And see also per Kay, J., in *In re Dunn*, 41 Ch. D. 439, and per Stirling, J., in *In re Baschiera & Co.*, 33 Sol. J. 469. If the essential and permanent particulars of the two marks are too similar, it is immaterial that there are differences in the non-essential and changeable elements : *In re Murphy & Co.*, W. N., 1890, p. 84. It has been held in Victoria that when A and B have for years used marks bearing a certain resemblance to one another, A cannot afterwards register a mark still more similar to B's mark : *In re Rowley & Pyne*, 9 Vict. L. R. (L.) 307.

The restriction imposed on the registration of similar trade marks does not extend to similar marks of the same owner, but when one person applies for the registration of an essential particular, or combination of essential particulars, together with varying additions, the proper course is to register the marks as a series under § 66, *ante*. The old Acts contained no provision corresponding to those of § 66, but the same course was considered to be the right one, viz., either to register the essential particular, omitting the additions, but stating that there were to be such, or else to register the essential particular with one form of addition, but stating that that might be varied. See *In re Barrows*, 5 Ch. D. 353 ; *In re Brook*, 26 W. R. 791 ; *In re William Dixon & Co.*, M. R., April 4th, 1879 ; *Davis v. Tylor*, M. R., April 24th, 1879 ; *In re Clippens Oil Co.*, M. R., March 11th, 1881 ; *In re Steedman*, L. J. N. of C. 1883, p. 83 ; though occasionally separate registration was granted to marks which differed only in non-essential respects, as in *In re Fox & Co.*, V. C. H., May 7th, 1881. See the observations of Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238, as to registration with a note of disclaimer. Also *infra*.

When the second of two trade marks which it is thought may conflict is claimed by a different person from the registered proprietor of the first one, it makes a considerable difference whether the second mark is an old one or a new one ; for it is the duty of a manufacturer, when adopting a new mark, to take especial care to select a distinctive one, and the Court will be far more strict in deciding whether this has been done, than it will be in deciding as to similarities between old marks. So that old marks bearing a certain similarity to each other may sometimes be allowed to be

Registration as a series.

Old marks favoured

registered, though if the mark last applied for were a new one, registration would be refused to it: *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 275; *In re Lambert*, 61 L. T. N. S. 138; and see per Lord Blackburn in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 499.

The "Three Mark Rule."

When the Act of 1875 came into operation it was soon discovered that trade marks which were for practical purposes indistinguishable had in various instances been used by two or more firms, generally in different parts of the country, for the same or substantially the same goods, and the injustice of giving an exclusive right to the first of these firms was felt to be so great that what is known as the "Three Mark Rule" was promulgated by the Commissioners of Patents. The first public announcement of the new rule was made by Jessel, M. R., in *In re Walkden Acrated Waters Co.*, 54 L. J. Ch. 394; when he stated that the Lord Chancellor was of opinion that the number of times that a device or emblem might be registered as a trade mark for articles of the same class ought, for the sake of distinctiveness, in no case to exceed three. That was a case in which the application was for the registration of a mark similar in its main features to two others already on the register. The mark was a new one, and the application was only allowed upon condition of the consent of both the previously registered proprietors being produced. On account of the mark in that case having been a new one, an idea arose that the rule was only applicable to new marks, but in *In re Hyde & Co.*, 54 L. J. Ch. 395; the Master of the Rolls took another opportunity of referring to the rule, and stated that the Lord Chancellor had personally come to the decision that not more than three registrations of the same, or practically the same, mark should be allowed, and that this was also his own decision; and, in fact, that of the Commissioners of Patents, having been communicated to the Attorney and Solicitor General. This decision was intended to cover old marks, and not merely new ones. A mark used in substance by more than three firms could not be registered, but must be treated as open. The rule therefore is that where a mark has been used by more than three firms it is common to the trade and incapable of registration; that where a mark has been used by two firms or three firms before the 13th of August, 1875 (the date of the passing of the Act of 1875), it is the old mark of each firm, and each firm is entitled to registration, almost as of right, on proof of the facts; but that where a mark has been registered by one firm or two firms, another firm will not be allowed to register substantially the same mark for the same goods as a new mark, except by the consent of the previously registered proprietors. See *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Brook*, 26 W. R. 791; *In re Pocell*, Dig. 589; *Ex parte Sales, Pollard & Co.*, Dig. 620; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Benbow v. Low* (4), 44 L. T. N. S. 875; *Mouson & Co. v. Boehm*, 26 Ch. D. 398; and *In re Vergaras*, V.-C. H. June 3rd, 1881, in which last case the same mark was allowed to be registered by three separate firms as a new mark, all consenting. In *In re Walkden & Co.*, 54 L. J. Ch. 394, the mark was allowed to be registered as a new mark with the consent of two other firms who had registered similar marks as their old marks. An old mark may be registered under the Three Marks Rule, notwithstanding that another similar mark has been on the register for upwards of five years: *Jackson & Co. v. Napper*, 35 Ch. D. 162; *In re Bancroft & Co.*, 5 P. R. 209. And to entitle a mark to such registration it is not necessary to show user on the identical goods for which it is sought to register; it is sufficient to show actual user before August, 1875, on substantially identical goods—e.g. hatchets and axes, gimlets and anegrs, coopers' drawing-knives and carpenters' drawing-knives: *Jackson & Co. v. Napper*, 35 Ch. D. 162. In *In re United Vineyards Proprietors Co.*,

Stirling, J., Nov. 8th, 1889, the Company applied in 1876 for the registration of a device of a salamander with the words "The Salamander" as their old mark for brandy, used upwards of twenty years before 1876; but the application lapsed in consequence of the applicants having never received a letter from the registrar requesting the final fee to be forwarded. The applicants supposed the mark to have been registered. In 1882 another firm obtained the registration of a different device of a salamander as their new mark for fermented liquors and spirits. In 1889 the original applicants became aware of the non-registration, and at once made a fresh application for registration of their original mark as their old mark for brandy, used since 1850. The firm registered in 1882 refused to consent to the application, but did not appear to oppose it; and it was held that the registration should proceed, the mark being an old one. Where a new mark had been registered and much used, and another similar mark which had not been much used, was proved to be an old mark and was allowed to be registered, the new mark was not removed from the register, but was allowed to remain there side by side with the old one: *Mouson & Co. v. Boehm*, 26 Ch. D. 398. But where the word "Emollio" had been used for several years prior to 1870, but had been abandoned from that year till 1881, when the user was recommenced in a different form, and there had been considerable use of the word "Emolline" by another firm since 1876. "Emollio" was not allowed to be registered: *In re Grossmith*, 60 L. T. N. S. 612. In *In re Sone & Fleming Manufacturing Co.*, 30 Ch. D. 505 the applicants had used the mark in England and America since 1872, and had registered it in America in 1881. On their applying for registration in 1885 registration was refused by the comptroller on account of a somewhat similar mark having been registered by another firm in 1877, but that firm not appearing to oppose, though served with notice of the application, and the mark being an old one, registration was granted. So in *In re Bancroft & Co.*, 5 P. R. 209. To bring a mark within the rule and entitle it to registration, notwithstanding a previous similar registration for the same goods, foreign user is insufficient, and there must have been user within the United Kingdom: *In re Münch*, 50 L. T. N. S. 12; with which compare *In re Riviere & Co.*, 26 Ch. D. 48; *Leonard & Ellis v. Wells & Co.*, 26 Ch. D. 288 (per Fry, L. J.); and *Berliner Brauerei Gesellschaft Tirol v. Knight, Stocks & Co.*, W. N. 1883, p. 70. And the mere passage of marked goods through England, without any sale or exposure for sale, is not user of the mark in England: *Jackson & Co. v. Napper*, 35 Ch. D. 162, and see *Newman v. Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.). The user within the United Kingdom must have been substantial, and not merely nominal and unknown to the other proprietor: *In re Hodson & Co.*, 26 Sol. J. 43. A mark will be held to have been in common use, and to be consequently incapable of registration in any name, if the substantial part of it was so, though the minor parts were sometimes varied, e.g. in *In re Wragg*, 29 Ch. D. 551, the device of a syphon, hand and glass was held to be common to the mineral waters trade, though in the six cases relied on the three elements appeared together in three only, the syphon and hand in one, and the syphon and glass in two. From the same case it appears that the cases of user, which make the mark common, need not all have been on the goods, as in three out of the six cases the user was only on invoices and circulars, and not on the bottles.

In some cases the similarity between marks has been got over by registering for different goods, though in the same class (see note (a) to § 65, ante); or restricting the manner of user in respect of colour: *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *In re Jeffrey & Co.*, Stirling, J., May 18th, 1888, or otherwise; (*In re Whitely*, 42 L. T. N. S. 627; *In re Sykes*, 43 L. T. N. S. 626; *In re Farina* (3), Dig. 654), (see *In re De Otaduy*, W. N. 1885, p. 177); or the locality within which the mark is to

Registration
with a note.

be used (*In re Rabone*, Dig. 643; *In re Keep Brothers*, 26 Ch. D. 187; *In re Mitchell & Co.*, 28 Ch. D. 666; *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888. But where registration is granted with a limitation, the nature and extent of the limitation should appear on the face of the register, so as to be ascertainable by persons searching the register: *In re Mitchell & Co.*, 28 Ch. D. 666. See *In re De Otaduy*, W. N. 1885, p. 177. And in the same spirit, the improper grant of an exclusive right in common elements has been avoided by the use of disclaimers (*In re Leonardt*, Dig. 610; *In re Mitchell* (2) Dig. 611; *In re Hubbuck*, M. R., June 20th, 1879; *Ex parte Sales, Pollard & Co.*, Dig. 620; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Hoyle & Sons, Ltd.* (2), Chitty, J., Nov. 30th, 1883); *In re Davies*, Chitty, J., March 9th, 1885; and see § 74: and permission to use a mark has been reserved to certain persons, on registration against all others being granted (*Ex parte Hemming & Son*, M. R. April 27th, 1881).

Marks compared as used.

In considering whether there is in fact such similarity between two marks as to exclude the second from registration, it is very important to compare them in the actual mode of user—*e.g.*, as branded on metal goods (*In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 975; *Nuthall v. Vining*, C. A. Jan. 21st, 1880; and compare *Davis v. Reid*, 17 Grant Up. Can. Ch. 69). And if there are blanks in the new mark, as tendered for registration or registered, regard will be had to the manner in which these are filled up in practice: *In re Christiansen*, 3 P. R. 54, and the manner of arrangement of parts common to the trade will also be taken into consideration: *ib.* and see *In re Farrow*, 6 Times L. R. 319. And it has been held that, if one trade mark has been registered without colour, but is in practice used in a particular colour, and another trade mark is offered for registration which is distinguishable without colour, but might by the addition of colour be made to resemble the first mark, registration will be refused (*In re Worthington*, 14 Ch. D. 8). And see *In re Biegel*, 57 L. T. N. S. 247. Although a trade mark must now be distinctive, irrespective of colour; (*In re Hanson*, 37 Ch. D. 112), it may now be registered in colour (§ 67), an advantage which was previously reserved for cotton marks and other marks of a special character requiring registration by deposit. In such a case it was formerly held that the colour was part of the mark, so that a gold coin might be registered for goods for which a silver coin was already registered, though if both were in gold, or both in silver, there would be a similarity (*In re Robinson*, 29 W. R. 31), but having regard to the provisions of § 67, it hardly seems that this decision could now be repeated. In *In re Lyndon*, 32 Ch. D. 109, it was held by the Court of Appeal that a mark tendered for registration must be compared with a mark already registered, not as actually used, but as registered, and on the footing that the applicant's mark will be fairly used; and "it is established now that when two marks are being compared together for the purpose of seeing to what extent one resembles the other with reference to the question of registering or not, the Court must presume a fair user of the mark; and at the same time it is established that the Court must look, in deciding such a question as this, to the mode in which the mark would be stamped or affixed, the character of the goods upon which it is affixed, and generally to all the circumstances of the case with respect to the placing on of the mark and the user of it. But, though the circumstances are to be looked at, it is a cardinal proposition that the Court must presume a fair user": Per Chitty, J., in *In re Haines, Batchelor & Co.*, 5 P. R. 669. In the same way Cotton, L. J., said in *In re Lambert*, 6 P. R. 351: "In considering whether the mark is calculated to deceive, we must consider what would be the ordinary use, without fraud, of the mark, and not go into the question of what might be done by a fraudulent user. If that were done—if there were a fraudulent user—then the Court would interfere, not because the man had not got the trade mark, but because he was using that trade mark

fraudulently, so as to pass off his goods for those of another. That matter of fraud is not to be considered in dealing with the question whether the mark is so like another as to be calculated to deceive. In dealing with that question you must assume that it is fair and right." And see *In re Farrow* 6 Times L. R. 319. It has been held in Victoria (*Ex parte Kennedy*, 9 Vict. L. R. (L.) 335), and the same would appear to hold good in this country, that the marks ought to be compared taken apart, and not as seen side by side, and that the question is whether it is or is not probable that an incautious person would be deceived.

In the case of cotton marks which were brought before the Manchester Cotton marks. Committee of Experts, due weight should be given to their opinion as to the distinctiveness of the marks (*Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479), but they seem to have given somewhat too wide an interpretation to the expression "substantial similarity," in their instructions. See *In re Brook*, 26 W. R. 791. The cotton rules being now repealed, a B. list mark may be registered without an application to the Court, if the comptroller considers that a mistake has been made.

For instances of cases in which registration has been refused on the ground of similarity, reference may be made to *Allsopp v. Walker*, Dig. 545, in which Cases of refusal. the first mark was a man's hand held upwards, and the second was a female hand pointed horizontally; *In re Jelley, Son, & Jones* 51 L. J. Ch. 639, in which the first mark was a pointer at a point, with the word "Staunch," and the second was a pointer feeding out of a porridge pot; *In re Rosing*, 54 L. J. Ch. 975, in which the first mark was a plain horn with a looped cord, and the second was a sprig of two roses with a twisted horn; *Barrows v. Pelsall Coal and Iron Co.*, Dig. 530, in which the marks were a crown with "B. B. H." in Roman letters, and a crown with "B. B. S." in italics; *In re Worthington & Co.*, 14 Ch. D. 8, a plain triangle, and a triangle containing a church with an inscription; *In re Barker & Son*, 53 L. T. N. S. 23, where each label consisted of a sporting scene; *In re Marks & Tellefsen*, 79 L. T. (Journal) 247, in which the general arrangement of the two marks was very similar; *In re Speer*, 53 L. T. N. S. 890, a dog, tower and harp, in each case; *In re Sanitas Co., Ltd.*, 58 L. T. N. S. 166, where the application was for the word "Sanitas," which was included in two previous marks; *In re Grossmith*, 60 L. T. N. S. 612, where "Emollio" was thought too similar to "Emolline;" *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278, where each mark contained prominently a device of a golden fleece; *In re Baschiera & Co.*, 33 Sol. J. 439, a lion and a winged lion; *In re Murphy & Co.*, W. N. 1890, p. 84, a lion rampant with a crown and a lion rampant with a sheaf; *In re Goodall*, 42 Ch. D. 566, a similar arrangement of common words; and see *In re Farina* (2), 27 W. R. 456; *In re Hargreaves*, 11 Ch. D. 669; *In re Meyerstein & Co.*, 43 Ch. D. 604, and other cases; also *Ex parte Kennedy*, 9 Vict. L. R. (L.) 335, in Victoria.

For instances of cases in which registration has not been refused on the ground of similarity see *In re Farina* (1), 26 W. R. 261, where a label had Cases of non-refusal. been registered with a small seal in one corner, and application was made for the registration of the same seal alone; *In re Lyndon*, 32 Ch. D. 109, a man's head surmounting the word "way," and a helmeted female head surmounting the word "Athena;" *In re Haines, Batchelor & Co.*, 5 P. R. 669, a shaded device of a pointer at a point, facing to the left, and surmounting the word "Staunch," and an outline device of a pig, facing to the left, and surmounting the initials "H. B. & Co.;" *In re Burgoyne*, 61 L. T. N. S. 39, "Emu" and "Oomoo;" in *In re Dunn*, 41 Ch. D. 439, the opposition was disallowed on the ground that the goods were different. See also *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479, and the other cotton cases mentioned in the notes to the cotton rules. Except in the cases of cotton marks the opposition has usually been successful, and registration has either been refused altogether or only granted subject to limitations.

American cases.

Under the similar section in the United States Act, registration was refused where the first mark was the figure of a star and the second was the word "star" (*In re The American Lubricating Oil Co.*, 9 U. S. Pat. Gaz. 687); where the first mark was the name Haxall, and the principal part of the second consisted of the same name and a Maltese cross (*In re Coggin, Kidder & Co.*, 11 U. S. Pat. Gaz. 1109); where the marks were the word "Swan" and the words "Black Swan" (*Ex parte Caire*, 15 U. S. Pat. Gaz. 248); so where a trade mark was tendered which consisted of three parts, each of which was already registered, one by the applicant and the others by other firms (*In re Bush & Co.*, 10 U. S. Pat. Gaz. 164), and where the new mark consisted of "A. S. California Family * Soap," and "California" and "*" were already on the register (*Ex parte Smith* (1), 16 U. S. Pat. Gaz. 679); and see *Ex parte Weisert Bros.*, 16 U. S. Pat. Gaz. 680. In *In re Cornwall* (1), 12 U. S. Pat. Gaz. 138, registration was granted to a star and crescent, a star being on the register; and see *In re Imbs*, 10 U. S. Pat. Gaz. 463.

The comptroller is entitled to his costs of opposing an application on the ground of similarity to a registered mark; at all events, unless the marks are very clearly distinct. See *In re Patent Plumbago Crucible Co.*, M. R. Aug. 1st, 1879.

See Rule 46 as to notifying the order of the Court to the comptroller.

Where the Registrar had refused to register on the ground of similarity to a registered mark, and the marks did not appear to be similar, but the owner of the registered mark had not been served with the notice of motion of the person applying for the registration of the second mark, Chitty, J., directed the registered owner to be served, and on that being done, and no objection being made, ordered the registration to proceed: *In re Milne & Co.*, Chitty, J., July 6th, 1883. And where the comptroller objects to register a mark on the ground of similarity to a registered mark, the usual practice now is to require notice of the application to be given to the proprietor of the registered mark: *In re Sone & Fleming Manufacturing Co.*, 30 Ch. D. 505; *In re Bancroft & Co.*, 5 P. R. 209; *In re Baschiera & Co.*, 33 Sol. J. 469.

Further restriction on registration.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the *exclusive* use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice (a), or any scandalous design.

(a) This section is taken from § 6 of the Act of 1875, and was amended by § 15 of the Act of 1888. The wording of the original enactment was "would not be deemed entitled," and the present wording, "would be deemed disentitled," seems less open to misinterpretation. That the original enactment only referred to deceptiveness inherent in the mark itself, and not to liability to be mistaken for another mark, was held by Jessel, M. R., in *In re Horsburgh*, 53 L. J. Ch. 237. Kay, J., however (*In re Grossmith*, 60 L. T. N. S. 612; *In re Dunn*, 41 Ch. D. 439), and Stirling, J. (*In re Swift Specific Co.*, 6 P. R. 352) appear to have thought that words were within this section which bore a resemblance to words included in an earlier mark. And Cotton, L. J., took this view in *In re Dunn*, 41 Ch. D. 439. But in that case Lindley, L. J., expressly concurred in the view taken by Jessel, M. R., and Fry, L. J., did not dissent from it. And in *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278, the observations of Cotton, L. J., incline rather in the same direction. In so great a division of judicial opinion it cannot yet be said with certainty which view of the section is correct. It is, however, submitted that §§ 72 and 73 simply have reference to the course which the comptroller is to take of his own motion with respect to marks tendered for registration, and that § 72

requires him not to register marks calculated to deceive by similarity to other marks, and that § 73 requires him not to register marks calculated to deceive by reason of some inherent defect. Section 69, which is the section by which provision is made for opposition, not by the comptroller, but by any private objector, contains no limitation of the grounds upon which objection may be raised, and it is conceived that the Act imposes no restriction upon such objections, but leaves it open to the objector to set up any legal or equitable ground for rejecting the application. If this is correct, then the cases which fall within this section are cases in which a trade mark contains a false statement of origin: *In re Horsburgh*, 53 L. J. Ch. 237; or in which the trade mark untruly states that the proprietors are the "sole makers:" *In re Hayward & Sons*, 54 L. J. Ch. 1003; or in which the mark is habitually used as part of a deceptive whole: *Wood v. Lambert*, 32 Ch. D. 247.

Where it is sought to register as a trade mark a word or words which are or may be appropriate to the article to which the trade mark is to be applied, the applicant is in the dilemma that the alleged trade mark is either descriptive or deceptive; if the word or words are properly applicable to the article and may be truly used with respect to it, they are descriptive and are not within § 64; if they may be read as stating something with respect to the article which is untrue, they are deceptive within the present section; so that *quâcunqve viâ* the application must fail. Thus in *In re Saunion & Co.*, Dig. 625, where the mark was "Anglo-Portugo Oysters," either the oysters were of Anglo-Portuguese origin, in which case any one had a right to say that they were so, or they were not of such origin, in which case no one had a right to say so; and this was adopted by Lopes, L. J., in *In re Van Duzer*, 34 Ch. D. 623. There are numerous similar cases under the U. S. Acts. Thus, *In re American Sardine Co.*, 3 U. S. Pat. Gaz. 495 ("American Sardines"); *In re Dole Bros.*, 12 *ib.* 939 ("Egg Macaroni"); *In re Warburg & Co.*, 13 *ib.* 44 ("Cachemire Milano"); *Ex parte Marsching*, 15 *ib.* 294 ("French" paints); *Ex parte Knapp*, 16 *ib.* 318 ("London" Animal Foods); *Ginter v. Kinney Tobacco Co.*, 12 Fed. Rep. 782 ("Straight-cut" Cigarettes). Compare *In re Green*, 8 U. S. Pat. Gaz. 729 ("German Sirup"), where registration was allowed.

In the American case of *Ex parte Cigar Makers' Association*, 16 *ib.* 958, it was held that a mark could not be registered which was intended to be used by any member of an association on goods of any quality, nor one which was intended to be used for the furtherance of a scheme in restraint of trade. And in *Schneider v. Williams*, 44 N. J. Eq. 391, the Court refused to protect such a mark at the instance of a member of such an association. (But see *Strasser v. Moonelis*, 108 N. Y. 611; *People v. Fisher*, 57 N. Y. Sup. Ct. 552; *Allen v. Macarthy*, 37 Minn. 347; *Bloete v. Simon*, 19 Abb. N. C. 88.) And in *Ex parte Bloch & Co.*, 40 U. S. Pat. Gaz. 443, registration was refused in America to a mark which contained the words "Knights of Labour," the applicants having no connection with the society of that name.

As to what will be deemed to disentitle to protection in a court of justice, see further Ch. 7, *ante*.

74.—(1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark (a).

(a.) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

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trade marks.

Any distinctive (*b*) device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade (*c*) in the goods with respect to which the application is made ;

(b.) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive (*b*) word or combination of words, though the same is common to the trade (*c*) in the goods with respect to which the application is made ;

(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim (d) in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*

[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

Provided that a person need not, under this section, disclaim his own name or the foreign equivalent thereof, or his place of business ; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.]

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words or figures, which was, or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods (*e*).

The amendments in this section were made by § 16 of the Act of 1888.

(a) This section was new in 1883, and is not very clearly expressed, but what is intended appears to be that when a trade mark sent in for registration contains, together with an essential particular, a feature which is in common use in the trade, that common feature must be disclaimed, so that the rest of the trade may not be deprived of their right to use it. The additions to which this section relates are apparently not quite the same as the additions to an essential particular referred to in § 64 (2), but such as would be capable of distinguishing the goods, were it not that in point of fact they have been used by several different firms. Thus, if a device of an animal were registered in combination with the words "First quality," for iron, the case would be within § 64 ; but if the same device were to be registered in combination with a crown, the case would be within the present section, the crown being *primâ facie* distinctive, but in point of fact common to the

trade. Long user does not entitle members of a trade to register a particular device as part of their trade marks when the user was fraudulent in its inception and is still calculated to deceive : *In re Heaton*, 27 Ch. D. 570.

(b) The word "distinctive" is applicable to all the matters here mentioned : per Chitty, J., in *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274, and see, per Cotton, L. J., in *Waterman v. Ayres*, 39 Ch. D. 29. There is at first sight a contradiction in terms here, as a mark common to the trade cannot, of course, be distinctive ; but what is intended appears to be that any mark which is *prima facie* distinctive, but which is really common to the trade, must be disclaimed when registered as part of a combination. The epithet "distinctive" would thus be here applied to every mark which is not inherently incapable of appropriation by an individual. This view was approved by Chitty, J., in *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274. From the dicta in the Court of Appeal in *In re Hudson*, 32 Ch. D. 311, and *In re Atkins Filter & Engineering Co., Ltd.*, 3 P. R. 164 it would appear that their attention had not been directed to this word.

(c) The words "common to the trade" have been construed to mean Common
"open to the trade : " *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820, marks.
and *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274 ; and this seems to be what is meant. In *Thompson v. Montgomery*, 41 Ch. D. 35. Lindley, L. J., said that "nothing can be common to the trade which is used only by one person in the trade ;" but in § 64, where it was intended to exclude from registration fancy words "in common use," that expression was employed, and the difference of language seems to show that the phrase here means that which is of common right, whether in common use or not. When it is alleged adversely to an applicant for registration that the whole or a part of his trade mark is common to the trade, the onus is upon the person alleging that this is so to prove it, not upon the applicant for registration to prove the contrary : *In re Leonard & Ellis*, 26 Ch. D. 288. And the entries in the registry office books of applications for registration do not prove that a mark is in common use, as they only prove that the applications entered have been made, not that they have all been properly made, or upon true allegations, or that the marks applied for have in fact been used : *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434. A mark is not made common to a particular trade by the fact that persons engaged in different trades have used it on goods of a different character : *Somerville v. Schembri*, 12 App. Cas. 453 ; nor by the fact that goods marked with it have passed through England from one foreign country to another, without any offering for sale in England : *Newman v. Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.). And see *Jackson & Co. v. Napper*, 35 Ch. D. 162. In a number of cases since the Registration Acts marks have been found to be common to different trades ; thus, a number of words and devices to the iron trade : *In re Barrows*, 5 Ch. D. 353 ; *In re Davies*, Chitty, J., March 9th, 1885 ; the words "Bank of England," to the sealing-wax trade ; *In re Hyde & Co.*, 7 Ch. D. 724 ; the word "Selected," and other words and devices, to the steel-pen trade : *In re Leonardt*, Dig. 610 ; *In re Mitchell* (2), Dig. 611 ; *In re Kuhn & Co.*, 53 L. J. Ch. 238 ; the letters "S. P." to the snuff trade : *Ex parte Sales, Pollard & Co.*, Dig. 620 ; the Eton arms to the hat trade : *Lucke v. Webster*, M. R., April 4th, 1879 ; the words "Braided Fixed Stars," to the match trade : *In re Palmer* (3), 24 Ch. D. 504 ; the words "La Minerva, Habana," "La Pureza," and "Gold Leaf," to the cigar and tobacco trade : *In re Lloyd & Sons*, 27 Ch. D. 646 ; *Newman v. Pinto*, 57 L. T. N. S. 31 ; *Partlo v. Todd*, 12 Ont. Rep. 171 ; a device of a siphon, hand and glass to the mineral-water trade : *In re Wragg*, 29 Ch. D. 551 ; the words "Extra," "Extra G." "Coker," to the canvas trade : *In re Hayward & Sons*, 54 L. J. Ch. 1003 ; the words "Mandarin Tea" to the tea trade : *British Tea & Trading Association, Ltd. v. Cooke*

V. C. B., June 8th, 1886; the words "Old Innishowen" to the whisky trade: *Watt v. O'Hanlon*, 4 P. R. 1; the words "Parchment" and "Bank" to the paper trade: *In re Goodall*, 42 Ch. D. 566; various animals, devices, and colours to the cotton trade: *Orr-Ewing & Co. v. Johnston & Co.*, 7 App. Cas. 219; *Wallace & Co. v. King & Co.*, Bombay High Ct., April 30th, 1879; *In re Hoyle & Sons, Ltd.* (2), Chitty, J., Nov. 30th, 1883; and see *Orr-Ewing & Co. v. Registrar of Trade Marks*, 4 App. Cas. 479; and *In re Brook*, 26 W. R. 791.

Disclaimers
under the Act
of 1875.

(d) The practice of entering disclaimers in the register appears to have originated with the cases of *In re Leonardt*, Dig. 610, and *In re Mitchell* (2), Dig. 611. In those cases the consent of the owner of the mark was required, but in *In re Kuhn & Co.*, 53 L. J. Ch. 238, an order for a disclaimer was made notwithstanding that the owner did not formally consent, and in other cases the registration was subjected to limitations entered on the register. See cases cited in note (e) to § 72 *supra*. The practice has been carried so far that in *In re Hoyle & Sons, Ltd.* (2), Chitty, J. Nov. 30th, 1883, a trade mark, consisting of a pheasant sitting on a gate, was registered with a disclaimer of the bird, leaving only the gate. See the order of the House of Lords in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479, and see also the statement by Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238.

In *In re Hudson*, 32 Ch. D. 311, the Court of Appeal appears to have thought that a disclaimer could not be compulsorily enforced under the Act of 1875; but there does not seem to have been much argument on the point, and the case was decided on the ground that the words of which it was sought to compel a disclaimer were descriptive, and could not in any event be claimed as a result of the registration of the label. The words not being *primâ facie* distinctive, the question as to disclaimer could not really arise. The same was the case in *In re Atkins Filter & Engineering Co., Ltd.*, 3 P. R. 164. In *In re Hayward & Sons*, 54 L. J. Ch. 1003, Kay, J., held that the Court had power under the Act of 1875 to order a compulsory disclaimer, and he accordingly ordered a disclaimer to be entered of the words "Extra G," which were common to the trade.

Disclaimers
under the Acts
of 1883-8.

The provision in the present Acts being that the common particular must be disclaimed *in the application*, the question has been raised whether such a disclaimer can be made at a later date, and North, J., in *In re Goodall*, 42 Ch. D. 566, decided that this could not be done, and that an application from which a necessary disclaimer had been omitted was simply null and void. In *In re Swift Specific Co.*, 6 P. R. 352, Stirling, J., refrained from deciding whether an application defective in this respect was invalid, but directed a disclaimer to be entered on the register. Subsequent disclaimers have also been directed under these Acts by Kay, J.: *In re Hayward & Co.*, 54 L. J. Ch. 1003 ("Extra," "Coker"); by Kekewich, J.: *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820 ("Herbalin"); and by Chitty, J.: *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274 ("Washerine"). So that the greater weight of authority appears to be in favour of thus correcting an originally defective or wrongful application or registration. It has also been held by Kekewich, J., that the fact that a common word has been registered as part of a trade mark, without a disclaimer, does not necessarily disentitle the owner of the mark to his costs in an action against a person who has adopted the same trade mark: *Newman v. Pinto*, 57 L. T. N. S. 31. Where a distinctive device has been registered, together with words which are in fact common to the trade, but without any disclaimer, no right is acquired in the common word, even after the lapse of five years from registration: *British Tea & Trading Association, Ltd. v. Cooke*, V. C. B., June 8th, 1886 ("Mandarin Tea").

(e) The intention of this sub-section is to introduce here the "Three

Mark Rule," as to which see note (e) to § 72, *suprà*. That rule is that registration of the same or substantially the same mark may be granted to not more than three persons, who can prove real user before August 13th, 1875, but that proof of user by more than three persons before that date debars all persons from registering. For there to have been "public user" by more than three persons, it would seem that the user by each must have been substantial (*In re Hodson & Co.*, 26 Sol. J. 43), and such as came or ought to have come to the knowledge of each of the others. But the marks used need not have been absolutely identical, nor in all cases on the actual goods: *In re Wragg*, 29 Ch. D. 551. It will be noticed that this subsection only relates to old marks. In the case of new marks a second registration of the same device would not be granted under § 72, except by the consent of the previously registered proprietor, and a disclaimer might even then be required as a condition of his consent. User is not proved by the books of applications for registration, as the allegations therein contained are not proved: *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434.

Effect of Registration.

75. Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark (a). Registration equivalent to public use.

[Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration (b).]

(a) The original § 75, for which the present section was substituted by § 17 of the Act of 1888, came from § 2 of the Act of 1875, but the provision in that Act was made subject to the existence of a connection with goodwill. Now there is to be deemed to be public use of a trade mark as long as it is registered, whether there is or is not any goodwill, which points to the propriety of the removal of a trade mark from the register as soon as the goodwill has determined. It is, however, doubtful whether there is power under § 90 to obtain this. And see the last words of § 76, and note (d) to § 70. But registration does not entitle to an injunction in respect of goods for which the mark has not been used, though it has been registered for them, at all events unless the mark has been exactly copied: *Edwards v. Dennis*, 30 Ch. D. 454. In the United States also registration is equivalent to public use. See *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis., 1871, 248. Apart from the legislation on the subject, public use of a trade mark gives a property in it. See per Lord Blackburn, in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 496. It has been decided that to constitute public use it is not sufficient for the marked goods to be advertised; they must be actually in the market. But so long as that is the case, length of user is not necessary. See *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Maxwell v. Hogg*, L. R. 2 Ch. 307; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *In re Simpson, Davies & Sons*, M. R. Jan. 12th, 1881.

(b) The last part of this clause, as now altered, comes from rule 32 of the Rules of 1883, and originally from the old Rules. The principle that

registration dated from the receipt of the application prevailed throughout. Now a slight alteration is made by substituting the date of the application for the date of the receipt of it.

Right of first proprietor to exclusive use of trade mark.

76. The registration of a person as proprietor of a trade mark shall be *prima-facie* evidence (a) of his right to the exclusive use (b) of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence (a) of his right to the exclusive use of the trade mark, subject to the provisions of this Act (c).

Effect of registration.

(a) This section comes from § 3 of the Act of 1875. Until the end of five years from registration the only effect of it is, as was said in the Court of Appeal in *Nuthall v. Vining*, C. A. Jan. 21st, 1880, to qualify the registered proprietor for suing infringers,—in other words, registration is “simply a condition precedent to suing.” per Chitty, J., in *Mouson & Co. v. Boehm*, 26 Ch. D. 398; and it seems that when an action is brought to restrain an alleged infringement of a trade mark which has been registered for less than five years, the defendant may rebut the *prima-facie* evidence of the plaintiffs’ right afforded by his registration, without moving to rectify the register by expunging the mark. See *In re Palmer* (1), 21 Ch. D. 47; *Lever v. Goodwin*, 36 Ch. D. 1; *Weaver v. Sanitary Engineering & Ventilation Co.*, L. J. N. of C., 1887, p. 144; *Weaver v. Stiff & Sons*, *ib.* After the expiration of five years from registration, the title of the registered proprietor is, for the purposes of an action for infringement, an absolute right, and cannot be disputed except upon an application under § 90 to rectify the register: *Edwards v. Dennis*, 30 Ch. D. 454; *Apollinaris Co., Ltd. v. Herrfeldt*, 4 P. R. 478. Compare *Evans v. Smith*, 3 Times L. R. 390, and *Bodega Co., Ltd. v. Owens*, 23 L. R. (Ir.) 371, where this principle does not appear to have had full effect given to it. This applies also to cases of colourable imitation, as well as to cases of direct copying: *Rodgers & Sons, Ltd. v. Rottgen*, 5 Times L. R. 678. The lapse of five years from registration is, however, no bar to proceedings brought for the purpose of rectifying the register. The view originally entertained as to the effect of this section, and the corresponding section of the Act of 1875 upon applications to rectify, appears to have been that during the first five years from registration the mark remained liable to removal from the register, *e.g.*, on application by the true proprietor of it, when it had been wrongfully registered in the name of another person, as in *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98; *In re Australian Wine Co., Ltd.*, 61 L. T. N. S. 427; but that after the expiration of five years from registration the title of the registered proprietor was secure against individual rival claimants, but as “the Act only says that after five years the person who has registered a trade mark shall be entitled to the trade mark, but does not say that the mark as registered shall be deemed to be a trade mark”—(see per Jessel. M. R., in *In re Palmer* (1), 21 Ch. D. 47; and compare the Victorian cases of *Lewis v. Klapproth*, 11 V. L. R. (E.) 214; *Wolfe v. Alsop* (2), 12 V. L. R. (E.) 421; *Wolfe v. Lang & Co.*, 13 V. L. R. 752)—the trade mark remained liable to removal for inherent defects in it—*e.g.*, that it contained no one of the essential particulars specified by § 64. Thus in *In re Palmer* (1), 21 Ch. D. 47, and (3) 24 *ib.*, 504, the words “Braided fixed stars,” registered for matches, were expunged, on the ground that at the date of the registration and ever since they had been merely descriptive of matches prepared in a particular way. So where the word “Valvoline” had been

registered, though it had been used as a descriptive term: *In re Leonard & Ellis*, 26 Ch. D. 288. And see *In re Ralph*, 25 Ch. D. 194; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Wood v. Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659. Since the case of *Edwards v. Dennis*, 30 Ch. D. 454, however, it has been generally recognised that § 90 (§ 5 of the Act of 1875) overrides the provisions of this section (§ 3 of the Act of 1875), and that even after the lapse of five years the registration of a mark which is for any reason wrongful may be rectified. In that case Cotton, L. J., said that "the third section (of the Act of 1875) is intended to afford assistance to a person who is bringing an action against another person for passing off his goods as the goods of the person who brings the action. In such a case, if the plaintiff shows that he has been on the register for five years, that dispenses with the necessity of his adducing evidence of exclusive use of his trade mark. But the third section is no bar to an application under the fifth section for rectification of the register, and in the case of such an application the Court is bound to consider whether the trade mark is properly on the register; for, although it may have been on for five years, if it ought not to have been on at all, then it can be taken off." And in this the other Lords Justices concurred. Where words common to the trade—*e.g.* "Mandarin Tea"—have been registered in combination with a distinctive device, or in connection with a distinctive label, for upwards of five years, no exclusive right is thereby acquired in the words: *British Tea and Trading Association, Ltd. v. Cooke*, V. C. B. June 8th, 1886. In *Lamplough v. Beedler*, C. A., Nov. 12th, 1880, it was held that the registered words "Pyretic Saline" were purely descriptive. See *Reinhardt v. Spalding*, 49 L. J. Ch. 57, and *Wheeler v. Johnston*, 3 L. R. Ir. 284. In *In re Hayward & Co.*, 54 L. J. Ch. 1003, a note was entered on the register that in the case of a mark registered in 1885 the five years were to run from that date, and not from the date of the application, which was in 1879.

In the United States, registration only affords *prima-facie* evidence of ownership (Act of 1881, § 7), and amounts to nothing more than a mere record of a claim: *Yale Cigar Manufacturing Co. v. Yale*, 30 U. S. Pat. Gaz. 1183; and it has been there held that registration of descriptive words confers no right in them: *Van Beil v. Prescott*, 82 N. Y. 630; and that the use of a registered mark may be restrained: *Glen Cove Manufacturing Co. v. Ludeman*, 23 Bl. C. C. 46; *Schumacher & Ettlinger v. Schwenke* (2), 36 U. S. Pat. Gaz. 457. In Canada it has been repeatedly held that registration can be invalidated by proof that the registered proprietor was not the first to use the mark: *McCall v. Theal*, 28 Grant Up. Can. Ch. 48; *Partlo v. Todd*, 12 Ont. Rep. 171; *Watson v. Westlake*, 12 Ont. Rep. 449. But it has also been held that for this to be so, the user by others must have been before the registered proprietor used the mark, not merely before he registered it: *Smith v. Fair*, 14 Ont. Rep. 729. Under the Canadian Statute it has been held that registration gives no right of action for anything done before registration: *Morse v. Martin*, Quebec Super. Ct., Feb. 28th, 1882; but neither the Quebec Court of Queen's Bench (3 Dorion 353) nor the Canada Supreme Court (Cassel's Dig. 509) decided the point. In New South Wales the right to registration depends, not on priority of application, but on priority of user: *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114; and although registration has been held to be from the outset conclusive proof of the right of the registered proprietor: *Walker v. Cargill*, 5 N. S. W. Rep. (E.) 243, the use of a registered mark has been restrained by injunction: *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114; *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72.

(b) The right to the exclusive use of a trade mark, first asserted in *Gout v. Aleploglu*, 5 Leg. Obs. 495, and *Millington v. Fox*, 3 My. & Cr. 338, and

after much discussion affirmed by the chancery judges (see Ch. 6, *ante*) is now given by statute upon registration.

(c) See § 70 as to the connection with goodwill.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused (a). The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused (b).

Necessity for applying for registration.

(a) This part of this section comes from § 1 of the Act of 1876. By § 1 of the Act of 1875, failure to obtain registration was fatal to the owner of a trade mark, whether old or new. The effect of the alteration introduced by the Act of 1876 was clearly explained by Lord Blackburn in the House of Lords in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 498, in which he said: "This alters the Act of 1875 in two respects: it renders registration a condition precedent to a proceeding to recover damages, as well as to a proceeding to prevent infringement, and it provides that if the proprietor of a trade mark in use before the passing of the principal Act has been refused registration, he may, notwithstanding such refusal, institute proceedings, either for prevention of, or damages for, the infringement of such trade mark, and need not wait till he has got the register rectified." And again he said: "It seems to me that the effect of the Act of 1876 is, that if one who says he is the proprietor of a trade mark wishes to institute proceedings against some one who, as he says, is infringing it, he must first try to have his trade mark registered. If the registration is refused for any reason, he may apply (under § 5 of the Act of 1875) to have the register rectified, and then the Court will have to determine as the principal question whether the reason of the refusal was sufficient. But he may also seek for more speedy redress. He may obtain a certificate of the refusal, and then institute proceedings to prevent the infringement, and then the Court will have to determine whether he was the proprietor of the trade mark." See, also, Malins, V.-C., in *In re Barrows*, 5 Ch. D. 353-59, and *Twentsche Stoom Bleekery Goor v. Ellinger & Co.*, 26 W. R. 70. The present section differs from § 1 of the Act of 1876, in that by that section the alternative of registering or procuring a certificate of refusal was given to an owner of any old mark, whether the old mark was or was not capable of being registered, so that an owner of such a mark might safely be content with a certificate of refusal, however obviously wrong the refusal might be. In the present section it will be seen that this alternative is no longer given to owners of old marks capable of being registered. Such marks must now be registered or left unprotected. New marks which are incapable of being registered under § 64 need not apparently be either registered or refused registration. If the owner of a trade mark for which registration or refusal to register is required is unable, when suing an infringer, to produce a certificate of registration or of refusal to register, his remedy is barred: *Goodfellow v. Prince*, 35 Ch. D. 9; even though he has made application for registration, and has only failed to obtain it because of delay in the

office: *Hazzopulo v. Kaufmann*, 23 Sol. J. 819. In *Jay v. Ladler*, 40 Ch. D. 649, a trade mark which had been registered for some only of the goods in a class was protected in respect of other goods in the same class for which it had not been registered; but it seems very questionable whether full effect was given to the provisions of § 65 and of the Act generally. In *Hart & Colley*, 44 Ch. D. 193, North, J., decided the contrary, and this decision appears more in accordance with the spirit of the Act. It has been held that where a mark has been properly registered under the Act, persons to whom it has been assigned with the goodwill are not precluded under this section from suing on it before transfer of the registration into their names: *Ihlee v. Henshaw*, 31 Ch. D. 323; and the same has been decided in Canada: *Carey v. Goss*, 11 Ont. Rep. 619.

It appears that there is nothing in this section to preclude, in the absence of registration, the granting of an injunction where the get-up of goods has been imitated: *Lever v. Goodwin*, 36 Ch. D. 1 (with which compare the Canadian case of *Smith v. Fair*, 14 Ont. Rep. 729); nor where special words have been imitated, apart from trade mark: *Sanitas Co., Ltd. v. Condy*, 4 P. R. 530; nor where a distinctive name or mark has been imitated, under which the plaintiff's goods have become known in the market: *In re Sanitas Co., Ltd.*, 58 L. T. N. S. 166; *Rodgers & Sons, Ltd. v. Rottgen*, 5 Times L. R. 678; nor where the registered trade mark is usually placed with other matters on a label or wrapper: *Great Tower St. Tea Co. v. Langford & Co.*, 5 P. R. 66; *Ascough v. Johnson & Co.*, 3 Times L. R. 735; nor where spaces left blank in the trade mark as registered are in practice filled in: *Newman v. Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.); *Melachrino & Co. v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

Under the Canadian statute it has been held that registration only qualifies for suing in respect of acts done after registration, and not in respect of earlier acts: *Morse v. Martin*, Quebec Super. Ct., Feb. 28th, 1882. But the point was not decided either by the Quebec Court of Q. B. (3 Dorion 353) or by the Supreme Court of Canada (Cassel's Dig. 509; and in *Smith v. Fair*, 14 Ont. Rep. 729, it was held that the account granted in cases of infringement should not be limited to the period of registration, at all events where fraud was proved. In the last-mentioned case it was also held that a plaintiff who has failed in an action for infringement by reason of non-registration is not debarred by that fact from bringing a fresh action after he has effected registration. In California an exclusive right to the use of a name or trade mark cannot now be acquired without registration as provided by the State Code: *Whittier v. Dietz*, 66 Cal. 78.

By § 1 of the Act of 1875, as amended by § 1 of the Act of 1876, the disability for suing without registration was to begin from July 1st, 1877. The time thus allowed for registration was extended, in the case of marks used in respect of any goods in classes 23 to 35 ("textiles") by § 1 of the Act of 1877, and Orders in Council of Dec. 12th, 1877, and June 29th, 1878, to Dec. 31st, 1878, and in the case of marks used in respect of cotton piece goods, by further Orders in Council of Nov. 27th, 1878, and May 17th, 1879, to July 31st, 1879. Since the date last mentioned a certificate of registration or of refusal to register has been a *sine quâ non* in all cases within the Acts.

(b) See § 96, rule 60, and forms L. and T1. See, also, per Chitty, J., in *In re Normal Co., Ltd.*, 35 Ch. D. 231.

[77 A. In an action for infringement of a registered trade mark (a) the Court or a judge may certify that the right to the exclusive use of the trade mark came in question; and if the Court or a judge so certifies, then in any subsequent action Certificate as to exclusive use and costs thereon.

for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.]

This new section was introduced by § 18 of the Act of 1888.

(a) This new provision for the benefit of trade mark owners does not seem likely to be of much use to them, inasmuch as it only provides for a certificate being given where the right to a trade mark has come in question in an action for infringement; whereas the right to a trade mark is almost invariably contested on a motion to rectify, and the result of the action follows the result of the motion. Kay, J., has held that this provision does not apply to such a case: *B. Edgington, Ltd. v. John Edgington & Co.*, 6 P. R. 513, and this appears to be so.

Register of Trade Marks.

Register of
trade marks

78. There shall be kept at the Patent Office a book called the Register of Trade Marks (a), wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

(a) The register of trade marks was previously kept under the authority of § 1 of the Act of 1876. As to entries in the register, see §§ 87, 91, and 92, and Rules 32-34, and 46-48, *infra*.

Removal of
trade mark
after fourteen
years unless
fee paid.

79.—(1.) At a time not being less than two months nor more than three months before the expiration of fourteen years (a) from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee (b); and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register (c), and so from time to time at the expiration of every period of fourteen years.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee (d), the comptroller may without removing

such trade mark from the register accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee (e).

(5.) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless, for the purpose of any application (f) for registration during *the five years* [one year] next after the date of such removal, be deemed to be a trade mark which is already registered, [unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark].

(a) This section comes from the old Rules. The amendments were made by § 19 of the Act of 1888.

(b) *I.e.* £1. See First Schedule. Also Form X.

(c) The removal and its cause are to be recorded, under Rule 47.

(d) *I.e.* 10s. See First Schedule. Also Form Y.

(e) *I.e.* £1. See First Schedule. Also Form Z.

(f) The effect of this is that (under § 72) the comptroller cannot, for one year after a mark has been removed from the register, place another similar mark on the register for similar goods, except under the circumstances stated in the words added to the subsection.

Fees.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade (a); and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct. Fees for registration, &c.

(a) Under § 7 of the Act of 1875, these fees were fixed by the Lord Chancellor, with the assent of the Treasury. For the list of fees now fixed by the Board of Trade, see the First Schedule to the Rules. Also Rule 3.

Sheffield Marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield Registration by Cutlers' Company of Sheffield marks

marks) assigned or registered by the master, wardens, searchers, and assistants of that Company (a), the following provisions shall have effect :

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register) :

(2.) *The Cutlers' Company shall enter (b) in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875 (c).*

[(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine, in respect of metal goods, either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said registers (d).]

(3.) An application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, [on metal goods] shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company (e).

(4.) Every application so made (f) to the Cutlers' Company

shall be notified to the comptroller in the prescribed manner (g), and unless the comptroller within the prescribed time (h) gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner (i) :

- (5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court :
- (6.) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks ; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day :
- (7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark, shall apply in the case of applications and registration in the Sheffield register (k) ; and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this subsection shall not prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register (l) :*
- [(7.) The provisions of this Act, and of any general rules made under this Act, with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto ; and this Act and any such general rules shall, so far as applicable, be construed accordingly, with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the comptroller, the Patent Office, and the Register of Trade Marks respectively ; and notice of every entry, cancellation, or correction made in

- the Sheffield Register shall be given to the comptroller by the Cutlers' Company: provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register.]
- (8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on *cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without cutting edge*, [on metal goods] he shall in the prescribed manner (*m*) notify the application and proceedings thereon to the Cutlers' Company (*n*):
- (9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned:
- (10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks:
- (11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks (*o*):
- (12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal (*p*) to the comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court:
- (13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register (*q*).

- [(14.) For the purposes of this section, the expression "metal goods" means all metals whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.
- (15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield Register a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.]

The amendments in this section were made by § 20 of the Act of 1888.

(a) As to the Cutlers' Company, the old Sheffield corporate marks, and the system which prevailed with respect to Sheffield marks under the Trade Marks Registration Act, 1875, see Appendix G., *infra*. The specified goods now form a much wider class than formerly. The present section provides for the closing of the old Cutlers' register and the immediate establishment of a new one, which will be an exact duplicate of the general register, so far as it relates to marks used for the specified goods within the specified limits.

(b) Under this subsection the Cutlers' Co. are performing a mere ministerial act in registering marks which come within this subsection, whether the marks are registered on the Company's own motion or on the application of a party claiming to be the proprietor of the marks, and there is no appeal from their action under subsection (12), nor any *locus standi* for an opposition to an application to them to register a mark under this subsection, and they are directed to register marks within the subsection for all the goods mentioned in the subsection, though they may have been used for some only of those goods. And they are authorised to register, under this subsection, marks which have been assigned by the proprietor on the Sheffield register to another, but which have not been surrendered by him to the Company and reassigned by them to the assignee: *In re Lambert*, 5 P. R. 542; 6 *ib.* 344.

(c) By § 9 (6) of the Act of 1875, Sheffield corporate marks were allowed to be registered in the trade marks register in the same manner and upon the same terms and conditions in and upon which they might have been registered if they were not corporate marks. Under this provision it was held that where a corporate mark had been assigned by its proprietor, but had not been surrendered to the Company and reassigned by them to the assignee, he must perfect his title with the Company before he could obtain registration under the Act: *In re Rabone*, Dig. 643. There was, however, no requirement for corporate marks to be registered.

(d) See form of application at end of second Schedule to Rules.

(e) This subsection relates to new marks not within subsection (2), and it appears that applications to register such marks may be opposed by other persons in the trade: *In re Lambert*, 5 P. R. 542 (per North, J.), and that if the Cutlers' Company refuse to hear such opposition the opponent's proper remedy is by mandamus: *ib.*, 6 P. R. 344 (per Bowen, L. J.). Applications under this subsection are to be made in duplicate, accompanied by the prescribed fees and representations: Rule 56.

(f) This and the two next subsections relate to new marks: *In re Lambert*, 5 P. R. 542.

(g) By sending to the comptroller one copy of the application and two representations of the mark for each class, within seven days after receipt of the application: Rule 57.

(h) One month from the receipt by the comptroller of the notice from the Company: Rule 58 (1).

(i) The Company is to require the applicant to send the comptroller a wood block or electrotpe, and the comptroller is to advertise the application as in other cases: Rule 58 (2).

(k) It appears that this first part of this subsection relates to new marks only: *In re Lambert*, 5 P. R. 542.

(l) This latter part of this subsection relates to all Sheffield marks, new or old: *In re Lambert*, 5 P. R. 542. See Rule 59, by which the proceedings at Sheffield are assimilated to those in London.

(m) By sending a copy of the official paper, with a note distinguishing the application: Rule 58 (3).

(n) In *In re Rosing*, 54 L. J. Ch. 975, the Company opposed the registration of a trade mark on the ground of similarity to a corporate mark, but, the objection failing in the Court of first instance, were ordered to pay the costs of the motion. On appeal, however, the objection taken by the Company was supported.

(o) Compare Rule 41.

(p) This subsection applies to all cases in which the Cutlers' Company have arrived at a decision, but not to cases in which the Company have performed a mere ministerial act—*e.g.* by registering an old mark under subsection (2); in which case there is no appeal: *In re Lambert*, 5 P. R. 542. For Form of Notice of Appeal, see Form W.

(q) These provisions are, shortly, that a counterfeiter may be fined not exceeding £20 by a justice or justices of the peace, subject to an appeal to Quarter Sessions. See Appendix G., *infra*.

PART V.

GENERAL.

Patent Office and Proceedings thereat.

Patent Office.

82.—(1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office:

(2.) Until a new Patent Office is provided, the offices of the Commissioners of Patents of inventions and for the registration of designs and trade marks existing at the commencement of this Act (a) shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the comptroller general of patents, designs, and trade marks (b), who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

(a) This is in Southampton Buildings, Chancery Lane, W.C.

(b) Under the Trade Marks Registration Acts the registrar was at the head of the Registry Office.

83.—(1.) The Board of Trade (a) may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks. Officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

(a) The authority given by this section to the Board of Trade was formerly possessed by the Lord Chancellor, under § 7 of the Act of 1875.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence. Seal of Patent Office.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive (a). Trust not to be entered in registers.

(a) This section, so far as it relates to trade marks, comes from the old Rules. Under this section an order to rectify the register by adding to the registration of a trade mark a note stating that the user was restricted by an agreement of which the date only was given, was varied so that the terms of the agreement should appear on the face of the register: *In re Mitchell & Co.*, 28 Ch. D. 666; and in another case a similar agreement was allowed to be stated in the register so far as it restricted the goods on which a registered trade mark was to be used, but not so far as it regulated the manner of user or the way in which orders were to be executed: *In re De Otaduy*, W. N. 1885, p. 177.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality (a). Refusal to grant patent &c., in certain cases.

(a) This is a new section, and, so far as it relates to trade marks, does not seem to carry much farther the provisions of § 6 of the Act of 1875, now re-enacted in § 73, *supra*, prohibiting the registration of a scandalous design as a trade mark.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copy-right in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his Entry of assignments and transmissions in registers.

satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be (a). The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design, or trade mark, as the case may be, shall, subject to [the provisions of this Act and to] any rights appearing from such register to be vested in any other person, have power absolutely to assign (b), grant licences (c) as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

The amendment in this section was made by § 21 of the Act of 1888.

(a) As to the mode of obtaining registration as a subsequent proprietor, see Rules 36-40 and Form K. Though § 4 of the Act of 1875 is not re-enacted, it seems that a subsequent proprietor will still, as regards his title to the trade mark, be in the same position as if his title were a continuation of the title of the first registered proprietor. In *In re Bryant & May, Ltd.*, 4 Times L. R. 675, a question was raised as to a title by assignment, and it was held that an agreement to assign the goodwill and trade marks was sufficient.

(b) A trade mark can be assigned only in connection with the goodwill of the business. See § 70, *supra*. Also *In re Wellcome*, 32 Ch. D. 213.

(c) The power of granting licences must not be exercised so as to deceive the public, e.g. so as to authorize the use of the mark on inferior goods. See ch. 7. The power of granting licences at all seems, in the case of trade marks, rather to conflict with § 70; the intention of which appears to be that only the person entitled to the goodwill shall have the right of using the trade mark.

Inspection of
and extracts
from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to [the provisions of this Act and to] such regulations as may be prescribed (a); and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee (b).

The amendment in this section was made by § 22 of the Act of 1888.

(a) This section is taken from the old Rules. See Rule 52 for the present regulations. The fee for inspection is 1s. for every quarter of an hour.

(b) See First Schedule.

Sealed copies
to be received
in evidences.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers and

other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

90.—(1.) The Court may on the application of any person aggrieved (a) by the omission without sufficient cause of the name of any person [or of any other particulars] (b) from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making (c), expunging (d), or varying (e) the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit (f).

Rectification
of registers by
Court.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller (g).

This section comes from § 5 of the Act of 1875, but is in rather different terms. The amendment was made by § 23 of the Act of 1888.

(a) The first question on an application to rectify the register under this section is whether the applicant is or is not a "person aggrieved." This question usually has to be considered with reference to cases in which it is alleged that a mark which is on the register ought not to be there; and it has been said that in such cases "any person interested in the same trade as the registered proprietor" is a person aggrieved (*Rose v. Evans*, 48 L. J. Ch. 618); and that "the course of decision before the Act of 1888 was passed was that any person interested in the same trade might, without showing any special damage, be treated as a 'person aggrieved' by any improper or inaccurate registration" (*In re Hayward & Sons*, 54 L. J. Ch. 1003). That there must be some legal damage was laid down by Lord Selborne, C., in *In re Riviere*, 26 Ch. D. 48, where he pointed out that what was necessary to constitute a "person aggrieved" was that the thing complained of should be one of the grievances mentioned in the section, and that it should tend to his injury, to inflict upon him some damage, in a legal sense. Similarly, on the further hearing of the same case (58 L. T. N. S. 289), it was said by Fry, L. J., that "'any person aggrieved' means 'every person who will in reasonable probability suffer any injury or loss—using those words in a legal and not in a sentimental sense—from the other persons claiming to use it;'" and per Lindley, L. J. (S. C.), that the person must be aggrieved "in the sense of sustaining legal damage, either immediate or prospective." The commonest case is where the proprietor of a registered trade mark brings an action for infringement of it, and the defendant applies to have it removed from the register, on the ground that it never ought to have been placed there. In such cases it has been repeatedly held that the person sued is entitled to apply as a "person aggrieved:" *In re Ralph*, 25 Ch. D. 194; *In re Leonard & Ellis*, 26 Ch. D. 288; *Lloyd & Sons v. Bottomley*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551;

"Person
aggrieved."

Edwards v. Dennis, 30 Ch. D. 454; *Wood v. Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659; *In re Lever*, Chitty, J., Dec. 8rd, 1886; *In re Tongood*, 55 L. T. N. S. 594; *In re Ainslie*, 4 P. R. 212; *In re Ferry, Davis & Son*, 58 L. T. N. S. 695. In *In re Gianacchi*, 58 L. J. Ch. 782, this was held to be so, though no relief was claimed in the action as for infringement of trade mark, seeing that the registration was set out in detail in the statement of claim, thus showing that it was intended to make some use of it. And in *Thompson v. Montgomery*, 41 Ch. D. 35, words registered as a trade mark were removed from the register on the application of a person who was restrained by the same judgment from using them, and Lindley, L. J., said that "it is the duty of the Court, where its attention is called to an improper entry upon the register to rectify upon an application being made." Somewhat similarly it was held in *In re Ainslie*, 4 P. R. 212, that the fact that the applicants for rectification had contracted with the proprietors of the registered words "Ben Ledl," to sell no whiskey but theirs under that name, did not prevent them from applying as persons aggrieved. In *In re Vignier*, 61 L. T. N. S. 495, the applicants were aggrieved, they having registered and used the word "Monopolo" for champagne, and the respondents having registered the similar word "Monobrut." But where the alleged grievance consists in registering a mark which is not too similar to an earlier mark, there is no grievance: *In re Lambert*, 61 L. T. N. S. 138. In *In re Batt & Co.*, 6 P. R. 493, the applicants had used the word "Brymbo" on iron and steel, and the respondents had registered the words "The Brymbo Special" for the whole of class 5, having used it only for tin-plates; and although the respondents offered to limit their registration to tin-plates, it was held that the applicants, being aggrieved by the registration as it stood, and the mark being bad in itself, it must come off altogether. There is no ground for thinking that only a person who is himself entitled to registration can be a person aggrieved: *In re Riviere*, 26 Ch. D. 48, and it is not impossible for a person who only carries on a foreign trade to be aggrieved by a wrongful registration. *Id.* If a registered proprietor becomes insolvent while proceedings to rectify his registration are pending, his representative in bankruptcy may be added as a respondent to the application for rectification: *In re Rowe*, 48 L. T. N. S. 388.

(b) These words, now inserted, remove the possibility of any question whether the Court is enabled under this section to direct any other entry than that of a name to be made. It has been decided that the Court has power to direct the correction of any entry which has been improperly made in the register, whether of a name or of a mark: *In re Arbenz*, 35 Ch. D. 248.

Rectification
by registra-
tion.

(c) It seems that the Court has no jurisdiction to rectify the register under this section, unless some entry has been made in it; and it cannot rectify the register by directing a mark to be registered after it has been refused registration by the comptroller, except upon an appeal from the comptroller to the Board of Trade, referred by the Board to the Court, under § 62: *In re Normal Co., Ltd.*, 35 Ch. D. 281. An application to register, which is opposed by another trader, is not an application to rectify under this section, but is governed by § 69: *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278. The jurisdiction to rectify by making an entry is, therefore, confined to small matters of detail.

Rectification
by removal.

(d) On an application to remove a mark from the register, the question whether it was entitled to registration must be decided as at the date when registration was effected: *Wood v. Lambert*, 32 Ch. D. 247. The burden of proof is upon the applicant for removal, but he may prove his case by the statements in or omissions from the evidence tendered on behalf of the registered proprietor: *In re Leonard & Ellis*, 26 Ch. D. 288. Consequently if the mark is

one which was inherently capable of being used as a trade mark, and the application for removal is based on an allegation that it was not used as a trade mark, but as a descriptive term, the burden of proving that it was not used as a trade mark is on the applicant. See per Cotton, L. J., *ib.* And where a word was registered in 1878 as an old mark, and an application was made in 1889 to remove it from the register on the ground that it had not been used as a trade mark before 1875, and the original proprietor and his family were dead, and his successors in business failed to prove user of the word *per se* as a trade mark on the goods before 1875, though they proved user in various other ways before that date, Kay, J., while refusing to receive in evidence the statutory declaration made by the original proprietor on applying for registration, held that the applicants for removal after so great a lapse of time had not discharged the burden which rested on them, and that the mark could not be directed to be removed from the register: *B. Edgington, Ltd. v. J. Edgington & Co.*, 6 P. R. 513.

Where it is sought to remove a trade mark from the register on the ground of its too great similarity to an earlier mark, it is necessary, when comparing the two marks, to take into consideration (1) the manner in which blanks left in the earlier mark as registered are filled in in practice; (2) the manner in which the parts common to the trade are arranged; (3) the opinion of the trade as to the probability of deception: *In re Christiansen*, 3 P. R. 54, in which Lopes, L. J., said, as to the second point, "In dealing with matters which are common to the trade, I think we must look at the combination of those different matters common to the trade, their collocation and arrangement, and if we find things that are common to the trade all inserted in a similar position, in a similar form, and in similar arrangements, so as to make the whole so similar as to be calculated to deceive, I think that is enough." As to the third point, see *Mitchell v. Henry*, 15 Ch. D. 181. It is, however, necessary, when making such a comparison, to deal with the two marks on the footing that both will be fairly used: *In re Lambert*, 61 L. T. N. S. 138, per Cotton, L. J.; and see notes to § 72.

The cases in which marks have been removed from the register are numerous, and the grounds of removal may be classified as follows:—

- (i.) Name not printed in a distinctive manner (§ 64 (1) (a)); *In re Gianacis*, 58 L. J. Ch. 782 ("Gianacis Cigarettes"); *In re Hannay*, 7 P. R. 46 ("Hannay's Electroid Anti-fouling Composition").
- (ii.) Device not distinctive, being in common use in the trade (§ 64 (1) (c)): *In re Wragg*, 29 Ch. D. 551 (Syphon, hand and glass).
- (iii.) Words not distinctive or fancy words, being in common use in the trade (§ 64 (1) (c), § 64 (3)); *In re Hyde & Co.*, 7 Ch. D. 724 ("Bank of England" Sealing-wax); *In re Lloyd & Sons*, 27 Ch. D. 646 ("La Minerva Habana" cigars); *Great Tower St. Tea Co. v. Smith*, 6 P. R. 165 ("Tower Tea").
- (iv.) Words not distinctive or fancy words, being descriptive (§ 64 (1) (c), § 64 (3)): *In re Palmer* (3), 24 Ch. D. 504 ("Braided Fixed Stars" cigar-lights); *In re Harden Star, &c., Co., Ltd.*, 55 L. J. Ch. 596 ("Hand Grenade Fire Extinguisher"); *In re Stock*, 52 L. T. N. S. 123 ("Strathmore" whiskey); *In re Lever*, Chitty, J., Dec. 3rd, 1886, following *Lever v. Goodwin*, 36 Ch. D. 1 ("The Self Washer" soap); *In re Vaughan-Jones*, North, J., June 21st, 1884 ("Glenlivet" whiskey); *In re Towgood Bros.*, 56 L. T. N. S. 394 ("The Jubilee" note-paper); *In re Ainslie*, 4 P. R. 212 ("Ben-Ledi" whiskey); *In re Laing*, L. J. N. of C. 1887, p. 102 ("Glengowrie Blend of fine old Highland Whiskey"); *In re Arbenz*, 35 Ch. D. 248 ("Gem" air-guns); *In re Waterman*, 39 Ch. D. 29.

- ("Reversi" game); *In re Perry Davis & Son*, 58 L. T. N. S. 695 ("Pain-Killer" medicine); *In re Davis & Co.*, 59 L. T. N. S. 854 ("Boköl" beer); *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820 ("Herbalin" medicine); *Great Tower St. Tea Co. v. Smith*, 6 P. R. 165 ("Tower Tea"); *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274 ("Washerine" soap); *In re Vignier*, 61 L. T. N. S. 495 ("Monobrut" champagne); *In re Batt & Co.*, 6 P. R. 493 ("The Brymbo Special" metal goods); *In re Hannay*, 7 P. R. 46 ("Electroid" Anti-fouling Composition).
- (v.) Words registered as old mark, but not used as a trade mark *per se* on the goods before 1875 (§ 64 (3)) : *In re Palmer* (3), 24 Ch. D. 504 ("Braided Fixed Stars" cigar-lights); *In re Spencer*, 54 L. T. N. S. 659 ("Diamond Cast Steel"); *In re Hayward & Sons*, 54 L. J. Ch. 1003 ("Hayward's Coker Canvas"); *In re Perry Davis & Son*, 58 L. T. N. S. 695 ("Pain-Killer Medicine"); *In re Eno*, 41 Ch. D. 489 ("Fruit Salt" medicine); *Thompson v. Montgomery*, 41 Ch. D. 35 ("Stone Ale").
- (vi.) Words registered as old mark, but used descriptively and not as a trade mark (§ 64 (3)) ; *In re Leonard & Ellis*, 26 Ch. D. 288 ("Valvoline" oil); *In re Harrison, McGregor & Co.*, 42 Ch. D. 691 ("Albion" tools).
- (vii.) A mark registered for goods for which it was not used or intended to be used : *Edwards v. Dennis*, 30 Ch. D. 454 ("Neptune" brand metal goods).
- (viii.) Registered proprietor carrying on no business (Rules of 1876, now repealed) : *In re Ralph*, 25 Ch. D. 194 ("Homewasher" machine).
- (ix.) Marks registered, though too similar to earlier marks (§§ 69, 72) : *In re Barker & Son*, 58 L. T. N. S. 23 (a sporting scene in each case); *In re Christiansen*, 3 P. R. 54 (match-box labels); *In re Hayward & Sons*, 54 L. J. Ch. 1003 ("Hayward's Coker Canvas"); *In re Metcalf*, 31 Ch. D. 454 ("Milkmaid" brand and "Dairy-maid" brand condensed milk); *In re Biegel*, 57 L. T. N. S. 247 (three-triangle devices for beer); *In re Vignier*, 61 L. T. N. S. 495 ("Monopolo" and "Monobrut" champagne); *In re Batt & Co.*, 6 P. R. 493 ("Brymbo" and "The Brymbo Special" metal goods).
- (x.) Marks inherently deceptive (§ 73) : *In re Hayward & Sons*, 54 L. J. Ch. 1003 ("Sole Makers Extra Coker" canvas); *Wood v. Lambert*, 32 Ch. D. 247 ("Eton" cigarettes, made in London, but used with addresses in St. Petersburg and Constantinople).
- (xi.) Mark registered by servant of owner : *Ex parte Lawrence Brothers*, 44 L. T. N. S. 98 (mark for printers' rollers).

In some of the above cases the marks were not absolutely expunged, but some lesser step was taken. Where a trade mark has been wrongly registered, it may be expunged *ex parte*, without waiting for the trial of an action to meet which the application is made : *In re Gianacchi*, 58 L. J. Ch. 782. Five years' registration is no bar to the removal of the mark : *Edwards v. Dennis*, 30 Ch. D. 454. And see cases in note to § 76.

Applications for rectification were refused on various grounds in the following cases : *In re Riviere*, 53 L. T. N. S. 237 ; *Meuson & Co. v. Boehm*, 26 Ch. D. 398 ; *In re Chorlton & Dugdale*, 53 L. T. N. S. 337 ; *In re James*, 33 Ch. D. 392 ; *In re Talbot*, 3 P. R. 276 ; *In re Lambert*, 61 L. T. N. S. 138 ; *In re B. Edgington, Ltd.*, 6 P. R. 513.

In *In re Palmer* (2), 22 Ch. D. 88, when the Court of Appeal had decided that the fact of five years' registration was not a legal bar to an application to expunge a mark, they refused to stay the hearing of the case with the evidence till after the determination by the House of Lords of an

appeal from their decision on the point of law. It seems that an appeal from a decision upon an application for the removal of a trade mark from the register will not be treated as an interlocutory appeal, but that the case must be heard by three judges: *In re Riviere & Co.*, 26 Ch. D. 48, *In re Leonard & Ellis*, *ib.* 288.

For Australian cases of removal from the register, see *In re Rowley & Pyne*, 9 V. L. R. (L.) 307, in which R. & P. had used a device of a horse and groom for twenty years, and D. and his predecessor in business had used a device of a horse alone for twelve years, and then R. & P. adopted and registered a device of a horse alone, and it was removed from the Victorian register on D.'s application; and *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114, in which a mark which had been registered by a person who had not used it was removed from the New South Wales register on the application of a person who had long done so.

(e) The register has been rectified by varying an entry in the following ways:— Rectification
by varying.

(i.) By restricting the goods for which the mark is registered: *Edwards v. Dennis*, 30 Ch. D. 454; *In re Metcalf*, 31 Ch. D. 454.

(ii.) By striking some part of the mark out of it: *In re Stock*, 52 L. T. N. S. 123 (word "Strathmore" struck out of a whiskey mark); *In re Vaughan-Jones*, North, J., June 21st, 1884 (word "Glenlivet" struck out of a whiskey mark); *In re Biegel*, 57 L. T. N. S. 247 (three-triangle device struck out of a beer mark); and see *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274.

(iii.) By causing a partial disclaimer to be entered on the register, as in *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Hubbuck*, M. R., June 20th, 1879; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *Humphries & Co. v. Taylor Drug Co.* (2), 59 L. T. N. S. 820; *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274, and other cases. See notes to §§ 72 and 74.

(iv.) By directing an alteration in the name of the registered proprietor. It is, however, very questionable whether this can be done, and when registration has been effected in accordance with the application, but the application was wrong in some respect, it seems that the Court will amend the register by expunging the entry, but not by varying it so as to make the registration stand in another name. Thus Hall, V. C., said, in *In re Ward, Sturt & Sharp*, 50 L. J. Ch. 347, "I cannot rectify the register where no error has been committed. The term 'rectification' is only applicable to cases in which there has been some mistake or error in the registration. In other cases the applicant must follow the course laid down for cases of assignment or transmission." So in *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98, the Master of the Rolls expunged the entry, and left the rightful owners of the mark to make a fresh application in their own names. So in *In re Farina* (4), 44 L. T. N. S. 99, he directed administration to be taken out to the estate of the deceased registered proprietor, and the administrator, when appointed, to assign to the rightful proprietor. In *In re Rust & Co.*, 44 L. T. N. S. 98, however, the same learned judge allowed a mark to be transferred from the name of an individual member of a firm, stated to be trading under the name of the firm, into the names of all the partners trading under the name of the firm. It appears to have been thought by Jessel, M. R., in *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98, that it might not be impossible for the Court to

transfer a registration from one name into another, if the registered proprietor has registered another's trade mark in his own name when he was actually employed by the true owner to register it for him, and was so the agent and trustee for the other. In that case there was no agency, and no such order was made; but in *In re Australian Wine Co., Ltd.*, 61 L. T. N. S. 427, where the sole consignee in England of the wine from certain Australian vineyards had registered the name of the vineyards as his own trade mark, but intending it to be for the benefit of the owner of the vineyards, an order transferring the mark into the name of the owner of the vineyards was made. In *In re Riviere*, 53 L. T. N. S. 237, however, the Court of Appeal seem to have been decidedly of opinion that such an order could not be made, and Cotton, L. J., said: "In my opinion, whatever might be the result of the application to strike the name of the French firm off the register, the other application ought not to be granted. Without saying that it is impossible to grant such an application as this in any case where one person is improperly on the register, and another person who is entitled to the trade mark wishes to be put on, yet, as a rule (and I do not know a case where there would be an exception), when any one applies in the first instance to be publicly registered as the proprietor of a trade mark, the requirements of the Act and Rules as to issuing advertisements and otherwise ought to be complied with. For there may be cases—and I can imagine them—where, although the person applying to strike a name off the register may be entitled to say, as against the person on the register, that he is improperly registered as owner of the trade mark, yet there may be persons, not present at the litigation, who have a right, as against the applicant, to rectify the register, and to say that such applicant is not himself entitled to be there so as to prevent such third person from using the mark. I have thought it right to express my opinion on that part of the case at once." And Lindley, L. J., added: "If the applicants had succeeded in making out a case to remove the name of Riviere & Co., I do not think they would have been entitled to have themselves registered in respect of this mark. I think Mr. Stirling's observation is conclusive—that they could not have registered anew in respect of the old mark without advertising and taking the other steps required by the Act and Rules. I say that on behalf of the public." The same view was taken independently by Kay, J., in *Ex parte Kingsford & Son*, 61 L. T. N. S. 426. The most expedient course to adopt in such cases, where the parties are friendly, is indicated by the case of *In re Wellcome*, 32 Ch. D. 213, where an agent had registered his foreign principal's mark in his own name, but for the benefit of the principal, and subsequently assigned the trade mark to the principal, and it was held that the assignment was an assignment in connection with the goodwill, within § 70, and ought to be registered. A very special order was made in *In re Avril*, Stirling J., April 20th, 1888, in which persons to whom the registered proprietor of a trade mark had assigned her business and goodwill, with the right to use the trade mark, all for a limited period of six-and-a-quarter years, at the end of which period those rights were to revert to her, procured themselves to be registered as the proprietors of the trade mark in succession to their assignor; but, on her making complaint, they applied to the Court to restore the register to its previous condition, and it was accordingly ordered that the register should be rectified by removing their

names as subsequent proprietors of the mark and re-entering the name of the original proprietor. In *In re Patent Plumbago Crucible Co.* (2), Stirling, J., March 21st, 1890, two trade marks were registered in 1879 as the property of the Patent Plumbago Crucible Co., an unregistered company. In 1882 the Company assumed the name of "The Morgan Crucible Co.," and in 1890 the marks were allowed to be transferred into the name of "The Morgan Crucible Co., formerly trading as the Patent Plumbago Crucible Co. In America a partner who registered in his own name a trade mark of the firm was ordered to assign to his partner an equal interest in it: *Taylor v. Bothin*, 5 Sawy. 584.

(f) It has been held that opposed applications for the registration of trade marks are not within this section, and that the Court has no jurisdiction to give a successful opponent his costs of the proceedings in the Registry Office: *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278; following *In re Brandreth*, 9 Ch. D. 618. As to the costs of applications to remove marks, see Chap. 7, *sub fine*. Where the comptroller is served with notice of the application, as he now must be (Rule 49), and appears, his costs are ordered to be paid by the unsuccessful party.

(g) See Rule 46 and Form N in the 2nd Schedule. The order is to be carried into effect by the comptroller (Rule 46), and to be made public if he thinks fit (Rule 50).

91. The comptroller may (a), on request in writing accompanied by the prescribed fee (b),—

Power for
comptroller to
correct clerical
errors.

(a.) Correct any clerical error (c) in or in connection with an application for a patent, or for registration of a design or trade mark; or

(b.) Correct any clerical error (c) in the name, style or address of the registered proprietor of a patent, design, or trade mark.

(c.) Cancel the entry or part of the entry of a trade mark on the register (d): Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark (e).

[(d.) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.]

The amendment in this section was made by § 24 of the Act of 1888.

(a) In addition to the powers given by this section, the comptroller has authority, under Rule 48, to alter in the register the address of the proprietor of a trade mark (see Form M), and, under Rule 54, to allow amendments of documents.

(b) By the First Schedule the fee for altering address, or allowing correction of a clerical error, or cancelling the whole or part of an entry, or permitting amendment, is 5s.

(c) For form of request, see Form Q.

(d) This comes from the old Rules. For form of application for cancellation, see Form O. In *In re Lysaght*, Dig. 623, a registration for all the

goods in Class 5 was, on application by the proprietor, corrected by limitation to galvanised sheet iron only. In *Ex parte Sales, Pollard & Co.*, Dig. 620, the registered proprietors of a trade mark for snuff, consisting of the letters "S. P.," the initials of their firm, discovered that that mark had been for many years in common use in the snuff trade, though used originally by themselves, and procured the cancellation of the registration.

(e) See Rule 61, and for Form of Declaration see Form P.

Alteration of registered mark.

92.—(1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter (a) such mark in any particular, not being an essential particular (b) within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

(2.) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant (c); and the comptroller shall be entitled to be heard on the application.

(3.) If the Court grants leave, the comptroller shall, on proof thereof (d) and on payment of the prescribed fee (e), cause the register to be altered in conformity with the order of leave.

(a) This section is taken from the old Rules.

Alteration of trade marks.

(b) For what is an "essential particular," see § 64. *supra*. In *Ex parte Walker & Co.*, Dig. 624, a trade mark consisting of the letter "W.," a crown, and the word "Netherton" was allowed to be altered by substituting "Dudley" for "Netherton." In *Ex parte Lazenby*, V.-C. M., Feb. 26th, 1880, a trade mark was allowed to be altered by varying the address and changing the type in which it was printed. In *In re Dewhurst*, M. R., June 11th, 1880, a trade mark which had been assigned was not allowed to be altered by substituting the name of the assignee for that of the assignor, that being printed in the form of a signature, so as to constitute an essential particular; but in a similar trade mark, which had the name of the assignor printed in ordinary type, the substitution was allowed to be made. See also *In re Murphy & Co.*, W. N. 1890, p. 84. In *In re Board*, M. R., March 25th, 1881, persons who were registered as proprietors of a trade mark which contained a former name of their firm in ordinary type, were allowed to remove the name from the mark, leaving the space a blank, with permission, when using the mark, to insert in that space the name of the firm for the time being. In *In re Moeller & Schreiber*, Kay, J., March 7th, 1888, the letters "M. & S." were allowed to be substituted for the letters "D. G. F. H." In *In re Bloxwich Iron & Steel Co., Ltd.*, Chitty, J., Nov. 24th, 1887, the word "Bloxwich" was allowed to be substituted for the words "Birchills Hall." In *In re British Tea and Trading Association, Ltd.*, North, J., Oct. 26th, 1886, the registered trade mark consisted of three sides of a wrapper for packets of tea, of which those on the right and left consisted of arrangements of Chinese words, and that in the centre of the head of a mandarin, with the words "The British Tea Association" above it, and below it the words "Imperial Mandarin Tea, imported direct from the Imperial district in China," and leave was given to alter it by substituting for the words "imported direct from the Imperial district in China" (which had never been used by the applicants themselves, and not by their predecessors in business since 1877) the words, "This label is protected by registration as a trade mark." In *In re Ermen & Roby*, 56 L. J. Ch. 177, leave was given to alter a registered trade mark on which were words in Russian, by changing a capital E from the English into the Russian character and

inserting the word "of." In *In re Reiss Brothers*, 5 P. R. 291, the registered mark consisted of a combination mark for cotton piece goods, which comprised various words and devices, including their name and address, "Reiss Brothers, Manchester," and the words "Grass Bleach—Best Quality." "Grass Bleach" was the name of a description of bleaching which had gone out of use, and leave was given to alter the word "Grass" to "Reiss," notwithstanding that another combination mark, registered for similar goods, bore the name "Reiss & Co., Batavia," the remainder of the latter's mark being quite dissimilar from the applicant's mark. In *In re Guinness, Son & Co., Ltd.*, 5 P. R. 316, the firm of Arthur Guinness, Son & Co. had registered an oval label bearing, with other words and a device of an Irish harp, the printed signature, "Arth. Guinness, Son & Co.," and the goodwill and trade marks of the firm having been subsequently assigned to a limited company called "Arthur Guinness, Son & Co., Ltd.," leave was given to alter the registered trade mark by adding the word "Limited" in ordinary type beneath the signature. In *In re Ind, Coope & Co., Ltd.*, Stirling, J., June 22nd, 1888, and *In re Allsopp & Sons, Ltd.*, Chitty, J., July 6th, 1888, the word "Limited" was similarly allowed to be added on the trade marks after the name of the firm; and in *In re Bryant & May, Ltd.*, 4 Times L. R. 675, Stirling, J., said that such leave would be given as a matter of course. In *In re Jones & Co.*, Chitty, J., July 20th, 1883, on the other hand, the word "Limited" was allowed to be expunged. The addition of non-essential matters does not deprive a mark of the benefit of the period of user before the addition: *In re Bryant & May, Ltd.*, 4 Times L. R. 675.

(c) Notice must be given to the comptroller fourteen days before the application. See Rule 51.

(d) As to mode of notifying the order to the comptroller, see Rule 46 and Form N.

(e) *I.e.*, 10s. See First Schedule. Representations of the mark as altered are also to be supplied. See Rule 51.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Falsification of entries in registers.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent (a).

Exercise of discretionary power by comptroller.

(a) See Rules 17-19 as to the exercise by the comptroller of his discretionary powers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers (a) for directions in the matter.

Power of comptroller to take directions of law officers.

(a) The Attorney-General or Solicitor-General for England. See § 117.

Certificate of
comptroller to
be evidence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima-facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone (a).

(a) This section is somewhat modified from § 8 of the Act of 1875, by which the certificate of the registrar was made evidence. Now the certificate is to be *prima facie* evidence only.

By § 77, *supra*, the comptroller is authorised to grant a certificate of refusal to register an old mark (see Forms L and T), and by Rule 60 he may give a certificate, when required so to do, for the purpose of any legal proceeding or other special purpose, and on so doing shall specify on the face of it the purpose for which it is granted. (See Forms R, S, and T 1.)

See Instructions *infra*, paragraphs 35-37, in which it is stated that the comptroller's certificate in relation to a trade mark is of four kinds, viz:—

- (i.) For use in legal proceedings.
- (ii.) For use in applying for registration in foreign countries.
- (iii.) Of any application made and of proceedings thereon.
- (iv.) A certificate of refusal of a mark in use before the 13th August, 1875, and not registrable.

Applications
and notices by
post.

97.—(1.) Any application, notice or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post (a).

(a) See Rule 16.

Provision as
to days for
leaving docu-
ments at
office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office, shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Declaration
by infant,
lunatic, &c.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none,

any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted (a).

(a) This section, so far as it relates to trade marks, comes from the old Rules.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Transmission of certified printed copies of specifications, &c.

101.—(1.) The Board of Trade may from time to time make such general rules (a) and do such things as they think expedient, subject to the provisions of this Act—

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

(a.) For regulating the practice of registration under this Act:

(b.) For classifying goods for the purposes of designs and trade marks (b):

(c.) For making or requiring duplicates of specifications, amendments, drawings, and other documents:

(d.) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments, and other documents:

(e.) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(f.) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications

to patentees and to public authorities, bodies, and institutions at home and abroad :

(g.) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid (c).

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

(a) The power of making rules was formerly, by § 7 of the Act of 1875, vested in the Lord Chancellor. For the rules which have been made by the Board of Trade, see *infra*.

(b) See classification in Third Schedule to Rules.

(c) See Forms in Second Schedule to Rules. A new Form F is thereby substituted for Form F appended to the Act.

Annual
reports of
comptroller.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries and allowances, and other money received and paid under this Act.

Proceedings
of Board of
Trade.

[102 A.—(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or

to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.]

This section was introduced by § 25 of the Act of 1888.

International and Colonial Arrangements.

103.—(1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants (a); and such patent or registration shall have the same date as the *date of the protection obtained* [date of the application] in such foreign state.

International arrangements for protection of inventions, designs, and trade marks.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months (b), from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark:

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any trade mark the registration of which has been duly

applied for in the country of origin may be registered under this Act (c):

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state (d).

(a) This section is new. The amendment in it was made by § 6 of the Act of 1885. In the case of trade marks used by aliens, the existence of a convention between the state to which the alien belongs and the British Government is not a necessary condition precedent to his registration here. The Act does not say that to obtain priority the application for registration in a foreign state with which there is a convention must have been made by a subject of that state. That is apparently the intention of the section; but there is nothing to say that the same priority is to be refused to a subject of a different state, with which there may possibly be no convention, or even to a British subject, who has applied in a country with which there is a convention. On the other hand, in the proviso in subs. (3) the term "country of origin" is employed. Again, in subs. (3) the words are "has been *duly* applied for," whereas in subs. (1) there is nothing about "duly," and for all that appears the application may be one which could not possibly succeed in the foreign country. The object of this section is to enable effect to be given to the International Convention of 1883. See Appendix C. The exceptional rights of foreigners in respect of the registration of trade marks in the United Kingdom depend exclusively upon the terms of this Act, and the Court cannot have reference to the terms of the International Convention, 1883: *In re Californian Fig Syrup Co.*, 40 Ch. D. 620. Similarly, in the United States, the Courts cannot give effect to the convention without legislation. See opinion of the Attorney-General of the United States in 47 U. S. Pat. Gaz. 397.

(b) The application within four months is imperative, and if application is made after that time all special rights under this section are gone. And this is so though the foreign registration was effected before this section was made applicable to the particular foreign country: *In re Californian Fig Syrup Co.*, 40 Ch. D. 620. If a subject or citizen of a foreign state which is a party to the convention has registered in England a mark which is of doubtful validity according to English law, and is desirous of obtaining for it the benefits of this section (particularly subs. (3)), it seems that his proper course is to obtain its removal from the English register, and then to make an application for protection in his own country. Upon this being done, he will be in a position to apply again (within the four months) for registration in England under this section: see, per Kay, J., in *In re Vignier*, 61 L. T. N. S. 495.

(c) This subsection appears to qualify for registration in England any trade mark duly applied for in a country which has acceded to the convention, if the prescribed conditions are complied with, even though it is not within § 84: *In re Californian Fig Syrup Co.*, 40 Ch. D. 620. The proviso in this subsection gives no independent right of registration, but must be read with subs. (1), which requires application within four months: *Ib.*

(d) For list of Orders in Council, see Appendix C.

Provision for
Colonies and
India.

104.—(1.) Where it is made to appear to Her Majesty that the legislature of any British possession (a) has made satisfactory

provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession (b).

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

(a) See the definition of "British possession" in § 117, *infra*.

(b) For list of Orders in Council, see Appendix C.

Offences.

105.—(1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same (a), or describes any design or trade mark (b) applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction (c) to a fine not exceeding five pounds. Penalty on falsely representing articles to be patented.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article (d).

(a) This section, so far as it relates to an untrue representation as to the existence of a patent, is in substance a re-enactment of § 7 of 5 & 6 Will. IV. c. 83. In that case, however, the penalty of £50 was imposed, recoverable in an action, and a fraudulent intention was of the essence of the offence. See *Myers v. Baker*, 3 H. & N. 802. This section appears to follow that in not imposing a penalty where there has been a patent, though it may have expired. Under the U. S. Revised Statutes a penalty is imposed for a misrepresentation as to the existence of a patent, but there is no offence if there has been a patent and the date of the patent is given. See *Wilson v. Singer Manufacturing Co.*, 16 U. S. Pat. Gaz. 1091. But it is an offence to represent that an article is patented, after application has been made for a patent and provisional protection has been obtained, but before the actual grant: *R. v. Wallis*, 3 P. R. 1; *R. v. Crampton*, 3 P. R. 367.

See § 3 (1) (e) of the Merchandise Marks Act, 1887.

(b) Hitherto no penalty has been recoverable for untruly representing that a trade mark is registered. An offence is committed if a trade mark is represented to be registered before it actually is so, even though application for registration has been made and advertised: *R. v. Morris*, Great Marlborough Street Police Court, Dec. 16th, 1886.

(c) As to "summary conviction" in Ireland, see § 117.

(d) See Ch. 7, *ante*.

Penalty on unauthorised assumption of Royal Arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal Arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid (a), shall be liable on summary conviction (b) to a fine not exceeding twenty pounds (c).

(a) This section is new. For an offence against it to be committed it is not sufficient to prove that a person is using the Royal Arms without authority, or that what he is doing is calculated to lead to the belief that the user of the arms is authorised; but it must be proved that that user is calculated to lead to the belief that the trader is *carrying on his business* by Royal or Governmental authority.

(b) As to "summary conviction" in Ireland, see § 117.

(c) The following notice has been published in the *London Gazette*:—

"FRIDAY, FEB. 22ND, 1884.

"BOARD OF GREEN CLOTH, BOOKINGHAM PALACE, FEB. 19TH.

"Notice is hereby given that by section 106 of the Patents, Designs, and Trade Marks Act, 1883 (46 & 47 Victoria, cap. 57), a penalty of £20 is incurred by any persons who, without proper authority, assume the Royal Arms with a view to lead other persons to believe that they are employed under any department of Her Majesty's Household.

"SYDNEY, Lord Steward."

It will be observed that the above notice treats fraudulent intention as of the essence of the offence; but this does not appear to be in accordance with the provisions of the section.

See § 20 of Merchandise Marks Act, 1887, as to false representations with reference to holding a Royal warrant.

Scotland, Ireland, &c.

Saving for courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

For the purposes of this section "Court of Appeal" shall mean any court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Proceedings for revocation of patent in Scotland.

109.—(1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having

interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

110.—All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only. Reservation of remedies in Ireland.

111.—(1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland. General saving for jurisdiction of courts.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

112. This Act shall extend to the Isle of Man, and— Isle of Man.

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts;

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

[112 A.—The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied. Jurisdiction of Lancashire Palatine Court

for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster, in pursuance of this section, shall be subject to the like appeal as decisions of that Court in other cases.]

This section was introduced by § 26 of the Act of 1888.

Repeal; Transitional Provisions; Savings.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

- (a.) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending (a), or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or
- (b.) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or
- (c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

(a) Applications under the Act of 1875 had to be decided under that Act: *In re Hudson*, 32 Ch. D. 311. But § 63 applied to applications pending at the date of the passing of this Act, and not completed within twelve months by the applicants' default: *In re Hayward & Co.*, 54 L. J. Ch. 1003.

Former registers to be deemed continued.

114.—(1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2.) The registers of designs and of trade marks (a) kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

(a) The register of trade marks was previously to this Act kept under the authority of the Trade Marks Registration Act, 1875 (38 & 39 Vict. c. 91, by § 1 of which it was established), and the amending Acts (39 & 40

Vict. c. 33, and 40 & 41 Vict. c. 37). Those Acts placed the register under the superintendence of the then Commissioners of Patents, now abolished. See *in re Meikle*, 24 W. R. 1067; *In re Burrows*, 5 Ch. D. 353-61; *In re Rotherham*, 11 Ch. D. 250; 14 *ib.* 585.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered, or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act (a). Saving for existing rules.

(a) Rule 63 repeals all the old Rules.

116. Nothing in this Act shall take away, abridge, or pre-judicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof. Saving for prerogative.

General Definitions.

117. In and for the purposes of this Act, unless the context otherwise requires,— General definitions.

“Person” includes a body corporate:

“The Court” means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty’s High Court of Justice in England (a):

“Law Officer” means Her Majesty’s Attorney-General or Solicitor-General for England:

“The Treasury” means the Commissioners of Her Majesty’s Treasury:

“Comptroller” means the Comptroller-General of Patents, Designs, and Trade Marks:

“Prescribed” means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

“British possession” means any territory or place situate within Her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man; and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

“Legislature” includes any person or persons who exercise legislative authority in the British possession ; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland “summary conviction” means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

(a) See § 112 A, *suprà*.

SCHEDULES.

THE FIRST SCHEDULE.

Forms of Application, &c. (a).

(a) The only Form relating to trade marks is Form F., for which an amended Form F. is substituted by the Trade Marks Rules, *q.v. infra*.

THE SECOND SCHEDULE.

Fees on Instruments for obtaining Patents and Renewal.

THE THIRD SCHEDULE.

Enactments Repealed.

*	*	*	*	*	*
38 & 39 Vict. c. 91.	[1875].	—	The Trade Marks Registration Act, 1875.		
39 & 40 Vict. c. 33.	[1876].	—	The Trade Marks Registration Amendment Act, 1876.		
40 & 41 Vict. c. 37.	[1877].	—	The Trade Marks Registration Extension Act, 1877.		

THE PATENTS, DESIGNS, AND TRADE MARKS
(AMENDMENT) ACT, 1885.

48 & 49 VICT. c. 63.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[14th August, 1885.]

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the Principal Act). Construction and short title.

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

2-5. [These sections relate exclusively to Patents].

6. In subs. 1 of § 103 of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained." Amendment of § 103 of 48 & 47 Vict. c. 57.

THE PATENTS ACT, 1886.

49 & 50 VICT. c. 37.

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.

[25th June, 1886.]

WHEREAS (preamble).

Be it therefore enacted * * * * as follows:

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886. Short title and construction.

[This Act relates exclusively to Patents and Designs.]

THE PATENTS, DESIGNS, AND TRADE MARKS
ACT, 1888.

51 & 52 VICT. c. 50.

*An Act to amend the Patents, Designs, and Trade Marks
Act, 1883.*

[24th December, 1888.]

46 & 47 Vict.
c. 57. WHEREAS it is expedient to amend the Patents, Designs,
and Trade Marks Act, 1883, hereinafter referred to as the
principal Act :

Be it therefore enacted by the Queen's most Excellent
Majesty, by and with the advice and consent of the Lords
Spiritual and Temporal, and Commons, in this present
Parliament assembled, and by the authority of the same,
as follows :

1. [This section establishes a register of patent agents.]

2-5. [These sections relate to Patents].

6, 7. [These sections relate to Designs].

Amendments
of 46 & 47
Vict. c. 57,
§ 62, as to
application
for registra-
tion.

8.—(1.) In subs. 2 of § 62 of the principal Act for the
words "the patent office in the prescribed manner" shall be
substituted the words "such place and in such manner as may
be prescribed."

(2.) To the same section of the principal Act the following
subsection shall be added :

"(6.) Where an applicant for the registration of a trade
mark otherwise than under an international conver-
tion is out of the United Kingdom at the time of
making the application he shall give the comptroller
an address for service in the United Kingdom, and
if he fails to do so the application shall not be pro-
ceeded with until the address has been given."

§ 63, as to
limit of time
for pro-
ceeding with
application.

9. In § 63 of the principal Act for the words "the
application shall be deemed to be abandoned" shall be sub-
stituted the words "the comptroller shall give notice of the
non-completion to the agent employed on behalf of the appli-
cant; and, if at the expiration of fourteen days from that
notice the registration is not completed, shall give the like
notice to the applicant, and, if at the expiration of the latter
fourteen days, or such further time as the comptroller may in
special cases permit, the registration is not completed, the
application shall be deemed to be abandoned."

§ 64, as to
fancy words.

10.—(1.) For § 64 of the principal Act the following section
shall be substituted, namely :

“64.—(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

- (a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or
- (b.) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or
- (c.) A distinctive device, mark, brand, heading, label, or ticket; or
- (d.) An invented word or invented words; or
- (e.) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

“(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them; but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“(3.) Provided as follows:

- (i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:
- (ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.”

11. In § 67 of the principal Act the words “or colours” shall be added after the word “colour” in each place where that word occurs. § 67, as to colours of trade marks.

12. In § 68 of the principal Act after the word “comptroller” shall be added the words “unless the comptroller refuse to entertain the application.” § 68, as to advertisement of applications.

13.—(1.) In subs. 1 of § 69 of the principal Act for the words “two months” shall be substituted the words “one month or such further time, not exceeding three months, as the comptroller may allow.” § 69, as to opposition to registration.

(2.) In the same subsection the word "first" shall be omitted.

(3.) In subs. 2 of the same section for the words "two months" shall be substituted the words "one month."

(4.) For subs. 3 and 4 of the same section the following subsections shall be substituted, namely :

"(3.) If the applicant sends such counter-statement the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered; but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

"(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

"(5.) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

"(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom."

§ 72, as to restrictions on registration.

14. In subs. 2 of § 72 of the principal Act the following words shall be added at the beginning of the subsection, namely, "except as aforesaid," and for the words "so nearly resembling" shall be substituted the words "having such resemblance to."

§ 73, as to restriction on registration.

15. In § 73 of the principal Act the word "exclusive" shall be omitted.

§ 74, as to additions to trade marks.

16. For subs. 2 of § 74 of the principal Act the following subsection shall be substituted, namely :

"(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"Provided that a person need not under this section

disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof."

17. For § 75 of the principal Act the following section shall be substituted, namely: § 75, as to effect of registration.

"Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been the date of the registration."

18. After § 77 of the principal Act the following section shall be added and numbered 77A, namely: Certificate as to exclusive use and costs thereon.

"In an action for infringement of a registered trade mark the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same."

19.—(1.) In subs. 5 of § 79 of the principal Act for the words "five years" shall be substituted the words "one year." § 79, as to removal of trade mark from the register.

(2.) To the same subsection the following words shall be added; namely, "unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

20.—(1.) For subs. 2 of § 81 of the principal Act the following subsection shall be substituted: § 81, as to Sheffield marks.

"(2.) The Cutlery Company shall enter in the Sheffield Register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying 38 & 39 Vict. c. 91.

on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield Register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

(2.) In subs. 3 and 8 of the same section for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3.) For subs. 7 of the same section the following subsection shall be substituted :

"(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register."

(4.) To the same section the following subsections shall be added, namely:

"(14.) For the purposes of this section the expression 'metal goods' means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield Register a certificate under the hand of the Master of the Cutlers' Company shall have the same effect as the certificate of the comptroller."

21. In § 87 of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to." § 87, as to entry of assignments, &c.

22. In § 88 of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to." § 88, as to inspection.

23. In § 90 of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars." § 90, as to rectification register.

24. To § 91 of the principal Act the following subsection shall be added, namely: § 91, as to correction of errors.

"(d.) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered."

25. After § 102 of the principal Act the following section shall be added and numbered 102A, namely: Proceedings of Board of Trade.

"(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified."

26. After § 112 of the principal Act the following section shall be added and numbered 112A, namely: Jurisdiction of Lancashire Palatine Court.

"The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression 'the court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in

pursuance of this section shall be subject to the like appeal as decisions of that court in other cases."

Construction
of principal
Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act (a).

(a) In *In re Burgoyne*, 61 L. T. N. S. 39, Chitty, J., said that when an application was made before the commencement of this Act a right had been acquired to have the mark registered under the Act of 1883, subject to opposition and the like. But in *In re Baschiera*, 33 Sol. J. 469, the same learned judge said that the point must still be considered open.

Commence-
ment of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

TRADE MARKS RULES, 1890.*

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

PRELIMINARY.

1. These Rules may be cited as the Trade Marks Rules, 1890, and shall come into operation from and immediately after the 31st day of December, 1889.

INTERPRETATION.

2. In the construction of these Rules any words herein used defined by the said Acts (a) shall have the meanings thereby assigned to them respectively.

(a) See § 117.

FEES.

3. The fees to be paid in pursuance of the said Acts, so far as they relate to trade marks, shall be the fees specified in the first schedule hereto (a).

(a) See § 80. The fees are to be paid by stamps. See Instructions, par. 2, *infra*.

FORMS.

4. The Form F in the first schedule to the Patents, Designs, and Trade Marks Act, 1883, shall be altered or amended by the substitution therefor of the Form F in the second schedule to these Rules (a).

(a) For this Schedule see Appendix B *infra*. See Instructions, par. 5, *infra*, for list of stamped forms.

* Under the Trade Marks Registration Acts three successive sets of Rules were made, one in 1875, one in 1876 (which was considerably altered from time to time), and the last in March 1883. All these were repealed by the Rules of Dec. 1883, made under the Act of that year, to

which later additions were made from time to time, especially in 1889. All these are now repealed (see Rule 63, *infra*). The repealed Rules as to cotton marks are printed in Appendix D, in order to enable the position of such marks to be understood.

5. (1) An application for registration of a trade mark shall be made in the Form F in the second schedule to these Rules; (2) the remaining forms in such schedule may be used in all cases to which they are applicable.

CLASSIFICATION OF GOODS.

Classification of goods.

6. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the third schedule hereto.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the comptroller (a).

(a) See § 65. A guide to the classification can be obtained on application at the office. See Instructions, par. 19, *infra*.

APPLICATION FOR REGISTRATION.

Application by firm.

7. An application (a) for registration of a trade mark, if made by any firm or partnership, may be signed (b) by some one or more members of such firm or partnership, as the case may be.

If the application be made by a body corporate it may be signed (c) by the secretary or other principal officer of such body corporate.

(a) See § 62. For mode of making application, see also Instructions, para. 8-19, *infra*. A separate form is required for each class—par. 10. As to disclaimer of common or open marks, see § 74, and Instructions, par. 18.

(b) A member signing an application should add after his signature, "A member of the firm." See Instructions, par. 11.

(c) The officer signing should add after his signature and designation, "For the Company." See Instructions, par. 11.

Address of application.

8. Where a trade mark for registration of which application is made is in classes 23, 24 or 25 of the third schedule to these Rules, the applicant shall address and send his application to the Manchester Trade Marks Branch, 48, Royal Exchange, Manchester (a). Other applications (except applications which under § 81 of the said Acts should be made to the Cutlers' Company (b), shall be addressed and sent to the Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

(a) See Instructions, par. 34.

(b) See Rules 56-59, and Instructions, par. 33.

Agency.

9. An application for registration and all other communications between the applicant and the comptroller may be

made by or through an agent duly authorised to the satisfaction of the comptroller (a).

(a) An agent signing should add after his signature the word "Agent."
See Instructions, par. 12.

10. On receipt of the application the comptroller shall furnish the applicant with an acknowledgment thereof. Acknowledgment of application.

11. Where application is made to register a trade mark which was used (a) by the applicant or his predecessors in business before the 13th of August, 1875 (b), the application shall contain a statement (c) of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application. Contents of form of application.

(a) *I.e.*, in respect of the same goods for which the application is being made. Registration must be applied for as for a new mark when the mark has been used on different goods. See *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Edwards v. Dennis*, 30 Ch. D. 454.

(b) This is the date of the passing of the Act of 1875, and at this point the line is drawn between old and new marks, various indulgences being allowed to the former and not to the latter. See notes to §§ 64 and 72.

(c) Prior to 1883 a statutory declaration was required, since then a mere statement has been sufficient.

12. Subject to any other directions that may be given by the comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the comptroller or to the Cutlers' Company (a), shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half. Size, &c., of documents.

(a) See § 81; also Rules 56-59, and Instructions, par. 33.

13. Subject to any other directions that may be given by the comptroller, three representations (a) of each trade mark, except in the case of marks applied for in classes 23 to 35 inclusive (b), must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half-sheets. In the case of trade marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap (c). Representations of trade mark.

In the case of marks applied for in classes 23 to 35 inclusive, the applicant shall supply four representations (d) of each mark for each class.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the comptroller may think most convenient.

The comptroller may, if dissatisfied with the representation of a trade mark, require a fresh representation, either before he proceeds with the application or before he registers the trade mark.

The comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit (e).

(a) See § 62 (3), and Instructions, pars. 15, 16.

(b) These are the textile classes.

(c) See Instructions, par. 16.

(d) One of them will be exhibited at the Manchester Office.

(e) As to deposit, see note to § 67. All cotton marks are deposited, but other marks have been deposited in exceptional cases only. See *In re Robinson*, 29 W. R., 31; *Mitchell v. Henry*, 15 Ch. D. 181; *In re Jones Bros. & Co.*, V.-C. H., July 10th, 1880.

Representations of a series of trade marks.

14. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in § 66 of the said Acts, a representation of each trade mark of the series shall be made or affixed upon the form of application and also upon each of the separate half-sheets of paper aforesaid (a).

(a) See Instructions, par. 17.

Translation of foreign characters.

15. Wherever a mark consists of or includes words printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words, signed by the applicant or his agent (a).

(a) See Instructions, par. 14, and *In re Rotherham*, 11 Ch. D. 250; 14 *ib.* 585.

Mode of sending notices, &c.

16. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post (a).

In proving such service or sending, it shall be sufficient to

prove that the letter was properly addressed and put into the post.

(a) See § 97, and Instructions, pars. 1, 8, and 33. Communications relating to different applications should be made in separate letters. See Instructions, par. 8.

EXERCISE OF DISCRETIONARY POWERS.

17. Before exercising any discretionary power (a) given to Hearing by the comptroller by the said Acts adversely to the applicant for comptroller. registration of a trade mark, the comptroller shall (if so required by the applicant within one month from the date of the comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard.

(a) See § 94.

18. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to the comptroller whether or not he intends to be heard upon the matter. Notice of wish to be heard before comptroller.

19. The decision of the comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant. Notification of decision.

APPEAL TO THE BOARD OF TRADE.

20. When any person intends to appeal to the Board of Trade (a) from a decision of the comptroller in any case in which an appeal is given by the said Acts, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Trade Marks Branch, a notice of such his intention. Notice of appeal.

(a) See §§ 62 and 69.

21. Such notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof (a). Grounds of appeal to be stated.

(a) See Forms H (p. 469, *infra*) and 4 (p. 499, *infra*).

22. A copy of the notice of intention to appeal, accompanied by a statement of the case, shall also be forthwith sent to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London; and where there has been an opposition before the comptroller to the opponent or applicant as the case may be. Transmission of notice.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same. Directions by Board.

Hearing of appeal.

24. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the comptroller and to the appellant, and where there has been an opposition before the comptroller to the opponent or applicant as the case may be.

No appeal unless notice duly given.

25. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave of the Board of Trade.

Evidence on appeal.

26. Subject to the directions and leave of the Board of Trade, the evidence to be used on an appeal to the Board of Trade in the matter of an opposition shall be the same as that used at the hearing before the comptroller.

ADVERTISEMENT OF APPLICATION.

Advertisement of application.

27. Every application shall be advertised (a) by the comptroller in the official paper, during such times, and in such manner as the comptroller may direct, unless he refuse to entertain the application.

If no representation of the trade mark be inserted in the official paper in connection with the advertisement of an application, the comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition (b).

(a) As to advertisement, see § 68, and Instructions, pars. 20-27. "The object of the advertisement is to give to persons who might be claimants of the trade mark proposed to be registered the opportunity of coming forward and objecting," said Hall, V.-C., in *In re Meikle*, 24 W. R. 1067, and advertisement is therefore indispensable, *ib.* It is not, however, incumbent on persons to see the advertisement, and if a common mark has been registered, after advertisement, and without opposition, it may be removed from the register on application by persons aggrieved: *In re Hyde & Co.*, 7 Ch. D. 724; and marks improperly registered may be removed from the register even after they have been there for five years: *In re Palmer* (3), 24 Ch. D. 504; *In re Leonard & Ellis*, 26 Ch. D. 288, and other cases. See Notes to § 90.

(b) See Rule 13, *supra*.

Definition of official paper.

28. The official paper (a) for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

(a) The official paper is "The Trade Marks Journal" published at short intervals. It contains illustrations of all the trade marks for which application is made, or a reference to the places where they may be seen, as well as the

name, address, and calling of each applicant, the description of the goods, and the length of user as an old mark, if any, thus affording all persons interested in the use of trade marks authentic information as to the nature of the marks applied for in their respective trades. The journal may be obtained from the Patent Office, Sale Branch, 38, Cursitor Street, Chancery Lane. Copies of the journal are open to inspection at the Patent Office Library, Southampton Buildings, Chancery Lane. Upwards of 600 numbers of the journal have now been published. As to prices, see Instructions, par. 5.

29. For the purposes of such advertisements the applicant may be required to furnish a wood-block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the comptroller, or with such other information or means of advertising the trade mark as may be required by the comptroller; and the comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement (a).

Means of advertising trade mark to be supplied to official paper.

(a) See Instructions, pars. 20-27.

30. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in § 66 of the said Acts, the applicant may be required to furnish a wood-block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series (a); and the comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

Advertisement of series.

(a) See Instructions, par. 22.

OPPOSITION TO REGISTRATION.

31. (1.) A notice of opposition (a) to the registration of a trade mark shall state the ground or grounds on which the opponent intends to oppose the registration, and be signed by him or by his solicitor, and shall also contain an address for service in the United Kingdom, and shall be in the Form J in the second schedule to these Rules, with such variations as circumstances may require.

Notice of opposition.

(a) As to oppositions, see § 69 and Instructions, par. 32. The notice of opposition may be amended under rule 54, even after the counter statement has been put in: *R. v. Comptroller*, Q. B. D., May 3rd, 1890. Under the old Acts and Rules the practice was to require the opponent to take proceedings for the purpose of bringing the matter before the Court. The opponent thereupon took out a summons for directions as to the course to be followed, upon which it was usual for the applicant to be directed to apply for registration by way of motion or summons. In *In re Salamon*, Dig. 569, Jessel, M. R., said that the best mode of trying the case was by special case, when it was a simple question of law; by summons, when it was a question as to directions for carrying out the Act; by motion,

when it was a question as to disputed facts. In *In re Simpson, Davies & Sons*, 15 Ch. D. 525, he said he usually directed a summons, but had in one or two cases directed a motion. In *Ex parte King of Saxony*, Dig. 598, Hall, V.-C., directed a motion. Latterly a summons was almost invariably directed. See also *In re Johnston*, 43 L. T. N. S. 672, as to the course of procedure where there was an action pending. Under the old Rules, and while the first step had to be taken by the opponent, who had to give notice thereof to the office, two cases occurred in which trade marks were registered, though the registration was opposed, in consequence of no notice having been given to the office by the opponents of their having brought the matter before the Court. In one of these cases, *In re The Patent Nut and Bolt Screw Co.*, Chitty, J., March 9th, 1883, with a view to remedying the slip, a consent order was taken to rescind the registration, without prejudice to the applicant's summons for leave to register, the object being to restore matters to their *status quo ante* the registration. The opposition was subsequently withdrawn, but the registrar now objected to register, on the ground that the application had been finally disposed of, and that a new application was necessary. It was, however, held that the proper course was to discharge the former order for the removal of the mark from the register, and to direct the registrar to restore the register to its condition previous to such removal. In the other case, *In re Esbensen*, Pearson, J., Jan. 25th, 1883, the opponent moved to cancel the registration, with a view to the prosecution of the opposition as if there had been no registration; but it was held that the proper course was for the opponent to move to rectify the register in the ordinary way. See also *In re Paton*, Dig. 601. Under the Act of 1883 a summons for leave to register was taken out by the applicant, but the case will now only go to the Court on a reference from the Board of Trade.

Opposition on the ground of trade mark already on the register.

(2.) Where the ground, or one of the grounds, of opposition is that the applicant is applying for the registration of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the register of such trade mark already on the register.

Opponent's evidence.

(3.) Within two months after the expiration of one month or such further time not exceeding three months as the comptroller may allow (a) from the date of the advertisement of the application, the opponent shall leave at the Patent Office, Trade Marks Branch, such evidence by way of statutory declaration as he may desire to adduce in support of his opposition, and deliver to the applicant copies thereof.

(a) *I.e.*, within two months after the time allowed, under § 69 (1) of the Act of 1883, as amended by § 13 (1) of the Act of 1888, for putting in the notice of opposition.

Applicant's evidence.

(4.) * Within one month from the delivery of the opponent's copies of his statutory declarations the applicant shall leave at

* The counter-statement required by the Acts must also be delivered by the applicant within one month from the date of the receipt of the opponent's notice of opposition.

the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in answer, and deliver to the opponent copies thereof, and within seven days from such delivery the opponent shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in reply, and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply. Evidence in reply.

(5.) No further evidence shall be left on either side except by leave of the comptroller upon the written consent of the parties duly notified to him, or by special leave of the comptroller given on an application made to him. Closing of evidence.

(6.) Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application. Applications for leave to adduce further evidence.

(7.) On the completion of the evidence the comptroller shall, upon application by either party, upon Form E in the second schedule to these Rules, and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment. Appointment of time for hearing.

(8.) On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition; and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the register of the said trade mark already on the register have been duly specified in the notice of opposition. Disallowance of opposition in certain cases.

(9.) The decision of the comptroller in the case shall be notified to the parties. Decision to be notified to parties.

REGISTER OF TRADE MARKS.

32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee (a), enter the name, address, and description of the applicant in the Register of Trade Marks as the registered proprietor of the trade mark in respect of the particular goods or classes of goods described in his application. Time of registration of trade marks.

(a) See Form I and Schedule 1.

Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business.

Entries to be made in register.

Notice of registration.

Request by subsequent proprietor.

Signature of request.

Contents of request.

33. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the comptroller.

34. Upon registering any trade mark the comptroller shall enter in the register the date on which the application for registration was received by the comptroller, and such other particulars (a) as he may think necessary.

(a) As to entering "other particulars," see *In re Keep Bros.*, 26 Ch. D. 187, and *In re De Oladuy*, L. J. N. of C. 1885, p. 155.

35. The comptroller shall send notice to the applicant of the registration of his trade mark, together with a reference to the advertisement of such trade mark in the official paper.

36. Where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, a request for the entry of his name in the register as proprietor of the trade mark shall be addressed to the comptroller, and left at the Patent Office, Trade Marks Branch (a).

(a) See Form K and Instructions, par. 33.

37. Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively duly authorised to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorised in like manner (a).

(a) See Rules 7, 9, *suprà*.

38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted, in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade mark has been registered (a).

(a) See § 70 and cases in note (c) to § 90.

39. Every such request shall be accompanied by a statutory Declaration to declaration (a) to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade mark as claimed by such request. accompany request.

(a) See Form K.

40. The claimant shall furnish to the comptroller such other proof of title and of the existence and ownership of such good-will as aforesaid as he may require for his satisfaction. Further proof of title if required.

41. A body corporate may be registered as proprietor by its corporate name. Body corporate.

42. The term "applicant" in Rules 17, 18 and 19 shall include each of several persons claiming to be registered as proprietor of the same trade mark (a). Definition of applicant.

(a) See § 71.

43. Whether all such persons so claiming require to be heard before the comptroller or not, he may, before exercising the discretion vested in him by § 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the comptroller may require. Comptroller may require statement from rival claimants.

44. Where each of several persons claims to be registered as proprietor of the same trade mark, and the comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the comptroller, or if the comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case (a); and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct. Submission to Court of conflicting claims.

(a) See note to § 71.

45. Where the special case is to be submitted by the parties it may be agreed to by them, or if they differ, may be settled by the comptroller on payment of the prescribed fees (a). Settlement of special case.

(a) See Form T.

46. Where an order has been made by the Court in either of the following cases, viz. : Order of Court.

(a.) allowing an appeal under § 62 of the said Acts;

(b.) disallowing an opposition to registration under § 69; or,

(c.) under the provisions of §§ 72, 90, or 92 of the said Acts, the person in whose favour such order has been made, or such one of them, if more than one, as the comptroller may direct, shall forthwith leave at the Patent Office, Trade Marks Branch, an office copy of such order (a). The register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

(a) See Form N.

Removal of mark from register.

47. Where a trade mark has been removed from the register for non-payment of the prescribed fee or otherwise, under the provisions of § 79 of the said Acts, the comptroller shall cause to be entered in the register a record of such removal and the cause thereof.

Alteration of address in register.

48. If the registered proprietor of a trade mark send to the comptroller, together with the prescribed fee, notice of an alteration in his address, the comptroller shall alter the register accordingly (a).

(a) See Form M.

Notice to comptroller of applications to rectify register.

49. Four clear days' notice of every application to the Court under § 90 of the said Acts, for rectification of the register, shall be given to the comptroller (a).

(a) This is a new rule. Hitherto no such notice has been necessary.

Publication of rectification or variation of register.

50. Whenever an order is made by the Court for making, or varying, or varying an entry from or in the register, the comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register.

Notice to comptroller of order of Court for alteration of trade mark under § 92 of Acts.

51. Whenever the registered proprietor of any trade mark intends to apply for the leave of the Court to add to or to alter such trade mark, under § 92 of the said Acts, the notice to be given to the comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the comptroller such a number of representations of the trade mark as altered as he may deem sufficient.

INSPECTION OF REGISTER.

Hours of inspection.

52. The Register of Trade Marks shall be open to the inspection of the public (a), on payment of the prescribed fee, on every weekday, between the hours of ten and four, except on the days and at the times following :

- (a.) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or
- (b.) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;
- (c.) Times when the register is required for any purpose of official use.

(a) See § 88.

POWER TO DISPENSE WITH EVIDENCE.

53. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the comptroller, or at the Patent Office, and it is shown to the satisfaction of the comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence. Dispensing with evidence.

AMENDMENTS.

54. Any document or drawing or other representation of a trade mark for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which in the opinion of the comptroller may be obviated without detriment to the interests of any person may be corrected, if the comptroller think fit, and on such terms as he may direct (a). Amendment of documents.

(a) Under this rule leave may be given to amend a notice of opposition, even after the counter statement has been put in: *R. v. Comptroller*, Q. B. D. May 3rd, 1890. As to the comptroller's power to correct clerical errors, see 91. See also Form Q.

ENLARGEMENT OF TIME.

55. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the comptroller (a), if he think fit, and upon such notice to other parties and proceedings thereon, and upon such terms as he may direct. Comptroller may enlarge time.

(a) See, however, the limitations imposed by § 69 (1), *supra*.

CUTLERS' COMPANY.

Sheffield applications in duplicate.

56. All applications to the Cutlers' Company (a) for registration of a trade mark, under § 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

(a) See § 81, and Instructions, par. 33, also Form W.

Notice to comptroller.

57. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Time within which comptroller may object to application made at Sheffield.

58.—(1.) The time within which the comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said company shall be one month from the date of the receipt by the comptroller of the notice from the said company of the making of the application.

Advertisement of application made at Sheffield.

(2.) If no such objection is made by the comptroller, the Cutlers' Company shall require the applicant to send the comptroller a wood-block or electrotype as the comptroller may direct, and the comptroller shall, if satisfied with such wood-block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

Manner of notifying to Cutlers' Company application received by Comptroller.

(3.) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in subs. 8 of § 81 of the said Acts shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

Similarity of proceedings at London and at Sheffield.

59. The provisions of these Rules as to forms, representations, the proceedings in opposition to registration, registration, and all subsequent proceedings, shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

CERTIFICATES.

Certificate by comptroller.

60. The comptroller, when required to give a certificate as to an entry, matter, or thing which he is authorised by the said Acts or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate, but every certificate of registration shall have specified on the face thereof, whether the same is to be used in legal proceedings, or for the purpose of obtaining

registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country (a).

(a) See § 96, and Instructions, para. 35-37.

DECLARATIONS.

61. The statutory declarations (a) required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows : Manner in which, and persons before whom, declaration is to be taken.

(a.) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding ;

(b.) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding ; and

(c.) If made out of Her Majesty's dominions, before a British minister, or person exercising the functions of a British minister or a consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a judge or magistrate.

(a) As to declarations by infants and other persons under disability, see § 99.

62. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration. Notice of seal of officer taking declaration to prove itself.

REPEAL.

63. All general rules as to the registration of trade marks heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of December, 1889, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application pending at the said date. Previous rules repealed.

M. E. HICKS-BEACH,
President of the Board of Trade.

SCHEDULES.

FIRST SCHEDULE.

FEES.

	<i>£</i>	<i>s.</i>	<i>d.</i>
1. On application to register a trade mark for one or more articles included in one class	0	5	0
2. For registration of a trade mark for one or more articles included in one class	1	0	0
3. For registering a series of trade marks, for every additional representation after the first in each class	0	5	0
4. On appeal from comptroller to Board of Trade— By appellant	1	0	0
5. On notice of opposition for each application opposed.—By opponent	1	0	0
6. On hearing by comptroller.—By applicant and by opponent respectively	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
8. For every additional mark assigned or transmitted at the same time	0	2	0
9. For continuance of mark at expiration of fourteen years	1	0	0
10. Additional fee where fee is paid within three months after expiration of fourteen years	0	10	0
11. Additional fee for restoration of trade mark where removed for non-payment of fee.	1	0	0
12. For altering address on the register, for every mark	0	5	0
13. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
14. For cancelling the entry or part of the entry of a trade mark upon the register, on the application of the owner of such trade mark	0	5	0
15. On request to comptroller to correct a clerical error, or permit amendment of application under § 91	0	5	0

FEES—*continued.*

	£	s.	d.
16. For certificate of refusal to register a trade mark under § 77	1	0	0
17. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first	0	10	0
18. For certificate of registration to be used in legal proceedings	1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
20. For certificate of comptroller under § 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country	0	5	0
21. For copy of notification of registration	0	2	0
22. Settling a special case by comptroller	2	0	0
23. For inspecting register, for every quarter of an hour	0	1	0
24. For making a search amongst the classified representations of trade marks, for every quarter of an hour	0	1	0
25. For office copy of documents, for every 100 words (but never less than one shilling).	0	0	4
26. For certifying office copies, MS. or printed	0	1	0
27. In cases where the wood-block or electrotype of the trade mark exceeds two inches in breadth or depth, or in breadth and depth—For every inch or part of an inch over two inches in breadth	0	2	0
For every inch or part of an inch over two inches in depth	0	2	0
28. Manchester Trade Marks Office	Same as above		
29. Sheffield Marks	Same as above		
30. On appeal from Cutlers' Company, Sheffield, to comptroller	1	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

Approved,

FRANK MOWATT,
Assistant Secretary
for the Lords Commissioners of
Her Majesty's Treasury.

SECOND SCHEDULE.

FORMS.

(See *Appendix B, infra.*)

THIRD SCHEDULE.

GENERAL NOTE.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the comptroller may desire.

CLASSIFICATION OF GOODS.*

Illustrations.

Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.

Class 1.

Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.

Such as—

Acids, including vegetable acids.
Alkalies.
Artists' colours.
Pigments.
Mineral dyes.

Class 2.

Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.

Such as—

Artificial manure.
Cattle medicines.
Deodorisers.
Vermin destroyers.

* For further information as to the classification of goods, see Guide to the Classification, obtainable at the Patent Office on application.

Class 3.

Chemical substances prepared for use in medicine and pharmacy.

Such as—
 Cod liver oil.
 Medicated articles,
 Patent medicines.
 Plasters.
 Rhubarb.

Class 4.

Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.

Such as—
 Resins.
 Oils used in manufactures and not included in other classes.
 Dyes, other than mineral.
 Tanning substances.
 Fibrous substances (*e.g.*, cotton, hemp, flax, jute).
 Wool.
 Silk.
 Bristles.
 Hair.
 Feathers.
 Cork.
 Seeds.
 Coal.
 Coke.
 Bone.
 Sponge.

Class 5.

Unwrought and partly wrought metals used in manufacture.

Such as—
 Iron and steel, pig or cast.
 Iron rough.
 „ bar and rail, including rails for railways.
 „ bolt and rod.
 „ sheet, and boiler and armour plates.
 „ hoop.
 Lead, pig.
 „ rolled.
 „ sheet.
 Wire.
 Copper.
 Zinc.
 Gold, in ingots.

Class 6.

Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7.

Such as—

Steam engines.
Boilers.
Pneumatic machines.
Hydraulic machines.
Locomotives.
Sewing machines.
Weighing machines.
Machine tools.
Mining machinery.
Fire engines.

Class 7.

Agricultural and horticultural machinery, and parts of such machinery.

Such as—

Ploughs.
Drilling machines.
Reaping machines.
Thrashing machines.
Churns.
Cyder presses.
Chaff cutters.

Class 8.

Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.

Such as—

Mathematical instruments.
Gauges.
Logs.
Spectacles.
Educational appliances.

Class 9.

Musical instruments.

Class 10.

Horological instruments.

Class 11.

Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.

Such as—

Bandages.
Friction gloves.
Lancets.
Fleams.
Enemas.

Class 12.

Cutlery and edge tools.

Such as—
Knives.
Forks.
Scissors.
Shears.
Files.
Saws.

Class 13.

Metal goods not included in other classes.

Such as—
Anvils.
Keys.
Basins (metal).
Needles.
Hoes.
Shovels.
Corkscrews.

Class 14.

Goods of precious metals (including aluminium, nickel, Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.

Such as—
Plate.
Clock cases and pencil cases of such metals.
Sheffield and other plated goods.
Gilt and ormolu work.

Class 15.

Glass.

Such as—
Window and plate glass.
Painted glass.
Glass mosaic.
Glass beads.

Class 16.

Porcelain and earthenware.

Such as—
China.
Stoneware.
Terra cotta.
Statuary porcelain.
Tiles.
Bricks.

Class 17.

Manufactures from mineral and other substances for building or decoration.

Such as—
Cement.
Plaster.
Imitation marble.
Asphalt.

Class 18.

Engineering, architectural, and building contrivances.

Such as—
Diving apparatus.
Warming apparatus.
Ventilating apparatus.
Filtering apparatus.
Lighting contrivances.
Drainage contrivances.
Electric and pneumatic bells.

Class 19.

Arms, ammunition, and stores not included in Class 20.

Such as—
Cannon.
Small arms.
Fowling pieces.
Swords.
Shot and other projectiles.
Camp equipage.
Equipments.

Class 20.

Explosive substances.

Such as—
Gunpowder.
Gun-cotton.
Dynamite.
Fog-signals.
Percussion caps.
Fireworks.
Cartridges.

Class 21.

Naval architectural contrivances and naval equipments not included in Classes 19 and 20.

Such as—
Boats.
Anchors.
Chain cables.
Rigging.

Class 22.

Carriages.

Such as—

Railway carriages.
Waggons.
Railway trucks.
Bicycles.
Bath chairs.

Class 23.

(a) Cotton yarn, and sewing
cotton not on spools or
reels.

(b) Sewing cotton on spools or
reels.

Class 24.

Cotton piece goods of all kinds.

Such as—

Cotton shirtings.
Long cloth.

Class 25.

Cotton goods not included in
Classes 23, 24, or 38.

Such as—

Cotton lace.
Cotton braids.
Cotton tapes.

Class 26.

Linen and hemp yarn and thread.

Class 27.

Linen and hemp piece goods.

Class 28.

Linen and hemp goods not
included in Classes 26, 27,
and 50.

Class 29.

Jute yarns and tissues, and other articles made of jute not included in Class 50.

Class 30.

Silk, spun, thrown, or sewing.

Class 31.

Silk piece goods.

Class 32.

Other silk goods not included in Classes 30 and 31.

Class 33.

Yarns of wool, worsted, or hair.

Class 34.

Cloths and stuffs of wool, worsted, or hair.

Class 35.

Woollen and worsted and hair goods not included in Classes 33 and 34.

Class 36.

Carpets, floor-cloth, and oil-cloth.

Such as—
Drugget.
Mats and matting.
Rugs.

Class 37.

Leather, skins unwrought and wrought, and articles made of leather not included in other classes.

Such as—
Saddlery.
Harness.
Whips.
Portmanteaus
Furs.

Class 38.

Articles of clothing.

Such as—

Hats of all kinds.
Caps and bonnets.
Hosiery.
Gloves.
Boots and shoes.

Class 39.

Paper (except paper-hangings), stationery, and bookbinding.

Such as—

Envelopes.
Sealing wax.
Pens (except gold pens).
Ink.
Playing cards.
Blotting cases.
Copying presses.

Class 40.

Goods manufactured from india rubber and gutta percha not included in other classes.

Class 41.

Furniture and upholstery.

Such as—

Paper-hangings.
Papier mâché.
Mirrors.
Mattresses.

Class 42.

Substances used as food, or as ingredients in food.

Such as—

Cereals.
Pulses.
Olive oil.
Hops.
Malt.
Dried fruits.
Tea.
Sago.
Salt.
Sugar.
Preserved meats.

Class 42 (continued).

Confectionery.
 Oil cakes.
 Pickles.
 Vinegar.
 Beer clarifiers.

Class 43.

Fermented liquors and spirits.

Such as—
 Beer.
 Cyder.
 Wine.
 Whiskey.
 Liqueurs.

Class 44.

Mineral and aerated waters,
 natural and artificial, in-
 cluding ginger-beer.

Class 45.

Tobacco, whether manufac-
 tured or unmanufactured.

Class 46.

Seeds for agricultural and hor-
 ticultural purposes.

Class 47.

Candles, common soap, deter-
 gents; illuminating, heating,
 or lubricating oils; matches;
 and starch, blue, and other
 preparations for laundry
 purposes.

Such as—
 Washing powders.
 Benzine collas.

Class 48.

Perfumery (including toilet
 articles, preparations for the
 teeth and hair, and perfumed
 soap).

Class 49.

Games of all kinds and sporting articles not included in other classes.

Such as—
 Billiard tables.
 Roller skates.
 Fishing nets and lines.
 Toys.

Class 50.

Miscellaneous, including—

- (1.) Goods manufactured from ivory, bone, or wood, not included in other classes.
- (2.) Goods manufactured from straw or grass, not included in other classes.
- (3.) Goods manufactured from animal and vegetable substances, not included in other classes.
- (4.) Tobacco pipes.
- (5.) Umbrellas, walking-sticks, brushes and combs.
- (6.) Furniture cream, plate powder.
- (7.) Tarpaulins, tents, rick-cloths, rope, twine.
- (8.) Buttons of all kinds, other than of precious metal or imitations thereof.
- (9.) Packing and hose of all kinds.
- (10.) Goods not included in the foregoing classes.

Such as—
 Coopers' wares.

(Signed) M. E. HICKS-BEACH,
 President of the Board of Trade.

INSTRUCTIONS TO PERSONS WHO WISH TO
REGISTER TRADE MARKS.

PRELIMINARY.

1. All communications relating to Trade Marks, not being marks in Classes 23, 24, or 25, or Sheffield marks, should be addressed to the Comptroller, Patent Office, Trade Marks Branch (a). All applications should be in the English language.

They may be made by post, or left at the Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C. (See also paragraphs 8 and 33.)

(a) As to the Manchester Office, see par. 34, *infra*.

2. The fees in relation to Trade Marks Registration cannot be received at the Patent Office. They should be paid in exchange for the *stamped forms* required, which may be obtained at the following places:—

(a.) The Inland Revenue Office, Royal Courts of Justice, London (Room No. 6).

(b.) The following Post Offices in London:—

The General Post Office, E.C.

District Post Office, Lombard Street, E.C.

„ 226, Commercial Road, E.

„ 9, Blackman Street, Borough, S.E.

„ Charing Cross, W.C.

„ 28, Eversholt Street, Camden Town, N.W.

Post Office, 12, Parliament Street, S.W., or

(c.) The Chief Post Office of the undermentioned cities and towns:—

IN ENGLAND AND WALES.

Accrington.	Crewe.	Leicester.	Salford.
Altrincham.	Croydon.	Lichfield.	St. Helen's.
Ashton - under - Lyne.	Darlaston.	Lincoln.	Scarborough.
Barnsley.	Derby.	Liverpool.	Sedgley.
Barrow-in-Furness.	Dewsbury.	Macclesfield.	Sheffield.
Bath.	Doncaster.	Manchester.	Southampton.
Bedford.	Dorchester.	Middlesbrough.	Stafford.
Beverley.	Driffield.	Nantwich.	Stalybridge.
Birkenhead.	Droitwich.	Newcastle.	Stockport.
Birmingham.	Dudley.	Newport (Mon.).	Stoke-on-Trent.
Blackburn.	Durham.	Northallerton.	Stourbridge.
Bolton.	Exeter.	Northampton.	Stourport.
Bradford.	Gateshead.	Nottingham.	Sunderland.
Brighton.	Goole.	Nuneaton.	Swansea.
Bristol.	Greenwich.	Oldbury.	Tamworth.
Bromsgrove.	Guildford.	Oldham.	Truro.
Burnley.	Halifax.	Patrinton.	Tunstall.
Burslem.	Hartlepool.	Plymouth.	Wakefield.
Burton-on-Trent.	Huddersfield.	Pontefract.	Walsall.
Bury.	Hull.	Portsmouth.	Warrington.
Cambridge.	Ipswich.	Prescot.	Wednesbury.
Cardiff.	Keighley.	Preston.	West Bromwich.
Carlisle.	Kendal.	Reading.	Whitby.
Chatham.	Kidderminster.	Redditch.	Widnes.
Chester.	Knaresbro'.	Richmond (Yorks).	Wigan.
Clitheroe.	Knutsford.	Ripon.	Wolverhampton.
Congleton.	Lancaster.	Rochdale.	Wolverton.
Coventry.	Leamington.	Rotherham.	Woolwich.
	Leeds.	Rugby.	York.

IN SCOTLAND.

Aberdeen.	Inverness.
Dumbarton.	Lanark.
Dundee.	Leith.
Edinburgh.	Paisley.
Glasgow.	Perth.
Greenock.	Renfrew.

IN IRELAND.

Belfast.	Limerick.
Cork.	Londonderry.
Dublin.	Waterford.
Dundalk.	Wexford.
Galway.	

NOTE.—*Arrangements have also been made by which any of the forms required may be ordered at any Money Order Office in the United Kingdom not included in the above List.*

3. The following is a list of the stamped forms under the Patents, Designs, and Trade Marks Acts, 1883-8, which relate to Trade Marks, and which may be obtained at the places mentioned above:—

TRADE MARKS.

Letter.	Title of Form.	Fee.		
		£	s.	d.
E	Application for Hearing by Comptroller	1	0	0
F	Application for Registration of Trade Mark -	0	5	0
G	Additional Representation Form -	No stamp.		
H	Appeal to Board of Trade from decision of Comptroller	1	0	0
I	Registration Fee -	1	0	0
J	Notice of Opposition to Application for Registration -	1	0	0
K	Request to enter Name of Subsequent Proprietor, with Declaration in support thereof -	1	0	0
L	Request for Certificate of Refusal to Register a Trade Mark	1	0	0
M	Notice of Application for Alteration of Address -	0	5	0
N	Notice of Order of Court for Alteration or Rectification of Register -	0	10	0
O	Application to Cancel Entry of Mark on Register -	0	5	0
Q	Request for Correction of Clerical Error or for Amend- ment of Application under § 91 -	0	5	0
R	Request for Certificate of Registration for use Abroad	0	5	0
S	Request for Certificate of Registration for use in Legal Proceedings -	1	0	0
T	Application for Settlement of a Special Case -	2	0	0
T'	Request for General Certificate of Comptroller -	0	5	0
V	Request for Copy of Official Notification -	0	2	0
W	Appeal from Cutlers' Company at Sheffield to Comptroller	1	0	0
X	Fee for Continuance of Trade Mark at expiration of fourteen years -	1	0	0
Y	Additional Fee where fee is paid within three months after expiration of fourteen years -	0	10	0
Z	Additional Fee for Restoration of Trade Mark where removed for non-payment of fee -	1	0	0

Of the above forms, those bearing the letters F, G, I, X, Y, and Z, are kept in stock at the various offices named in paragraph 2. Any of the others when required must be bespoke.

SALE OF OFFICIAL PUBLICATIONS.

4. The Patents, Designs, and Trade Marks Acts, 1883-8, and the Trade Marks Rules, 1890, should be carefully studied. Copies of the Acts and of the Rules can be purchased at the Sale Branch of the Patent Office, 38, Cursitor Street, Chancery Lane, London, E.C. The price of the Acts and Rules together is 2s. 6d., postage, 2d.; of the Acts alone, 2s., postage, 1½d.; and of the Rules alone, 6d., postage 1d. Sums exceeding 1s. should be remitted by Postal Order or Post Office Order.

5. Copies of the "Trade Marks Journal" may also be obtained from the Sale Branch of the Patent Office, 38, Cursitor Street, Chancery Lane, London, E.C.

The price of the "Trade Marks Journal" is:—

Nos. 1 to 509 (Years 1876 to 1887)	-	1s. per number.
Nos. 510 to 561 (Year 1888)	-	1s. 6d. „
No. 562 and following Nos. from 1 January, 1889,		6d. „

DEFINITION OF A TRADE MARK.

6. The definition of a trade mark is given in the 64th section of the Acts, as follows:—

"(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

- (a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or
- (b.) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or
- (c.) A distinctive device, mark, brand, heading, label, or ticket; or
- (d.) An invented word or invented words; or
- (e.) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3.) Provided as follows:—

- (i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof;
- (ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade mark under this part of this Act."

SEARCHES.

7. A person wishing to adopt a trade mark should, before engraving a block and circulating impressions of the mark among his customers, make a search or a formal application at the Trade Marks Branch of the Patent Office with the view of ascertaining whether his proposed mark is already registered, or whether, from its being calculated to deceive by a resemblance to other marks already on record, it would be refused registration under the 72nd section of the Acts.

The fee for making a search amongst the classified representations of trade marks is 1s. for each quarter of an hour. The fee for a formal application is 5s. (See paragraphs 9 and 3 of these Instructions as to the mode of making a formal application.)

The comptroller does not undertake to make searches amongst the trade marks recorded at his office, *except in connexion with formal applications for registration.*

 APPLICATIONS FOR REGISTRATION.

8. Applications sent by post should be addressed—

The Comptroller,
The Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London, W.C.

In the case of marks claimed in Classes 23, 24, or 25, applications should be addressed—

The Comptroller,
Manchester Trade Marks Branch,
48, Royal Exchange,
Manchester.

Agents and other persons who may be interested in more than one application are particularly requested to make communications relating to different applications in *separate* letters.

9. An application for the registration of a trade mark consists of:—

(a.) An application form (Form F) bearing an impressed stamp of 5s. (see paragraph 3).

(The applicant should, before filling up the form, carefully read the marginal notes.)

(b.) Certain additional representations of the trade mark, mounted on forms (Form G) (see paragraphs 3 and 15).

10. A *separate* application form is required for *each* class in

cases where the same trade mark is claimed in more than one class of goods.

11. If the mark be the property of a firm, the Form F should be signed by a member of the firm, who should add, after his signature, "A member of the firm;" if of a company, by the secretary or other principal officer, who should add, after his signature and designation, "For the Company."

12. Applications may be made by agents in the names of and on behalf of the owners of trade marks. The agent must be duly authorised by the owner or owners; the necessary authority should be signed by the owner or owners.

Applications made by agents should have, after the name of the agent, the description "Agent."

13. When an applicant for the registration of a trade mark, otherwise than under an international convention, is out of the United Kingdom at the time of making the application, he must give the comptroller an address for service in the United Kingdom.

14. When the mark consists of or includes words printed in other than Roman characters, there should be given upon the forms a translation of such words, signed by the applicant or his agent.

In the case of marks claimed in Classes 23, 24, or 25, the applicant should state by what name the particular mark claimed would be referred to in the invoices of his house.

Additional Representations of Mark.

15. Each of the additional representations should be placed in the centre of a separate Form G.

In the case of a trade mark which is not claimed in Classes 23 to 35, *two* additional representations are required for *each* class claimed.

In the case of a trade mark claimed in any one or more of the Classes 23 to 25, *four* additional representations should be sent for *each* of such classes. In the case of a trade mark claimed in any one or more of the Classes 26 to 35, *three* additional representations should be sent for each of such classes.

The representations of the mark on the Forms G must agree *in every respect* with each other, and with that on the Form F.

16. Representations of a mark of a large size may be folded. In that case they must, however, be backed with linen and firmly affixed to the forms. Representations must in no case be executed *in pencil*. They should be not only of a durable nature, but of such a kind as will admit of their being preserved and bound together in volumes as records of the property of the owners.

SERIES OF TRADE MARKS.

17. By § 66 of the Acts, the comptroller is empowered to register under one registration a series of trade marks which, whilst they resemble each other in the material particulars, differ from each other in respect of the statements of the goods for which they are used, of the statements of numbers, of the statements of price, of the statements of quality, or of the statements of names of places. When an application is made for such a series, a representation of *each* of the marks included in the series must be affixed to the Form F, and also to each of the Forms G.

COMMON OR OPEN MARKS.

18. In the case of a trade mark used before the 13th August, 1875, common or open marks of any kind may be registered in connection with it; but in the case of a trade mark not so used, common or open marks consisting of *a word or combination of words only* can be registered as a part of the mark.

In each case, the applicant for entry of such common particular or particulars must disclaim the right to the exclusive use of the same in a note at the foot of the application form, such note to be signed by the applicant or his agent.

See § 74 of the Acts, subs. 3, for definition of common marks.

CLASSIFICATION OF GOODS.

19. A guide to the classification of goods under the Trade Marks Rules can be obtained on application at the Patent Office, Trade Marks Branch, and should be asked for if the applicant feels any difficulty in determining to which of the classes set out in the third schedule to the Rules the goods for which he uses his mark belong.

ADVERTISEMENT IN THE "TRADE MARKS JOURNAL."

20. A trade mark cannot in any case be entered upon the Register until one month after its advertisement in the official paper.

21. A wood-block or electrotype must be furnished for each mark in each class claimed, except in the case of Class 23 (*a*) (Cotton Yarn and Sewing Cotton, not on spools or reels), and Classes 24 and 25, for which no blocks or electrotypes are required.

A wood-block or electrotype will be required for an application in Class 23 whenever it is in respect of, or covers, sewing cotton on spools or reels.

No block or electrotype should be forwarded until a formal demand for it is sent by the comptroller.

22. In the case of a series of trade marks differing only in respect of the particulars mentioned in § 66 of the Acts, a wood-block or electrotype must be furnished for each mark in the series, for each class claimed.

23. The wood-blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be accepted.

24. The largest space available for the insertion of any single block or electrotype is five and a half inches broad by seven and a half inches deep.

When a block or electrotype *exceeds two inches in depth or breadth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch in depth or breadth beyond the two inches.

25. The number given by the comptroller should *not* be cut on the face of the block or electrotype, but should be *marked upon the side* in such a manner as to secure its identification.

26. All blocks or electrotypes should be sent to the Patent Office, Trade Marks Branch, together with the paper marked "Form 2," and with the representation of the mark sent for the guidance of the applicant in preparing the block or electrotype.

27. The blocks or electrotypes supplied for the advertisement of trade marks cannot in any case be returned to applicants.

RESTRICTIONS ON REGISTRATION.

28. Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork be included within the mark by some border or lines.

29. The words "Registered," "Registered Design," "Copy-

right," "Entered at Stationers' Hall," "To counterfeit this is Forgery," will not be registered under the Acts, and should not, therefore, appear upon the representations of trade marks forming part of an application (a).

(a) The following official notice appeared in "Trade Marks Journal" No. 570 (February 27th, 1889), p. 220, and is still in force:—

OFFICIAL NOTICE—TRADE MARKS.

After the 31st March, 1889, marks of the nature indicated below will not be accepted for registration as trade marks under the Patents, Designs, and Trade Marks Acts, 1883-8:

- (1.) Pictorial representations of goods to which the marks are to be applied.
- (2.) Names of persons in the possessive case in combination with the names of goods.

30. The following will not be registered as trade marks, or as prominent parts of trade marks, unless the marks have been used before 18th August, 1875:—

The Royal Arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of Her Majesty the Queen, or of any member of the Royal Family.

Representations of the Royal Crown.

The National Arms or Flags of Great Britain.

31. When there appears on the face of a trade mark an indication of the goods to which the mark is applied, the claim for its registration must be in respect of *those goods only*.

OPPOSITIONS.

32. Notice of opposition to the registration of a trade mark (Form J) must be filed within one month (or such further time, not exceeding three months, as the comptroller may allow) from the date of advertisement of the mark in the "Trade Marks Journal."

The applicant's counter-statement must be filed within one month from the date of receipt of the opponent's notice of opposition.

The opponent's evidence, in support of the opposition, must be filed within two months after the expiration of such month or extended time.

The applicant's evidence must be filed within one month from the delivery of the opponent's evidence.

The opponent's evidence in reply must be filed within seven days from the delivery of the applicant's evidence.

On the completion of the evidence, either party may apply (upon Form E) for the case to be heard by the comptroller.

FORM OF COUNTER-STATEMENT.

The following is a form of counter-statement :—

[For this form see Appendix B., p. 482, *infra*.]

CUTLERS' COMPANY.

33. By § 81 of the Acts, application for the registration of trade marks used on metal goods shall, if made by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company. (*See Rules 56 to 59.*)

Applications made to the Cutlers' Company in pursuance of § 81 of the Acts should be made on Form F, the address in the left-hand corner to be, "To the Cutlers' Company, Sheffield," instead of "To the Comptroller," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each application should be accompanied by an unstamped copy on foolscap paper. (*See Rule 56.*)

Applications sent by post should be addressed—

The Law Clerk to the Cutlers' Company,
The Cutlers' Hall,
Sheffield.

MANCHESTER OFFICE.

34. For the convenience of merchants and manufacturers engaged in the cotton trade, and for the purpose of facilitating the recording of trade marks used in respect of cotton goods, an office is open at 48, Royal Exchange, Manchester, where searches can be made, on payment of 1s. for each quarter of an hour, for marks in classes of textiles from Class 23 to Class 35.

CERTIFICATES.

35. The comptroller's certificate in relation to a trade mark is of four kinds, viz. :—

- (i.) For use in legal proceedings.
- (ii.) For use in applying for registration in foreign countries.

(iii.) Of any application made and of proceedings thereon.

(iv.) A certificate of refusal of a mark in use before 13th August, 1875, and not registrable.

36. A person desirous of obtaining any of the above certificates should forward Form S, Form R, Form T¹, or Form L (see paragraph 3), as the case may be, to the comptroller, giving the comptroller's official number of the mark, and stating whether the certificate is required for use in legal proceedings, or for use in applying for the registration of the mark in a foreign country, or for what other purpose.

37. In every case where a certificate is required in respect of a cotton mark, or in respect of any trade mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the mark must be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the comptroller.

REGISTRATION OF SUBSEQUENT PROPRIETORS OF REGISTERED TRADE MARKS.

38. The request and declaration to be made by a subsequent proprietor on application for the registration in his name of a registered trade mark must be made on Form K (see paragraph 3).

H. READER LACK,
Comptroller.

January 1890.

N.B.—The Rules and Instructions under the Trade Marks Registration Acts, 1875-7, were frequently added to and altered, and it will be advisable for intending applicants under the Patents Acts, 1883-8, to take care to proceed in accordance with the Rules and Instructions for the time being in force.

APPENDIX B.
FORMS AND PRECEDENTS.

PART I.
FORMS PRESCRIBED BY THE SECOND SCHEDULE TO
THE RULES.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

TRADE
MARKS.

E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

In Cases of Opposition, &c.

SIR,

(a) Here insert
full address.

I,

of (a)

hereby apply to be heard in reference to

and request that I may receive due notice of the day fixed for
the hearing.

Sir,

Your obedient Servant,

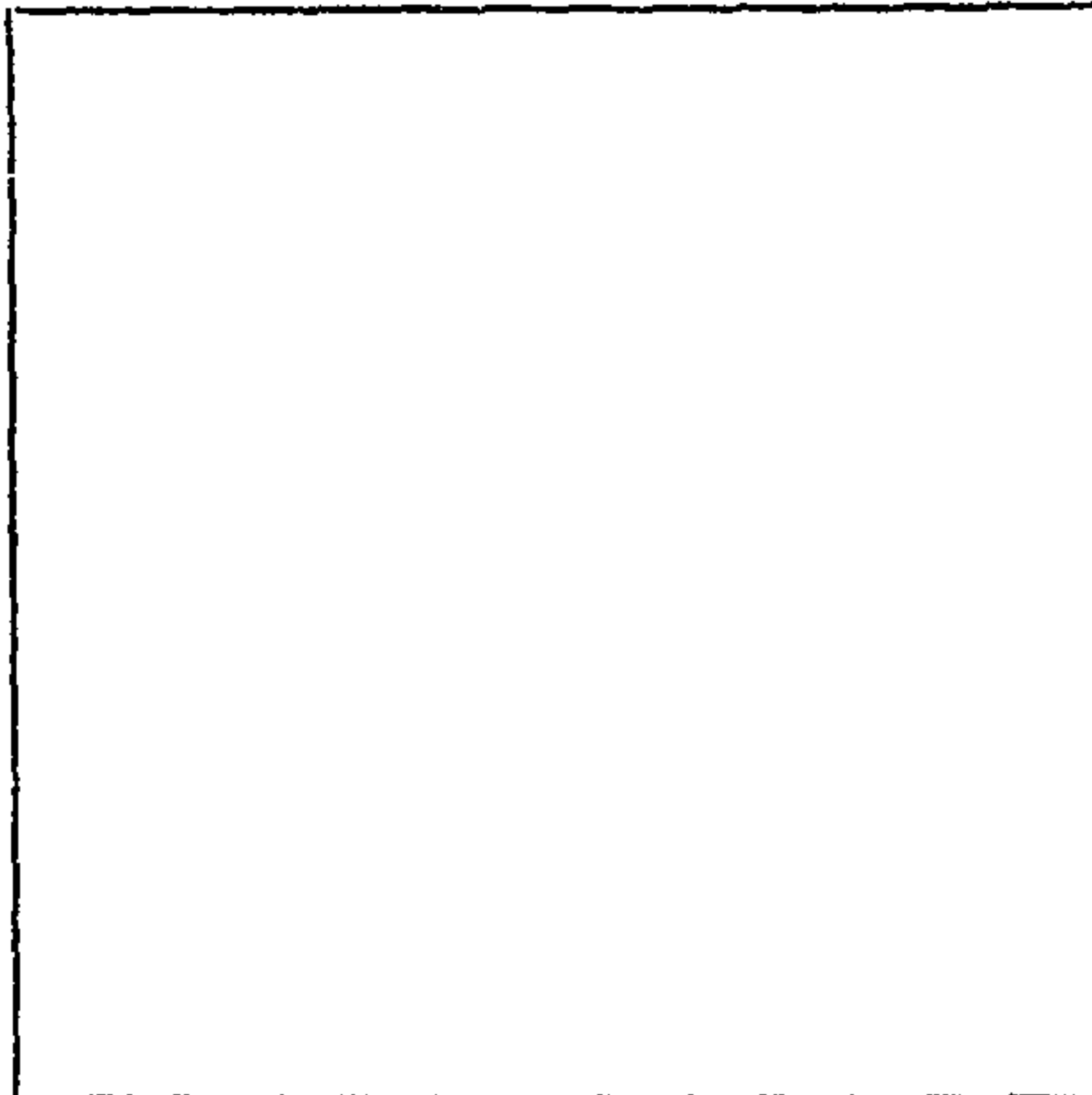
*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, London*

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

F.

APPLICATION FOR REGISTRATION OF TRADE MARK.

TRADE
MARKS.



One representation to be fixed within this square, and two others to be sent on separate half-sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.

(a) Only goods contained in one and the same class should be set out here. A separate application form is required for each separate class.

You are hereby requested to register the accompanying trade mark in Class _____, in respect of (a) _____,

in the name of (b) _____,

who claims to be the proprietor thereof (c).

(b) Here insert legibly the full name, address and description of the individual firm or company. Add trading style (if any).

The essential particulars of the trade mark are the following (d)

and disclaim any right to the exclusive use of the added matter.

(c) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

(Signed) _____ (e)
Dated the _____ day of _____ 18__

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, London.

(d) See subs. (2) and (3) of § 61 of the Acts.

[Or where the application is for a mark in classes 23, 24 or 25],

To the Comptroller,
Manchester Trade Marks Branch,
48, Royal Exchange, Manchester.

(e) To be signed by the applicant or by an agent duly authorised.

Note.—If the trade mark has been in use in respect of the goods since before August 13th, 1875, state length of such user.

PATENTS, DESIGNS, AND TRADE MARKS ACTS
1883—1888.

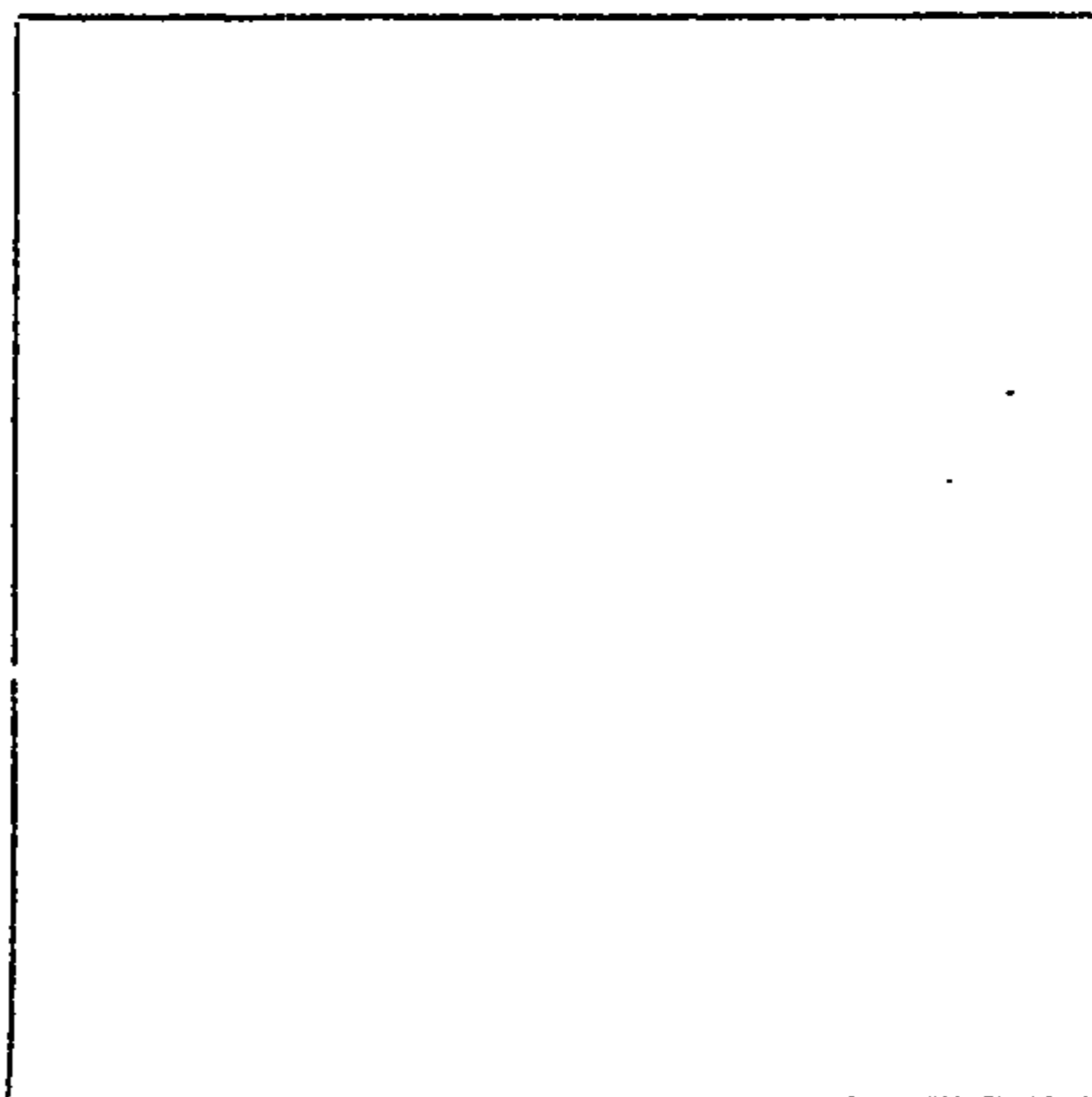
G.

ADDITIONAL REPRESENTATION OF TRADE MARK TO ACCOMPANY
APPLICATION FOR REGISTRATION.

One representation of the trade mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the application form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed hereto.



Two of these ADDITIONAL REPRESENTATIONS of the trade mark must accompany *each* form of application.

In the case of a trade mark claimed in one of the Classes 23 to 35, THREE of these ADDITIONAL REPRESENTATIONS of the mark must accompany the form of application.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

H.

FORM OF APPEAL FROM THE COMPTROLLER TO THE BOARD
OF TRADE.

TRADE
MARKS.

I, (a)
of (a)

(a) Here insert
full name and
address of appel-
lant.

hereby give notice of my intention to appeal to the Board of
Trade from (b)

of the Comptroller of the day of 18 ,

(b) Here insert
"the decision" or
"that part of the
decision" as the
case may be.

whereby he (c)

(c) Here insert
the decision com-
plained of.

Accompanying this notice is a statement of my case for the
decision of the Board of Trade.

(Signed)

Dated day of 18

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, London.*

and to

[Name of Respondent to Appeal.]

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

I.

FEE FOR REGISTRATION OF A TRADE MARK.

Sir,

In reply to your request I hereby transmit the prescribed
fee for the registration of the Trade Mark No.
in Class

I am,

Sir,

Your obedient Servant,

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

TRADE
MARKS.

TRADE MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

J.

NOTICE OF OPPOSITION TO APPLICATION FOR REGISTRATION.

[To be accompanied by an unstamped duplicate.]

In the matter of an application,
No. by
of

(a) Here state
full name and
full address.

I, (a) hereby give notice of my intention to oppose the registration of the trade mark advertised under the above number for Class in the "Trade Marks Journal" of the day of 18 , No. , page .

The grounds of opposition are as follows (*):—

(Signed)

Dated the day of 18

Address for service:—

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

(* See p. 492, *infra*, for forms of grounds of opposition.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

TRADE
MARKS.

K.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF TRADE
MARK UPON THE REGISTER, WITH DECLARATION IN SUPPORT
THEREOF.

(a) Or We.
Here insert
name, full ad-
dress, and de-
scription.

I, (a)

(b) My or our.
(c) Or names.

hereby request that you will enter (b) name (c) in the
register of trade marks as proprietor of the trade mark
No. in Class .

(d) I am, or We
are.

(d) entitled to the said trade mark and to the goodwill
of the business concerned in the goods with respect to which
the said trade mark is registered.

(e) Here state
whether trade
mark trans-
mitted by death,
marriage, bank-
ruptcy, or other
operation of law,
and if entitled by
assignment state
the particulars
thereof as e.g.,
"by deed dated
the day of
18 ,
made between
So-and-so of the
one part."

(e)

And I do solemnly and sincerely declare that the above several
statements are true, and the particulars above set out comprise
every material fact and document affecting the proprietorship
of the said trade mark as above claimed.

(f) This para-
graph is not re-
quired when the
declaration is
made out of the
United Kingdom.

(f) And I make this solemn declaration conscientiously be-
lieving the same to be true, and by virtue of the provisions of
the Statutory Declarations Act, 1835.

(g) To be signed
here by the per-
son making the
declaration.

(g)

Declared at

this day of 18 . }
Before me,

(h)

(A) Signature
and title of the
authority before
whom the decla-
ration is made.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

L.

REQUEST FOR CERTIFICATE OF REFUSAL TO REGISTER A TRADE
MARK IN USE BEFORE 13TH AUGUST, 1875.

In the matter of an application
for registration of an old trade
mark, No.
in Class

SIR,

I,

of

the applicant in the above matter, hereby request you to furnish
me with your certificate of refusal to register the said trade
mark.

(a) Signature
of applicant.

(a)

Dated this day of 18

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

M.

NOTICE OF APPLICATION FOR ALTERATION OF ADDRESS ON
REGISTER OF TRADE MARKS.

In the matter of the trade mark,
No. , registered
in Class .

SIR,

Notice is hereby given that I

of

the registered proprietor of the trade mark numbered as above,
desire that my address on the Register of Trade Marks be
altered to

Dated this day of 18 .

(a) Signature
of proprietor.

(a)

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

TRADE
MARKS.

TRADE
MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

N.

NOTICE OF ORDER OF COURT FOR ALTERATION OR RECTIFICA-
TION OF REGISTER OF TRADE MARKS.

In the matter of the trade mark
No. _____, registered
in Class _____ in the name of

SIR,

Notice is hereby given that by an order of the Court made on the _____ day of _____ 18____, it was directed that the entry on the Register of Trade Marks in respect of the trade mark numbered as above should be rectified in the manner therein specified.

An office copy of the order of the court is enclosed herewith.

Dated this _____ day of _____ 18____.

To the Comptroller, (a)
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

(a) To be signed by the person interested or his agent.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

O.

FORM OF APPLICATION BY PROPRIETOR OF REGISTERED TRADE
MARK TO CANCEL ENTRY ON REGISTER.

Trade mark No. _____ Class _____ advertised in "Trade
Marks Journal," No. _____ page _____
Name of registered proprietor or firm _____

Place of business _____

I, the undersigned
of _____

[or I, the undersigned,
a member of the firm of

of _____ on behalf of my said
firm]

apply that the entry upon the Register of the Trade Marks in
Class _____ of the trade mark No. _____ may be cancelled.

The _____ day of _____ 18____.

(Signed)

This is the statement marked 'O' referred to in the
declaration of _____
made before me the _____ of _____ 18____.

TRADE
MARKS.

TRADE
MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

P.

FORM OF DECLARATION IN SUPPORT OF APPLICATION FOR
CANCELLATION OF TRADE MARK BY OWNER.

I, _____ of _____
I, _____ a member of the firm of _____
of _____]

do hereby solemnly and sincerely declare, to the best of my
knowledge and belief, as follows:—

(1) The application signed by me, and dated the
day of _____ 18 _____ and marked with the letter "O,"
and shown to me at the time of making this declaration, is true.

(2) I am the person whose name appears on the Register of
Trade Marks as the proprietor of the trade mark referred to
in the said application marked with the letter "O."

[or My said firm is the firm whose name appears on the Register
of Trade Marks as the proprietor of the trade mark referred
to in the said application marked with the letter "O."]

And I make this solemn declaration conscientiously believing
the same to be true, and by virtue of the provisions of the
Statutory Declarations Act, 1835.

(Signed)

Declared at

this _____ day of

18 .

Before me,

If the declaration be made before a commissioner to ad-
minister oaths it will require to be stamped with a 2s. 6d.
impressed Inland Revenue stamp.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

Q.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR
OR FOR PERMISSION TO AMEND APPLICATION UNDER
§ 91.

TRADE
MARKS.

SIR,

I hereby request that

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

R.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK
FOR USE IN OBTAINING REGISTRATION ABROAD.

TRADE
MARKS.

In the matter of the trade mark
No. , registered in
Class in the name of

SIR,

I,

of
the registered proprietor of the above trade mark, hereby request
you to furnish me with your certificate of registration for use
in obtaining registration of the same in (a)

(b)

(a) Here state
name of country
in which regis-
tration is to be
sought.

(b) Signature.

Dated this day of 18 .

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

S.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK
TO BE USED IN LEGAL PROCEEDINGS.

In the matter of the trade mark
No. , registered in
Class in the name of

SIR,

I,

of

the registered proprietor of the above trade mark, hereby
request you to furnish me with your certificate of registration
to be used in legal proceedings

(a) Signature.

(a)

Dated this day of 18 .
*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

T.

APPLICATION FOR SETTLEMENT OF A SPECIAL CASE ON
APPLICATION TO REGISTER A TRADE MARK.

In the matter of the application
of and
of the application of

SIR,

Notice is hereby given that I, ,
of ,
and I, ,
of ,
are unable to agree upon the facts on which the opinion of the
Court is to be taken, and that we request you to fix a day on
which we may attend before you and obtain your finding on the
matters of fact to be submitted to the Court as settled.

Dated this day of 18 .

(a)

(a) To be signed
by both parties.

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

TRADE
MARKS.

TRADE
MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

T¹.

REQUEST FOR GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD).

In the matter of the trade mark No.
in Class

SIR,

I,

of

hereby request you to furnish me with your certificate that (a)

(a) Here set out the particulars which the comptroller is requested to certify.

(b) Signature.

Dated this (b) day of 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

U.

GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD).*

Patent Office, Trade Marks Branch,
London,

18 .

I,
Comptroller-General of Patents, Designs, and Trade Marks,
hereby certify

* In practice this form is usually employed as shown at p. 490, *infra*.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

V.

TRADE
MARKS.

REQUEST FOR COPY OF OFFICIAL NOTIFICATION OF REGISTRA-
TION OF TRADE MARK.

In the matter of the trade mark
No. , registered
in Class .

SIR,
I

of
the registered proprietor of the trade mark above named hereby
request that you will furnish me with a copy of the official
notification of the registration of the same.

(a) Signature.

Dated this (a) day of , 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

W.

TRADE
MARKS.

FORM OF APPEAL FROM CUTLERS' COMPANY AT SHEFFIELD TO
COMPTROLLER.

[To be accompanied by an unstamped duplicate.]

SIR,

I hereby give notice of appeal against the decision of the
Cutlers' Company of Sheffield in regard to my application for
registration of a trade mark No. , in Class ,
for

and I beg to submit my case (a) for your decision accordingly.

(b)
Dated this day of , 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

(a) The state-
ment of the case
to be written
upon foolscap
paper (on one
side only), with
a margin of two
inches on the
left-hand side
thereof.

(b) Signature.

PATENTS, DESIGNS, AND TRADE MARKS ACTS
1883—1888.

X.

CONTINUANCE OF MARK AT EXPIRATION OF 14 YEARS FROM
THE DATE OF REGISTRATION.

TRADE
MARKS.

SIR,

In pursuance of the notice received from you, I hereby transmit the prescribed fee of £1 for continuance on the Trade Marks Register of the trade mark No. , in Class .

Dated the day of 18 .
(a)

(a) Signature
of proprietor.

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

Y.

ADDITIONAL FEE OF 10/- TO ACCOMPANY "CONTINUANCE FEE"
(FORM X), WITHIN 3 MONTHS AFTER EXPIRATION OF
14 YEARS.

TRADE
MARKS.

SIR,

In pursuance of the notices issued by you, and of the provisions of § 79 (3), of the above Acts, I hereby transmit the additional fee of 10/- (along with Form X) for the continuance on the Trade Marks Register of the trade mark No. , in Class .

Dated the day of 18 .
(a)

(a) Signature
proprietor.

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

TRADE
MARK.

Z.

RESTORATION OF TRADE MARK WHERE REMOVED FOR
NON-PAYMENT OF FEE.

(To accompany Form X.)

SIR,

In pursuance of the notices issued by you, and of the provisions of § 79 (4), of the above Acts, I hereby transmit the additional fee of £1 (along with Form X) for restoration to the Trade Marks Register of the trade mark No. _____, in Class _____.

(a) Signature
of proprietor.

Dated the _____ day of _____ 18

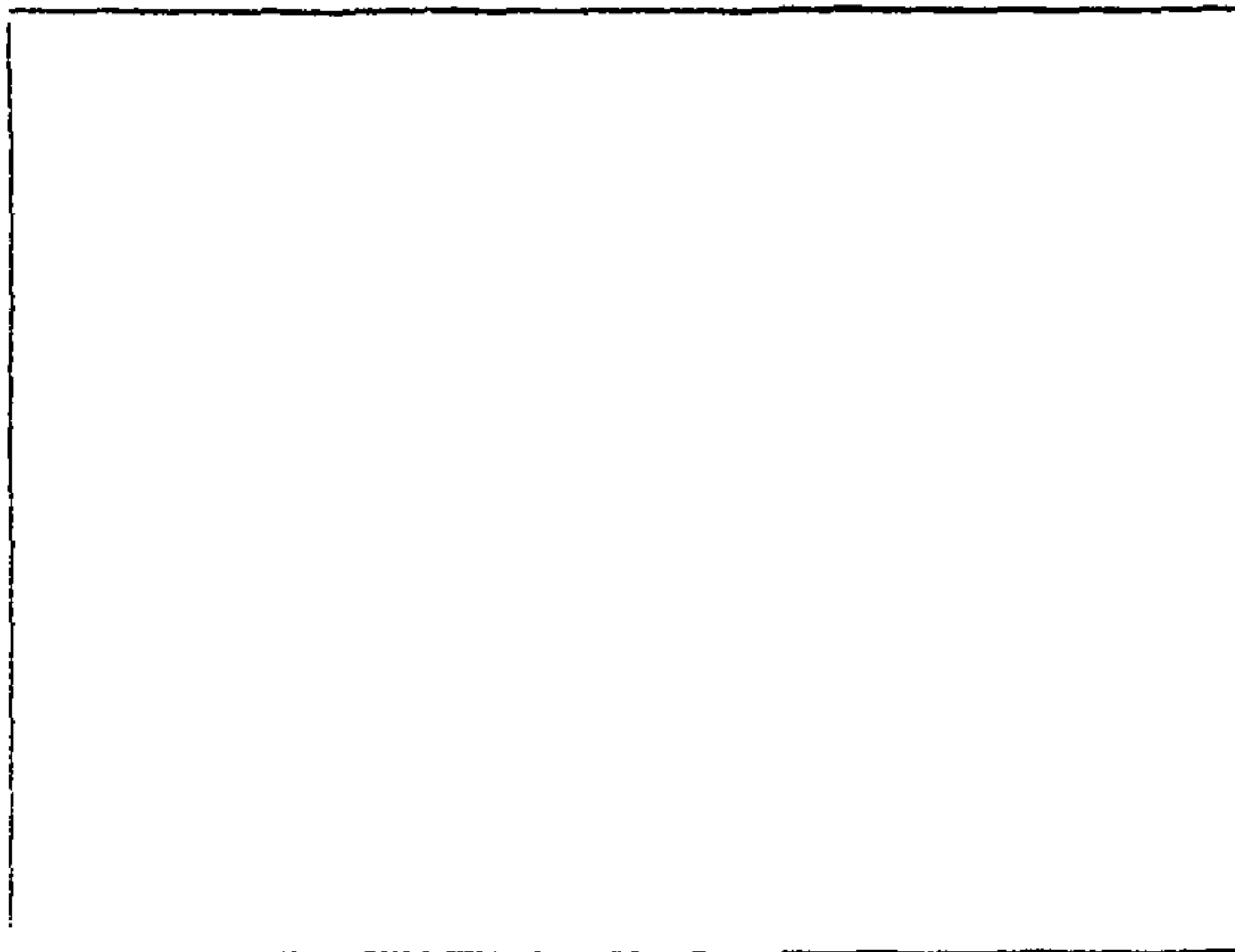
(a)

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

CORPORATE
TRADE
MARK.

APPLICATION FOR REGISTRATION OF OLD CORPORATE TRADE
MARK.



You are hereby requested to register the accompanying old
Corporate Trade Mark in Class , in respect of

in the name of

who claims to be the proprietor thereof.

(Signed)

Dated the day of 18 .

*To the Cutlers' Company,
Cutlers' Hall, Sheffield.*

FORM SUGGESTED BY THE COMPTROLLER.

[See Instructions, par. 32.]

a.

FORM OF COUNTER-STATEMENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

TRADE MARKS.

In the matter of an application
No. _____, and of the oppo-
sition thereto No. _____.In reply to the notice of opposition in this matter by
of _____, I give notice by way of counter-statement
that I rely for my application on the following grounds (a):—

(To be dated and signed by the applicant or his solicitor.)

*To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*(a) See page 496, *infra*, for forms of grounds of counter-statement.

FORMS IN USE IN THE PATENT OFFICE, TRADE MARKS
BRANCH (SELECTED).

b.

FORM OF RECEIPT OF AN APPLICATION.

Patent Office: Trade Marks Branch,
London.

Received this day of , 18 , an appli-
cation for the registration of trade mark
in the name of

Comptroller.

c.

FORM OF AUTHORISATION OF AGENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

FORM OF AUTHORISATION.

SIR,

I beg to inform you that I have appointed (*a*)
of to act as my agent for the registration of (*b*)

I am,

Sir,

Your obedient servant,

(*c*)

(*a*) Here insert name and address of agent.

(*b*) If the authority is to be limited to one application, insert "of the Trade Mark" or as the case may be "sent herewith."

(*c*) To be signed by the proprietor.

To the Comptroller,
The Patent Office,
25, Southampton Buildings.
London, W.C.

d.

FORM OF ADVERTISEMENT.

FORM FOR "TRADE MARKS JOURNAL."

18 .

Class of Goods.	Number.	Description of Goods.	Name, address, and calling of applicant.	Date of application received.	If mark used prior to 13th August, 1875, how long used.

APPENDIX B.

N.B.—This Paper is to be sent with the block or electrotpe and the representation, *prepaid*, to
The Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London, W.C.

e.

FORM OF NOTIFICATION OF REGISTRATION.

PATENT OFFICE, TRADE MARKS BRANCH.

LONDON, , 18 .

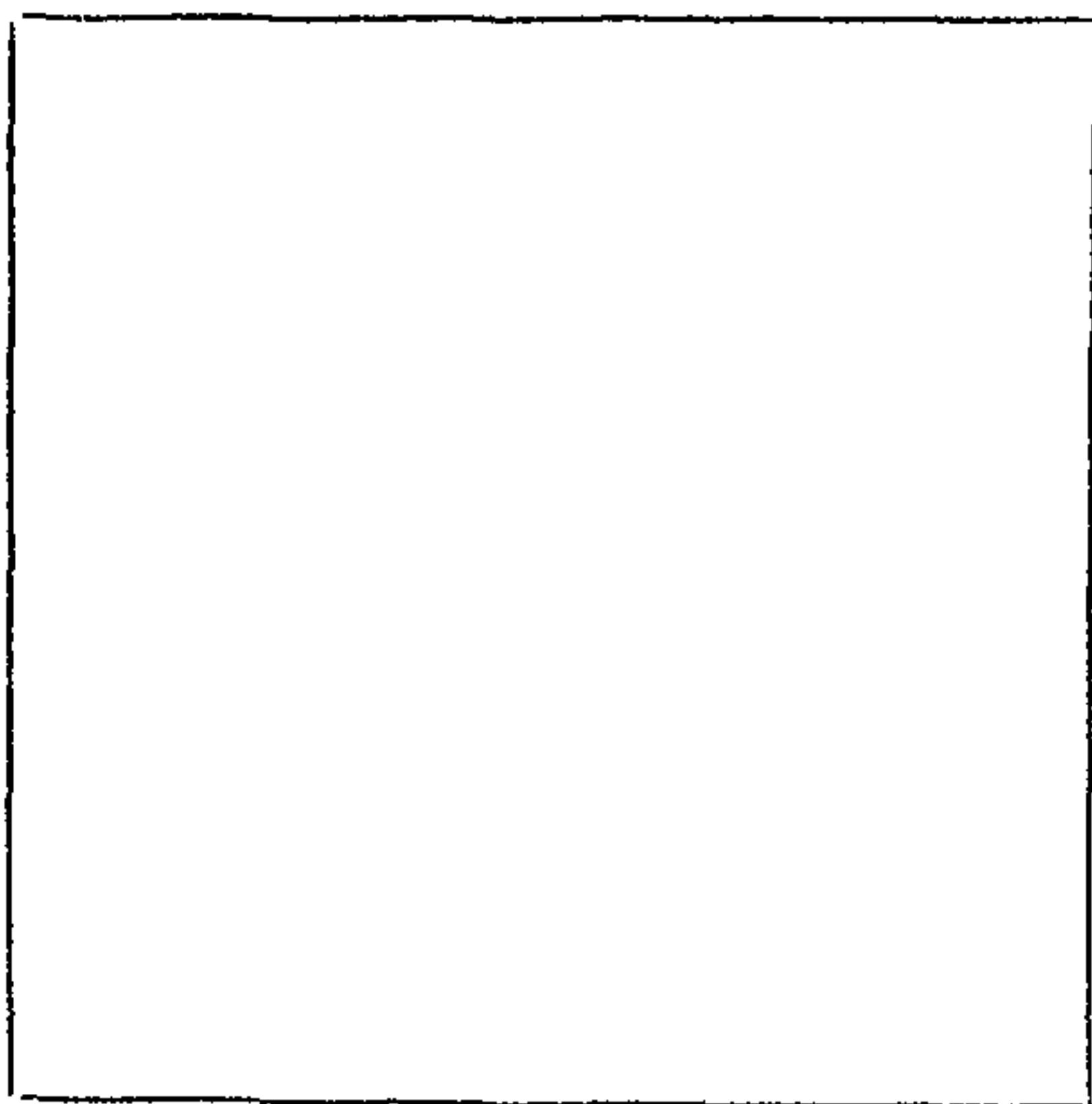
Notification of Registration.

SIR,
I beg to inform you, pursuant to Rule 35 of the Trade Marks Rules, that the trade mark No. ,
advertised in the "Trade Marks Journal," No. , has
been registered in your name for the following goods in
Class , viz. :—

The registration dates from the day of ,
18 .

I am,
Your obedient servant,
H. READER LACK.
Comptroller-General.

REPRESENTATION OF TRADE MARK AS ADVERTISED.



*f.*FORM OF NOTIFICATION OF REGISTRATION OF SUBSEQUENT
PROPRIETOR.

PATENT OFFICE: TRADE MARKS BRANCH,

London

18 .

SIR,

I have to inform you that, in pursuance of your application received at this office on the _____, 18____, your
has been entered on the register as proprietor of the trade
mark

I am,

Your obedient servant,
H. READER LACK.
Comptroller.

g.

FIRST NOTICE UNDER § 79.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.*Notice before removal of Trade Mark from the Register,
under § 79.*

SIR,

I, HENRY READER LACK, Comptroller-General of Patents, Designs, and Trade Marks, hereby give you notice that, in conformity with the provisions of § 79 of the above Acts (printed at back hereof), your trade mark No. _____, registered in Class _____, will be removed from the Trade Marks Register unless the prescribed fee of £1 (payable by Form X) be received at this office *before* the _____ day of 18____.

A stamped Form X, for payment of the fee, may be obtained as directed at the back of this Notice.

Dated this _____ day of _____ 18____.

To

*Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London, W.C.*

/k.

SECOND NOTICE UNDER § 79.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

SECOND NOTICE.

*Notice before removal of Trade Mark from the Register,
under § 79.*

SIR,
I, HENRY READER LACK, Comptroller-General of Patents Designs, and Trade Marks, hereby give you notice that, in conformity with the provisions of § 79 of the above Acts (printed at back hereof), your trade mark No. _____, registered in Class _____, will be removed from the Trade Marks Register unless the prescribed fee of £1 (payable by Form X) be received at this office *before* the _____ day of _____ 18 _____.

If the above fee be not paid *before* the date above named, the trade mark will, after the end of three months from such date, be removed from the Trade Marks Register, unless an *additional* fee of 10s. (payable by Form Y) be remitted.

Stamped forms for payment of renewal fees may be obtained as directed at the back of this notice.

Dated this _____ day of _____, 18 _____.

To

2.

FORM OF CERTIFICATE OF REGISTRATION OF ORIGINAL PROPRIETOR
FOR USE IN LEGAL PROCEEDINGS, OR IN APPLYING FOR
REGISTRATION IN FOREIGN COUNTRIES.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.

Certificate of Registration.

No.

In the matter of legal proceedings
[or, in the matter of an application
to register the trade mark No.
of *A. B.*, in *France*.]

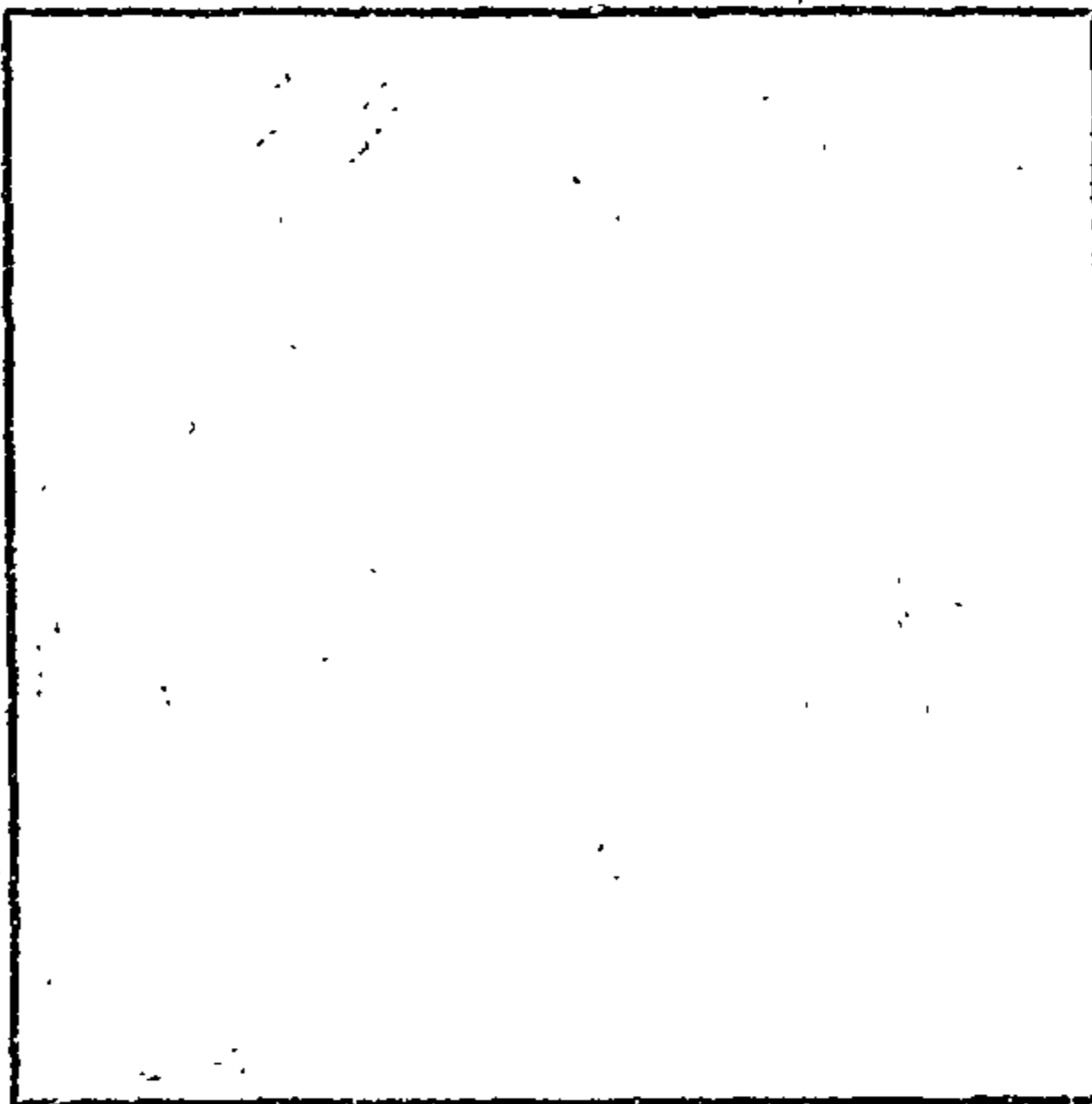
I, HENRY READER LACK, Comptroller-General of Patents,
Designs, and Trade Marks, hereby certify that *A. B.* of
, is entered on the Register of Trade Marks as proprietor
of the trade mark No. in Class in respect
of , for the registration of which mark applica-
tion was made on the day of 18 .

The user claimed for the said trade mark is [*one year before
the 13th day of August, 1875*] (a).

(a) No mention
is made of user,
unless this was
prior to the 13th
August, 1875.

A representation of the said trade mark is shown hereunder
[or, is annexed hereto].

REPRESENTATION OF TRADE MARK.



Witness my hand and seal this
18 .

day of

Comptroller-General.

*Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

k.

FORM OF CERTIFICATE OF REGISTRATION OF SUBSEQUENT PROPRIETOR FOR USE IN LEGAL PROCEEDINGS, OR IN APPLYING FOR REGISTRATION IN FOREIGN COUNTRIES.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Certificate of Registration.

No. In the matter of legal proceedings
[or, in the matter of an application
to register the trade mark No.
of *A. B. & Co.*, in *France*].

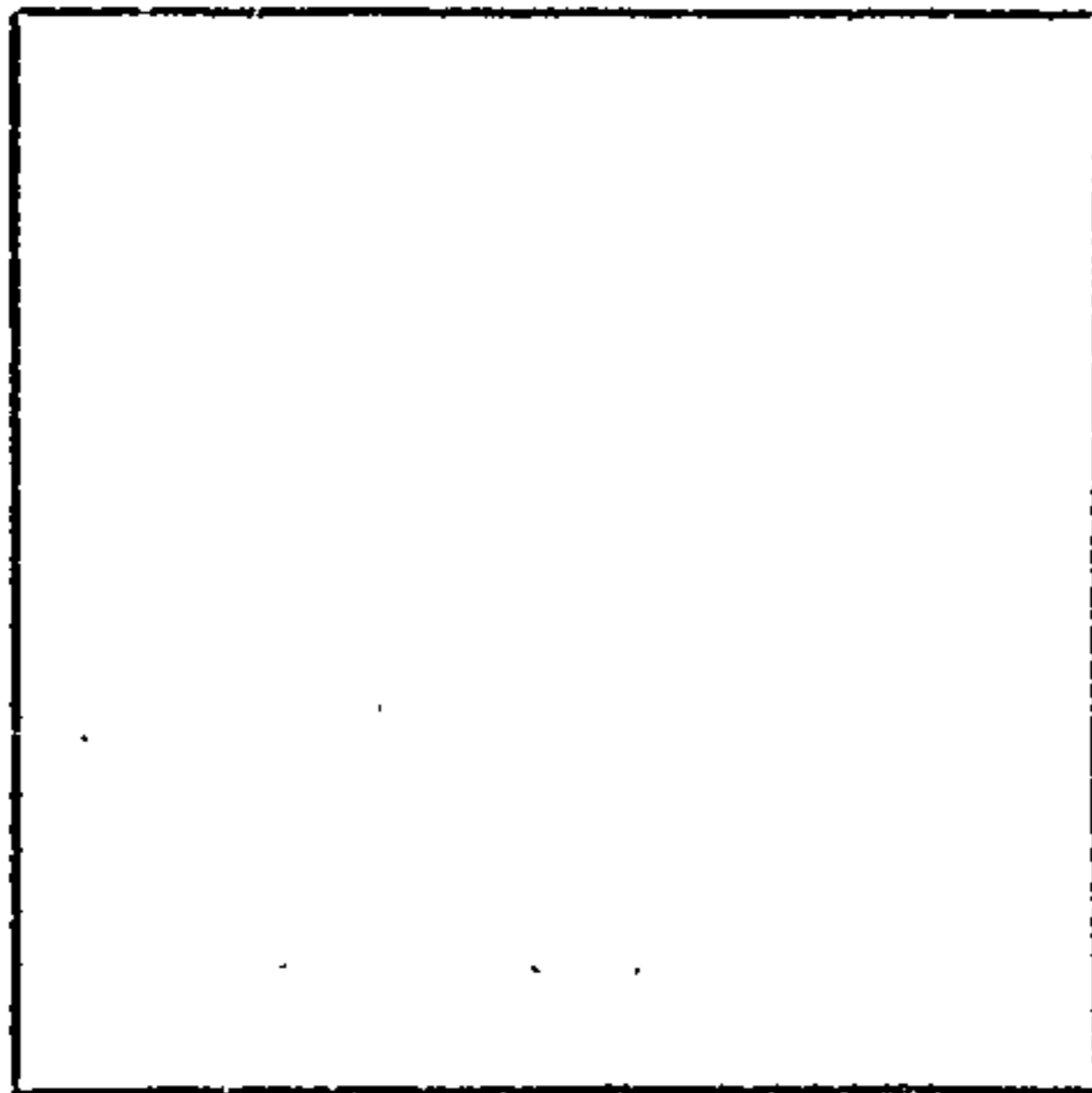
I, HENRY READER LACK, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify that under date the day of 18 , *A. B. & Co.* of , are entered on the Register of Trade Marks as proprietors of the trade mark No. in Class in respect of , in succession to *A. B.* of , in whose name the said trade mark was registered in the same class, and in respect of the same goods under date the day of 18 .

The user claimed for the said trade mark is [*one year before the 13th day of August, 1875*] (a).

A representation of the said trade mark is shown hereunder [or, is annexed hereto].

(a) No mention is made of user, unless this was prior to the 13th August, 1875.

REPRESENTATION OF TRADE MARK.



Witness my hand and seal this day of 18 .

Comptroller-General.

*Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

1.

FORM OF GENERAL CERTIFICATE.

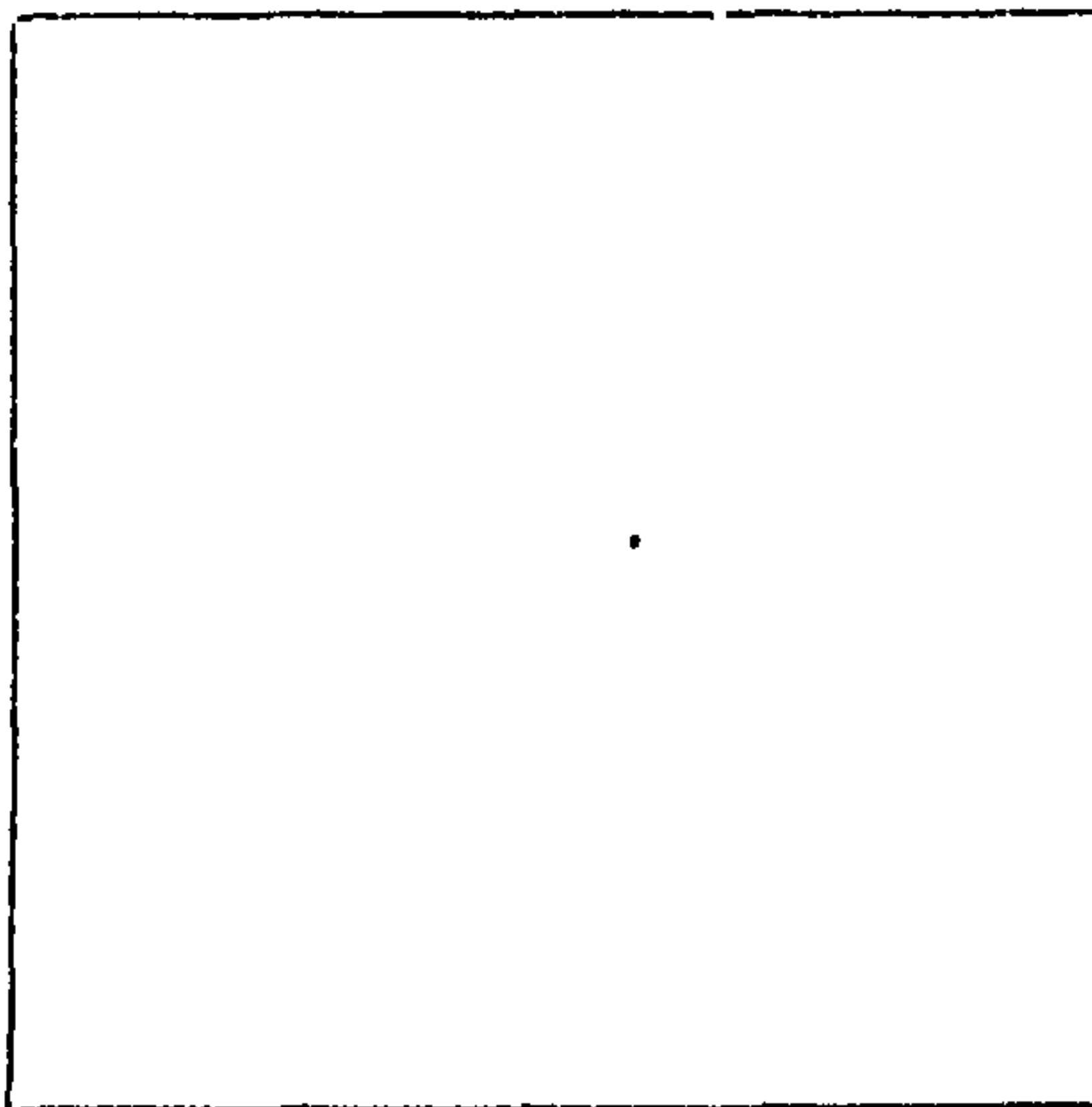
PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1863—1888.*General Certificate.*

In the matter of

No.

I, HENRY READER LACK, Comptroller-General of Patents,
Designs, and Trade Marks, hereby certify that

REPRESENTATION OF TRADE MARK.

Witness my hand and seal this
18 .

day of

Comptroller-General.

*Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

m.

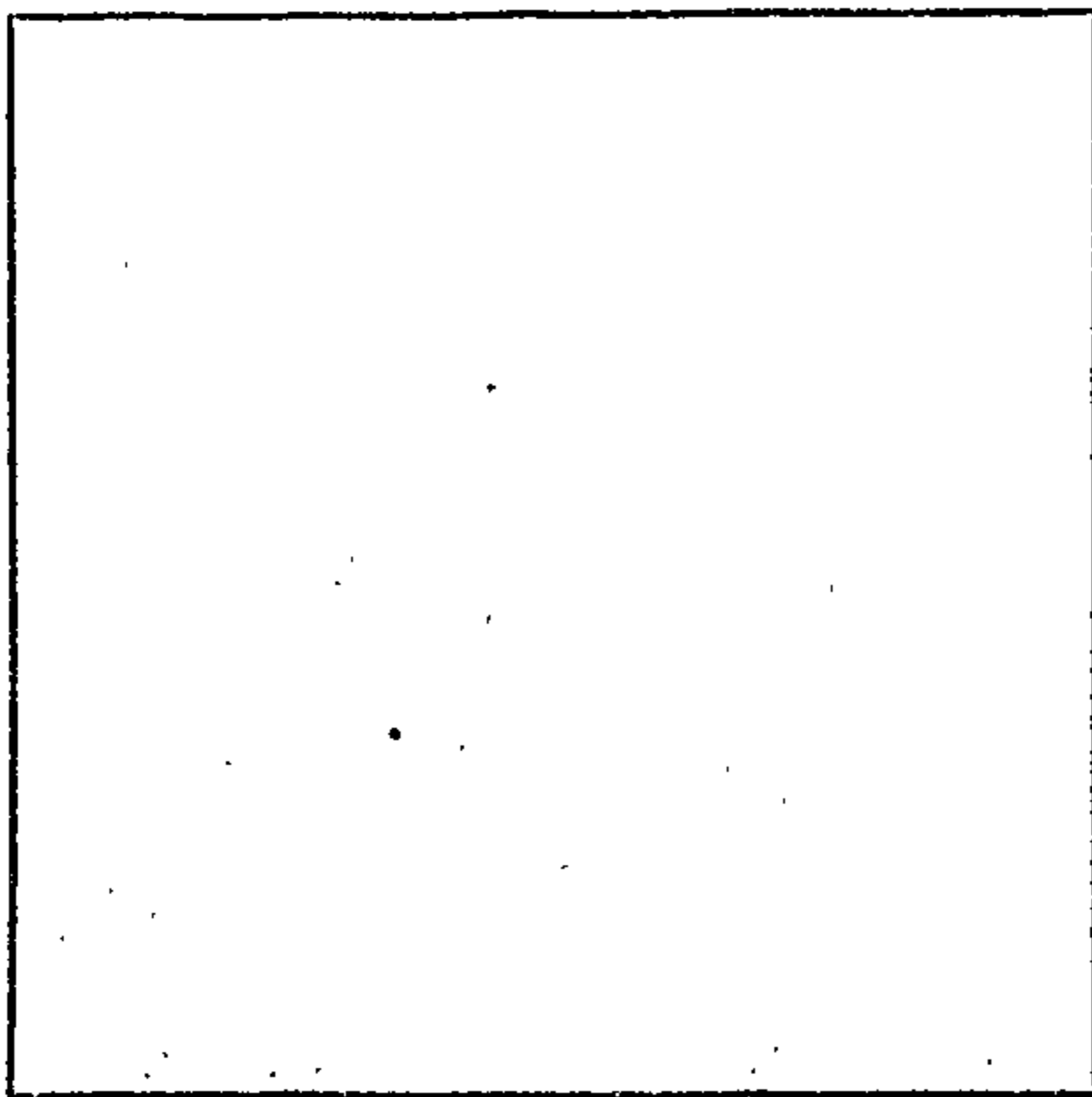
FORM OF CERTIFICATE OF REFUSAL TO REGISTER.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,
1883—1888.*Certificate under § 77.*

No.

I, HENRY READER LACK, Comptroller-General of Patents,
Designs, and Trade Marks, hereby certify that on the
day of 18 , ofapplied to register the mark, of which a representation is
below, in Class in respect ofstating that the same had been in use as a trade mark before
the 13th day of August, 1875; and I also certify that it is
a mark incapable of being registered under "The Patents,
Designs, and Trade Marks Acts, 1883—1888."

REPRESENTATION OF TRADE MARK.

Witness my hand and seal this day of
18 .

Comptroller-General.

*Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.*

PART II.

FORMS FOR USE IN REGISTRATION PROCEEDINGS.

1. GROUNDS OF OPPOSITION (a).

- (i.) THE alleged trade mark to which the above-mentioned application relates is not a registrable trade mark within § 64 of the Patents, Designs, and Trade Marks Acts, 1883-8.
- (ii.) The alleged [as in (i.) to—relates] does not consist of or contain any essential particular as defined by § 64 of the Patents, Designs, and Trade Marks Acts, 1883-8, or any special and distinctive word, or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the 13th August, 1875.
- (iii.) It is not the fact, as alleged by the applicant in his application, that he has used the trade mark No. _____ for _____ years. The said trade mark has in fact been used exclusively for _____ years past by the opponent, who is now applying to register the same. If there has been any user by the applicant, the same has been clandestine and unknown to the opponent.
- (iv.) It is not the fact as alleged [as in (iii.) to—years]. The applicant has never used the said alleged trade mark otherwise than as a mere descriptive term, and he is not now entitled to register it as his old trade mark.
- (v.) The goods in respect of which the above-mentioned applicant is seeking to register the alleged trade mark No. _____ are not goods comprised in Class _____ of the classes under the Patents, Designs, and Trade Marks Acts, 1883-8.
- (vi.) The alleged [as in (i.) to—relates] is a mere word in ordinary use in the English language descriptive of quality, and the applicant is not entitled to acquire an exclusive right therein by registration.

(a) See Form J, p. 470, *suprà*, for the formal parts of the notice of opposition. These forms are intended to be varied and combined as may be necessary, or they may suggest others more suitable to particular cases.

- (vii.) The alleged [as in (i.) to—relates] is not distinctive of the above-named applicant's goods, but is merely descriptive of the character and quality of the goods to which it is applied.
- (viii.) The alleged [as in (i.) to—relates] is not a mark distinctive of the above-named applicant's goods, but has for many years past been in common use in the trade, and is generally understood by the trade and the public to denote a particular quality [or pattern] of goods [and was for that reason placed by the Manchester Committee of Experts in their second class or B. list], and no person is entitled to acquire an exclusive right therein by registration.
- (ix.) The alleged [as in (i.) to—relates] consists of a name which has throughout the continuance of an expired patent been applied by the applicant as patentee, and by the trade and the public, to articles manufactured in accordance with the said patent. Upon the expiration of the said patent the trade became entitled to manufacture in accordance with the said patent, and to describe articles so manufactured by the name which was generally understood to be descriptive of them, and the applicant is not now entitled to exclude the trade from the use of the said name.
- (x.) The alleged [as in (i.) to—relates] is identical with the opponent's trade mark No. _____ registered with respect to the same goods or description of goods as those for which the applicant is now applying to register the same. If the applicant is allowed to register or use the said alleged trade mark, the trade and the public will be deceived and the opponent injured.
- (xi.) The alleged [as in (i.) to—relates] has such a resemblance to the opponent's [as in (x.) to—register the same] as to be calculated to deceive. An action is now pending in the Chancery Division of the High Court of Justice in which the opponent is seeking to restrain the applicant from using the said alleged trade mark.
- (xii.) The alleged [as in (i.) to—relates] has such a resemblance to the opponent's Sheffield mark No. _____, registered in the Sheffield register with respect to the same goods or description of goods as those for which the applicant is now applying to register the said alleged trade mark, as to be calculated to deceive.

- (xiii.) The trade mark [as in (i.) to—relates] is the trade mark of the opponent, and has been used by him in his business for _____ years last past, and an application by the opponent for the registration of the same is now pending. The applicant is a discharged servant of the opponent, in fraud of whose rights the present application is made.
- (xiv.) The trade mark [as in (i.) to—relates] was _____ months since adopted by the opponent and used upon his [describe the goods], and the applicant was employed by the opponent to obtain the registration of the same on his behalf, and he is not now entitled to obtain the registration of the same in his own name.
- (xv.) The trade mark [as in (i.) to—relates] has for many years past been the exclusive property in [France] of the opponent, and it has for the same period been exclusively used in the United Kingdom upon goods of the opponent imported into this country. [The opponent has not hitherto registered the said trade mark in the United Kingdom from ignorance of the requirements of British law, but he is now about to apply for the registration of the same.]
- (xvi.) The alleged [as in (i.) to—relates] contains several material misstatements with respect to the nature and composition of the article to which it is applied by the applicant, and the said alleged trade mark is therefore calculated to deceive, and ought not to be registered.
- (xvii.) The alleged [as in (i.) to—relates] contains a statement contrary to the fact, that the goods to which it is applied by the applicant are patented, and the said alleged trade mark ought not therefore to be registered.
- (xviii.) By articles of partnership, dated _____, under which the opponent and the applicant carried on business until recently in partnership, it was agreed that on the dissolution of the partnership the goodwill of the partnership business and the trade marks used therein (of which the trade mark [as in (i.) to—relates] was one) should belong solely to the opponent. The said partnership is now dissolved, and the applicant is not entitled to use or register the said trade mark.
- (xix.) By articles [as in (xviii.) to—dissolution of the partnership] neither of the partners should in any business

carried on by him use the name or trade marks used by the said partnership. The trade mark [as in (i.) to—relates] is one of the trade marks which were used by the said partnership, and since the dissolution of the said partnership the applicant is not entitled to use or register the said trade mark.

- (xx.) The word _____ which forms part of the alleged [as in (i.) to—relates] is a word in common use in the trade, and the applicant is therefore not entitled to acquire any exclusive right in the said word by registration, or to obtain registration of the said alleged trade mark, except and unless he first disclaims any right to the exclusive use of the said word.
- (xxi.) The device of a [“lion”] is in common use in the _____ trade, and the applicant is therefore not entitled to obtain registration of the words [“Lion Brand”] as part of his alleged trade mark No. _____, except and unless he first disclaims any right to the exclusive use of the said words.
- (xxii.) Goods of my manufacture [or, merchandise] of the same description as the goods for which the applicant is now applying to register his alleged trade mark, are constantly ordered and sold as [“Lion”] goods, and if the applicant is allowed to obtain registration of the device of a [lion] as [or as part of] his trade mark, it will cause his goods to be passed off as and for my goods.
- (xxiii.) The alleged [as in (i.) to—relates] has such a resemblance to the opponent's registered trade mark No. _____ as to be calculated to deceive. The class of goods for the whole of which the above-mentioned applicant is now applying to register the said trade mark includes the goods in respect of which the opponent's said trade mark is registered, and the applicant is therefore not entitled to obtain registration of the said alleged trade mark except and unless the goods in respect of which registration is granted to him are so limited and defined as not to include the goods or description of goods for which the opponent's said trade mark is registered as aforesaid.
-

2. GROUNDS OF COUNTER-STATEMENT (a).

- (i.) The trade mark to which the above-mentioned application relates has been exclusively used for _____ years last past by the applicant, and is a good, valid, and registrable trade mark.
- (ii.) The trade mark [as in (i.) to—relates] consists of [or contains] an essential particular as defined by § 64 of the Patents, Designs, and Trade Marks Acts, 1883-8, viz., [a distinctive device, mark, or label], and is therefore registrable as a new trade mark.
- (iii.) The trade mark [as in (i.) to—relates] consists of a special and distinctive word used by the applicant as a trade mark before the 13th day of August, 1875, and is therefore a good and valid trade mark and is registrable as an old mark.
- (iv.) I have publicly used the trade mark [as in (i.) to—relates] in the United Kingdom for _____ years, as alleged in my above-mentioned application. Such user has not been clandestine, but has been generally known to the trade in _____; and if it has not been known to the opponent, that must have been either because he was not engaged in such trade, or else because he conducted his business negligently.
- (v.) The goods in respect of which I am applying to register my above-mentioned trade mark No. _____ are goods comprised in Class _____ of the classes under the Patents, Designs, and Trade Marks Acts, 1883-8, [as appears from the Guide to the Classification issued at the Patent Office].
- (vi.) My above-mentioned trade mark is not a mere word in ordinary use in the English language descriptive of quality, but is a special and distinctive word by which my goods are generally recognised by the trade and the public, and I am entitled to register the same.
- (vii.) My above-mentioned trade mark is not merely descriptive of the character and quality of the goods to which it is applied, but it was first adopted and has since been exclusively used by myself for the purpose of distinguishing goods of my manufacture [or merchandise], and it is generally recognised as being distinctive of such goods.
- (viii.) It is not the fact that my above-mentioned trade mark has for many years past, or at all, been in common use

(a) See Form a, p. 482, *supra*, for the formal parts of the counter-statement.

in the trade. In instances I have obtained injunctions to restrain infringements thereof, and if there has been any user by persons not so restrained it has been without my knowledge, or I should have taken proceedings against them.

- (ix.) It is not the fact that my above-mentioned trade mark is generally understood by the trade or the public to denote a particular quality of goods; on the contrary, it is generally understood to denote goods of my manufacture [or merchandise], and the trade and the public would be deceived and I should be injured if any other manufacturer were to use it.
- (x.) My above-mentioned trade mark was placed by the Manchester Committee of Experts in their 2nd class, or B. list, in consequence of a misapprehension as to the principles by which their action was to be governed, and the said mark was wrongfully so placed, and ought to be admitted to registration.
- (xi.) It is not the fact that I, or the trade, or the public, have used or understood my above-mentioned trade mark as describing articles made in accordance with my expired patent. On the contrary, I adopted it before the grant to me of the said patent, and it has always been used and understood as distinguishing goods of my make, and not goods of any particular pattern.
- (xii.) My above-mentioned trade mark is not identical with the opponent's registered mark [or Sheffield mark], nor has it such resemblance to the same as to be calculated to deceive.
- (xiii.) The goods with respect to which the opponent's trade mark [or Sheffield mark] is registered are not the same goods nor goods of the same description as the goods with respect to which I am applying for registration of my above-mentioned trade mark.
- (xiv.) The opponent's trade mark No. is not a good or valid trade mark, but was registered by mistake and wrongfully, and I am now applying for the rectification of the register by the removal therefrom of the said mark.
- (xv.) Whether the trade mark which I am now applying to register is or is not the property of the opponent in a foreign country, as to which I have no knowledge, the said trade mark has not, up to the present time been known in the United Kingdom in connection with [describe the goods], but the same is a new mark adopted for the first time by myself months since.

- (xvi.) The statements contained in my above-mentioned trade mark are true, and my said trade mark is not calculated to deceive. If any of such statements are exaggerated, such exaggerations are trifling and immaterial and not calculated to deceive.
- (xvii.) The mention of a patent contained in my above-mentioned trade mark is not such as to lead to the belief that the patent there mentioned is an existing patent, and my said trade mark is not calculated to deceive.
- (xviii.) The articles of partnership mentioned in the notice of opposition provided that the goodwill and trade marks of the partnership business should belong to the opponent only in the event of the partnership being dissolved by effluxion of time. The said partnership was dissolved at an earlier date by common consent, and the provisions of the said articles were varied in such manner that the goodwill and trade marks devolved upon the opponent and myself equally.
- (xix.) The trade mark to which my above-mentioned application relates was used by me in my business concurrently with the opponent before the 13th day of August, 1875, and is an old trade mark, and was not used by any other person in the same trade, and I am therefore entitled to registration notwithstanding the opponent's registration.
- (xx.) The opponent uses his trade mark No. only by stamping it on his goods. I only use mine by placing it on the wrappers in which the goods are placed; and the concurrent use of the two trade marks in such different ways is not calculated to deceive. I have used my trade mark for years, and am willing to undertake to use it in the future only as I have hitherto used it.
- (xxi.) The opponent uses his trade mark No. only on goods exported by him to [the Colonies and the United States]. I only use mine in [the United Kingdom]; and the concurrent user of the two trade marks in such different parts of the world cannot deceive. I am willing [as in (xx.)].
- (xxii.) The word , which forms part of my above-mentioned trade mark No. , and also of the opponent's registered mark No. , is a mere word of description, and is not an essential particular of the opponent's said registered mark, nor has he any exclusive rights therein by reason of his registration.

3. FORM OF STATUTORY DECLARATION IN SUPPORT OF APPLICATION OR OPPOSITION.

Patents, Designs, and Trade Marks Acts, 1883-8.

Trade Marks.

In the matter of an application
by _____, for the registra-
tion of a trade mark No. _____,
and

In the matter of the opposition
thereto, No. _____, by _____.

I _____ of _____, a member of the firm
of _____, the above-named applicants [or opponents],
do hereby solemnly and sincerely declare as follows:—

- 1.
- 2.
- 3.

And I make this solemn declaration conscientiously be-
lieving the same to be true, and by virtue of the provisions
of the Statutory Declarations Act, 1835.

Signed

Declared at _____ day of _____
this _____ before me, _____ (a).

4. FORM OF CASE ON APPEAL TO THE BOARD OF TRADE.

[Heading as in Form 3, but omitting the reference to the
opposition, if the appeal is from the comptroller's spontaneous
refusal.]

Case on Appeal to the Board of Trade (b).

1. [Set out the material facts of the case in numbered
2. paragraphs.
- 3.
- 4.

The appellants submit that, under the circumstances herein-
before stated, the decision of the comptroller should be
reversed, and the appellants' trade mark No. _____ above

(a) See Rule 61.

(b) To accompany Form H.

mentioned should be admitted to registration [or as the case may be] on the following grounds:—

1. Because, &c.
2. Because, &c.

[The matters with which this appeal is concerned are of great importance to the appellants, and the appellants are desirous that the same may be referred to the decision of the Court, under § 62 [or 69] of the above-mentioned Acts.]

Signed

5. SPECIAL CASE.

In the High Court of Justice,
Chancery Division.
Mr. Justice

18 . B. No. .

Between [A.B.], Plaintiff,
and
[C.D.], Defendant.

Special case stated for the opinion of the High Court of Justice, pursuant to the Patents, Designs, and Trade Marks Acts, 1883-8, and the Rules made thereunder.

1. [The facts necessary to enable the Court to determine
2. the rights of the parties must be stated concisely in
3. numbered paragraphs.]
- 4.

The questions submitted for the opinion of the Court are:

1. Whether the plaintiff *A.B.*, or the defendant *C.D.*, or either of them, is entitled to have his name entered in the register of trade marks kept under the authority of the above-mentioned Acts as the proprietor of the said trade mark, or whether both of them are so entitled.
2. By whom the costs of this special case should be paid.

E. F., Solicitor for Plaintiff.

G. H., Solicitor for Defendant.

Note.—This special case is filed by *E. F.* of _____, Solicitor for the above-named Plaintiff.

6. SUMMONS FOR LEAVE TO REGISTER.

In the High Court of Justice,
Chancery Division.
Mr. Justice

In the matter of an application by *A. B.* for
the registration of a trade mark No. ,

and

In the matter of the opposition thereto,
No. of *C. D.*,

and

In the matter of the Patents, Designs, and
Trade Marks Acts, 1883-8.

Let all parties concerned attend at the chambers of Mr. Justice , at the Royal Courts of Justice, on the , the day of , 18 at o'clock in the noon, upon the application of the above-named *A. B.*, that the Comptroller-General of Patents, Designs, and Trade Marks may be directed to proceed with the above-mentioned application of the said *A. B.* [notwithstanding the above-mentioned opposition thereto of *C. D.*] or [notwithstanding the registration of *C. D.*'s trade mark No.], or [notwithstanding the registration of *C. D.*'s trade mark No. in the Sheffield register].

Dated the day of 18 .

(Seal)

This summons was taken out by *E. F.*, of , Solicitor for the above-named *A. B.*

To the Comptroller-General of Patents, Designs, and Trade Marks, or where there is an opposition, To the above-named *C. D.*

The following note to be added to the original summons, and when the time is altered by indorsement the indorsement to be referred to as below.

Note.—If you do not attend either personally or by your solicitor at the time and place above mentioned [or, at the place above mentioned at the time mentioned in the indorsement hereon] such order will be made and proceedings taken as the judge may think just and expedient.

7. NOTICE OF MOTION FOR LEAVE TO REGISTER.

[Heading as in No. 6.]

Take notice that the Court will be moved before the Hon. Mr. Justice on the day of 18 , or so soon thereafter as counsel can be heard, by Mr. , of counsel on behalf of the above-named *A. B.*, that you [*or that the Comptroller-General of Patents, Designs, and Trade Marks*] may be directed to proceed [as in No. 6].

Dated the day of , 18 .

(Signed) *E. F.* of , Solicitor
for the above-named *A. B.*

To the Comptroller-General of Patents, Designs,
and Trade Marks, *or, if there is an opposition,*
To *Mr. C. D.*

8. NOTICE OF MOTION FOR LEAVE TO ADD TO, ALTER, A
REGISTERED TRADE MARK.

In the High Court of Justice,
Chancery Division.

Mr. Justice

In the matter of the registered trade mark
No. of *A. B.*

and

In the matter of the Patents, Designs, and
Trade Marks Acts 1883-8.

Take notice [as in No. 7 to---that] leave may be given to add to the above-mentioned trade mark in the register of trade marks [the words " ," *or, as the case may be*], *or, that leave may be given to alter the registration of the above-mentioned trade mark in the following respects, that is to say by [diminishing the size of the words and altering the address from to , or, as the case may be].*

[Dated and signed as in No. 7.]

To the Comptroller-General of Patents,
Designs, and Trade Marks.

9. NOTICE OF MOTION FOR THE RECTIFICATION OF THE REGISTER.

[Heading as in No. 8.]

Take notice [as in No. 7 to---behalf of] *C. D.* of ,
that the register of trade marks kept under the authority of

the above-mentioned Acts may be rectified [by removing therefrom the above-mentioned trade mark No.], or [by adding to the registration of the above-mentioned trade mark No. a note disclaiming any exclusive right in the above-named *A. B.* to the use of the word], or [by adding, &c., &c., a note stating that the above-named *A. B.* is only entitled to use the same in respect of goods intended for export to], or [by adding, &c., &c., entitled to use the same by placing it upon the wrappers in which the goods are sold, and not by placing it upon the goods themselves], or [by limiting the registration of the above-mentioned trade mark No. to (describe the goods), and not allowing it to remain in respect of all the goods in class], or that such further or other order may be made for the rectification of the said register as to the Court shall seem just.

[Dated and signed as in No. 7.]

To Mr. *A. B.* and the Comptroller-General of
Patents, Designs, and Trade Marks.

PART III.

FORMS FOR USE IN ACTIONS FOR
INFRINGEMENT (a).

1. WRIT OF SUMMONS, WITH INDORSEMENT.

In the High Court of Justice., 18 . B. No. .
Chancery Division.
Mr. Justice

Between *A. B.*, Plaintiff,
and
C. D., Defendant.

VICTORIA, by the Grace of God, &c.

To *C. D.*, of _____, in the county of _____
We command you that within eight days after the service of this writ on you, inclusive of the day of such service, you do cause an appearance to be entered for you in an action at the suit of *A. B.*; and take notice that in default of your so doing the plaintiff may proceed therein, and judgment may be given in your absence.

Witness, Hardinge Stanley Baron Halsbury, Lord High Chancellor of Great Britain, the _____ day of _____, in the year of our Lord one thousand eight hundred and _____.

Memorandum to be subscribed on the writ.

N.B.—This writ is to be served within twelve calendar months from the date thereof, or, if renewed, within six calendar months from the date of the last renewal, including the day of such date, and not afterwards.

The defendant [*or* defendants] may appear hereto by entering an appearance [*or* appearances] either personally or by solicitor at the Central Office, Royal Courts of Justice, London.

(a) See Schedules to Rules of Supreme Court.

Indorsement to be made on the writ before issue thereof.

The plaintiff's claim is for an injunction to restrain the defendant from [see forms of Injunction in Part IV. of this Appendix], and for an account or damages ;

or The plaintiff's claim is for damages for wrongfully using [or imitating] the plaintiff's trade mark, and for an injunction to restrain, &c.

This writ was issued by the said plaintiff, who resides at _____ ;

or, This writ was issued by *E. F.* of _____, whose address for service is _____, solicitor for the said plaintiff, who resides at _____ ;

or, This writ was issued by *G. H.* of _____, whose address for service is _____, agent for *E. F.* of _____, solicitor for the said plaintiff, who resides at _____ [mention the city, town, or parish, and also the name of the street and number of the house of the plaintiff's residence, if any.]

Indorsement to be made on the writ after service thereof.

This writ was served by me at _____ on the defendant _____ on _____ the _____ day of _____,

18 .
Indorsed the _____ day of _____ 18 .
(Signed)
(Address)

2. NOTICE OF MOTION FOR INJUNCTION.

[Heading as in No. 1.]

Take notice that the Court will be moved before the Hon. Mr. Justice _____ on _____ the _____ day of _____ 18 , or so soon thereafter as counsel can be heard, by [Mr. _____ of] counsel for the above-named plaintiff, that an injunction may be granted to restrain the defendant, &c., until judgment in this action or further order, from [see Part IV. of this Appendix] [and take also notice that special leave to serve you with this [short] notice for the day aforesaid [with the writ of summons] has been obtained from the said Mr. Justice _____].

Dated the _____ day of _____ 18 .
(Signed) *E. F.* of _____
Solicitor for the above-named Plaintiff.

To the Defendant *C. D.*

3. STATEMENT OF CLAIM.

[Heading as in No. 1, inserting above the title of the action—
“Writ issued the day of , 18 .”

Statement of Claim (a).

1. The defendant has infringed the plaintiff's trade mark.
2. The trade mark is [*describe it*].

(If the plaintiff is not the original proprietor the trade mark, show shortly how his title is derived.)

3. The following are the acts complained of, viz. :—

(Set them out.)

The plaintiff claims an injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade mark, and in particular from [*see forms of Injunction in Part IV. of this Appendix*].
The plaintiff also claims an account or damages.

(Signed)

(Delivered)

(a) The above is the form appended to the Rules of Court, 1883, but it is thought that fuller particulars will usually be required. Forms 3 (i.), 3 (ii.), and 3 (iii.) are therefore suggested.

3 (i.). [Heading as above.]

Statement of Claim.

1. The plaintiff is the registered proprietor of a trade mark [consisting of] (a), which was advertised in the “Trade Marks Journal” of the day of 18 , and is registered for in Class [the date of such registration being the day of , 18] (b).

2. The defendant has infringed the plaintiff's said trade mark in manner following; that is to say [he has].

[3. The plaintiff has applied to the defendant to desist from his wrongful acts aforesaid, but he has refused (or neglected) so to do] (c).

4. The defendant has made considerable profits by selling goods not being the plaintiff's goods under the trade mark of which the plaintiff complains [or in manner aforesaid].

5. The plaintiff has sustained considerable damage from the defendant's wrongful acts aforesaid.

The plaintiff claims—

1. An injunction [as above].

2. An account of profits or damages and delivery up to him of all goods in the possession or power of the defendant having thereon the trade mark of which complaint is hereby made in order that such trade mark may be obliterated therefrom, and also delivery up to him for the purpose of destruction of all copies in the possession or power of the defendant of the said trade mark and of all blocks, dies, or other apparatus in the like possession or power adapted for the production of the said trade mark.

3. Costs.

(a) The trade mark need not be described unless the nature of the infringement renders it necessary.

(b) The date of registration may be omitted, if not more than five years before writ issued.

(c) Though previous application is not necessary, if it has been made, it should be mentioned.

3 (ii). [Heading as above.]

Statement o Claim.

1. [As in 3 (i.), omitting the description of the plaintiff's trade mark].

2. The said trade mark consists of [or contains] the device of a [lion], and the plaintiff's goods bearing such trade mark are extensively known in the [Indian] markets as ["Lion"] goods, and are frequently ordered and invoiced under that name.

3. No other goods of the same kind are or ever have been known in the [Indian] markets as ["Lion"] goods.

4. The defendant is using on goods intended for export to the [Indian] markets a trade mark [or label, or wrapper] on which he places the device of a [lion], and such user is calculated to deceive by inducing purchasers to buy the defendant's goods in the belief that they are buying those of the plaintiff.

5. [As in 3 (i.), par. 4].

6. [As in 3 (i.), par. 5].

The plaintiff claims [as in 3 (i.). For form of injunction, see that in *Orr-Ewing & Co. Johnston & Co.*, Part IV., No. 4, *infra*].

3. (iii.), [Heading as above.]

Statement of Claim (a).

1. The plaintiff has for years last past and upwards offered for sale and sold [a preparation for the human hair] of his manufacture under the title of [Robinson's Hair Stimulant], and previously to the defendant commencing his wrongful acts hereinafter stated no other person except the plaintiff offered for sale or sold under that title any similar preparation.

2. The plaintiff offers for sale and sells and always has offered for sale and sold [his said preparation] in bottles of a peculiar and distinctive shape packed in cases which are also of a peculiar and distinctive shape; and previously to the defendant commencing his wrongful acts hereinafter stated no other person except the plaintiff used for the purposes of trade in any [preparation for the human hair] bottles or cases similar in shape to the plaintiff's bottles and cases.

3. The plaintiff has recently ascertained as the fact is that the defendant for the purpose of passing off his goods as and for the plaintiff's goods is offering for sale and selling [a preparation] not of the plaintiff's manufacture under the title of [Robinson's Hair Stimulant], and in bottles similar in shape to the plaintiff's bottles and packed in cases similar in shape to the plaintiff's cases, whereby divers persons have been induced to purchase the defendant's [preparation] as and for the goods of the plaintiff [or and such acts are calculated to induce, &c.].

4. The defendant has made considerable profits by selling his goods as and for the goods of the plaintiff.

5. [As in 3 (i.), par. 5.]

The plaintiff claims—

1. An injunction to restrain the defendant, his servants and agents, from passing or attempting to pass off the defendant's goods as or for the plaintiff's goods, and in particular from offering for sale or selling any [preparation for the human hair] not of the plaintiff's manufacture by means of the use of the title [Robinson's Hair Stimulant], and by means of the use of bottles similar in shape to the plaintiff's bottles, and by means of the use of cases similar in shape to the plaintiff's cases, or by any of such means [or as may be].

2. An account of profits or damages.

3. Costs.

(a) This is intended for a case in which no trade mark has been registered.

4. DEFENCE.

[Heading as in No. 1.]

Defence (a).

The defendant says that :—

1. The trade mark is not the plaintiff's.
2. The alleged trade mark is not a trade mark.
3. The defendant did not infringe.

(Signed)
(Delivered)

(a) The above is the form appended to the Rules of Court, 1883, but a fuller form varying with the nature of the defence will generally be required.

5. REPLY.

[Heading as in No. 1.]

Reply.

The plaintiff as to the defence says that :—

- 1.
- 2.

(Signed)
(Delivered)

6. SUMMONS TO STAY PROCEEDINGS BY CONSENT, THE DEFENDANT SUBMITTING TO AN INJUNCTION.

[Heading as in No. 1.]

Let all parties concerned attend at the chambers of Mr. Justice _____ at the Royal Courts of Justice on _____ the _____ day of _____, 18____, at _____ o'clock in the _____ noon, on the hearing of an application on the part of the above-named defendant that the defendant submitting to a perpetual injunction restraining [see forms of Injunction in Part IV. of this Appendix, *infra*] and submitting to pay the plaintiff £ _____ in respect of [damages and] his taxed costs of this action, all further proceedings in this action may be stayed, or that such further or other order may be made as to the judge shall seem just.

Dated the _____ day of _____, 18____.

This summons was taken out by G. H. of _____, Solicitor for the above-named Defendant.

To the above-named Plaintiff.

PART IV.

PRECEDENTS OF INJUNCTIONS, &c.

1. CROFT *v.* DAY, 7 Beav. 84—90.*Label on Blacking Bottles—Trade Cards—Injunction.*

INJUNCTION to restrain the defendant, his servants, &c., "from selling, or exposing for sale, or procuring to be sold, any composition or blacking described as, or purporting to be, blacking manufactured by Day and Martin, in bottles having affixed thereto such labels as in the complainant's bill mentioned, or any other labels so contrived or expressed as, by colourable imitation or otherwise, to represent the composition or blacking sold by the defendant to be the same as the composition or blacking manufactured and sold by John Weston (the manager), for the benefit of the estate of Charles Day, the testator; and from using trade cards so contrived or expressed as to represent that any composition or blacking sold or proposed to be sold by the defendant is the same as the composition or blacking manufactured or sold by John Weston" (a).

2. SEIXO *v.* PROVEZENDE, L. R. 1 Ch. 192—194.*Brand on Casks of Wine—Injunction.*

Injunction to restrain the defendants, &c., "from affixing or causing to be affixed to any casks of wine shipped to their orders the brand or marks of a crown and the word *Seixo*, or any other combination of marks or words so contrived as, by colourable imitation or otherwise, to represent the marks or brands of the plaintiff, and from employing any marks or words which shall be so contrived as to represent, or induce the belief, that such wines are Crown *Seixo*, or the produce of the *Quinta do Seixo*, or otherwise using the word *Seixo* without clearly distinguishing the same from the wine produced by the *Quinta do Seixo*" (b).

3. STEPHENS *v.* PEEL, 16 L. T. N. S. 145.*Labels on Bottles of Ink—Injunction.*

Injunction restraining the defendant, &c., "from selling, or exposing, or advertising for sale, or procuring to be sold, any ink or writing fluid

(a) Lord Langdale, M. R.

(b) Wood, V.-C.

in bottles bearing thereon such labels as after mentioned, and from using any labels, or stamps, or advertisements so contrived or expressed as by colourable imitation or otherwise to represent or lead to the belief that the ink sold by the defendant is the ink or writing fluid manufactured by the plaintiffs, and sold by them under the name of 'Stephens' Blue Black Writing Fluid' " (a).

4. ORE-EWING & Co. v. JOHNSTON & Co., 7 App. Cas. 219—233.

"Two Elephant" Yarn—Injunction.

Injunction restraining the defendants, &c., "from affixing or causing to be affixed to any Turkey red yarn not dyed by the plaintiffs the ticket marked 'B,' and from using two elephants on any ticket used on Turkey red yarn, without clearly distinguishing such ticket from the plaintiffs' ticket mentioned in the pleadings, being the exhibit marked 'A' referred to in the depositions, or so as to represent or induce the belief that any of the said yarn was dyed by the plaintiffs " (b).

5. READ BROTHERS v. RICHARDSON & Co., 45 L. T. N. S. 54—60.

"Dog's Head" Beer for Exportation—Undertaking—Injunction to the Hearing—Costs.

"The plaintiffs by their counsel undertaking to abide by any order this Court may make as to damages in case this Court shall hereafter be of opinion that the defendants have sustained any by reason of this order which the plaintiffs ought to pay, this Court doth order that the defendants, &c., be restrained from using the figure of a dog's head upon any labels, tickets, or wrappers, affixed or applied to bottles of beer or stout sold for exportation or exported by the defendants to any of the Australian Colonies or New Zealand, and from selling for exportation or exporting to any of the said colonies any bottles of beer or stout having affixed or applied thereto any such label, ticket, or wrapper, until judgment in this action or further order; and it is ordered that the plaintiffs' costs of this motion be their costs in the action " (c).

6. BROADHURST v. BARLOW, L. J. N. of C., 1872, p. 183.

Stamps on Shirtings—Injunction.

Injunction restraining the defendants, &c., "from stamping, impressing, or affixing, or causing to be stamped, impressed, or affixed on or to

(a) Wood, V.-C.

(b) House of Lords.

(c) Court of Appeal.

any Spanish shirtings or pieces of white calico manufactured or sold by them, any mark consisting of words in the Turkish, Armenian, and Greek languages, meaning 'exactly 12 yards,' and placed between a figure or crest and the words 'Spanish Shirtings' enclosed in a scroll in the same manner as those are respectively placed in the plaintiff's trade mark, or in any manner only colourably differing therefrom" (a).

7. WOTHERSPOON v. CURRIE, L. R. 5 H. L. 508—523.

"Glenfield Starch"—Injunction.

Injunction restraining the respondent, &c., "from using the word 'Glenfield' in or upon any labels affixed to packets of starch manufactured by or for him, and from in any other way representing the starch manufactured by or for him to be 'Glenfield Starch,' and from selling or causing the same to be sold as 'Glenfield Starch,' and from doing any act or thing to induce the belief that starch manufactured by or for him, the respondent, is 'Glenfield Starch,' or starch manufactured by the appellant" (b).

8. FORD v. FOSTER, L. R. 7 Ch. 611—634.

"Eureka" Shirts—Injunction.

Injunction restraining the defendants, &c., "from applying the mark or title 'Eureka' to any shirts manufactured by them, or to any shirts sold by them, unless manufactured by the plaintiffs, and from selling any shirts already marked with the mark and title 'Eureka,' unless such mark or title has been applied with the sanction of the plaintiffs; and from issuing any boxes or packages on which the mark or title of 'Eureka' shall be applied to shirts not of the plaintiff's manufacture; and from affixing or using any label, or card, or other mark containing the word 'Eureka' to or upon any shirts not of the plaintiffs' manufacture" (c).

9. APOLLINARIS CO. v. NORRISH, 33 L. T. N. S. 242.

"Apollinaris Water"—Injunction.

Injunction restraining the defendants, &c., "from selling, &c., any mineral or other waters, not being the genuine Apollinaris Water, under the name of 'Apollinaris Water,' or 'London Apollinaris Water,' or

(a) Wickens, V.-C.

(b) House of Lords.

(c) James, L. J.

under any other name of which the word 'Apollinaris' so forms part as to be calculated to deceive the public" (a).

10. CARUNCHO v. STEPHENSON, 25 SOL. J. 929.

"La Intimidad" Cigars—Injunction.

Injunction restraining the defendant, &c., "from selling or causing or allowing to be sold, and from in any manner representing, or causing or procuring to be represented, any cigars manufactured, sold, or dealt in by the defendant as 'La Intimidad' cigars, or as cigars manufactured, imported, or sold by the plaintiffs or either of them; and also from affixing, or procuring or causing or allowing to be affixed, to any boxes of cigars manufactured, or bought, or procured, or sold, or attempted to be sold by the defendant, or otherwise using, or employing, or permitting to be used or employed, any labels, wrappers, brands, or marks used by the plaintiffs or either of them, or so contrived or prepared as to represent or lead to the belief that the cigars manufactured or sold by the defendant are cigars manufactured or sold by the plaintiffs or either of them, and from using the words 'La Intimidad' on any cigars, or boxes or wrappers containing cigars, so as to induce the belief that such cigars are manufactured or imported by the plaintiffs or either of them, pending the trial of this action" (b).

11. EDELSTEN v. EDELSTEN, 1 De G. J. & S. 185—189.

"Anchor Brand Wire"—Prayer of Bill—Injunction—Account—Delivery up.

Prayer of Bill: "that an account may be taken of the gains and profits made and obtained by the defendants by the sale of wire having tallies or labels attached thereto with the plaintiff's trade mark, or a trade mark in imitation of, or only colourably differing from that of the plaintiff, stamped or impressed thereon; and that the defendants may be ordered to pay to the plaintiff the amount of such gains and profits. That the defendants may be restrained by injunction from attaching to wire, not the manufacture of the plaintiff, any tally or label with the plaintiff's trade mark,

(a) Bacon, V.-C. And see also forms of injunctions in *Apollinaris Co. v. Edwards*, Seton, 4th ed. 237; *Millington v. Fox*, 3 My. & Cr. 338; and *Pemberton*, 4th ed. 490; *Edelsten v. Vick*, 11 Hare, 78; *Collins Co. v. Walker*, 7 W. R. 222, and Seton, 4th ed. 235; *Harrison v. Taylor*, 11 Jur. N. S. 408, and *Pember-*

ton, 4th ed. 490; *Braham v. Bustard*, 1 H. & M. 447; *McAndrew v. Bassett*, 4 De G. J. & S. 380, and *Pemberton*, 3rd ed. 239; *Mickle v. Emery*, Seton, 4th ed. 234; *Siegert v. Finklter*, 7 Ch. D. 801—814; *McLean v. Fleming*, 96 U. S. Rep. 245; 13 U. S. Pat. Gaz. 913, 914.

(b) Cave, J.

or any mark in imitation thereof, or only colourably differing therefrom, stamped or impressed thereon, and from otherwise using the plaintiff's trade mark, or any mark in imitation thereof, so as to denote or represent that the said wire is the 'Anchor Brand Wire,' or is the manufacture of the plaintiff; and from selling, or offering for sale, or procuring to be sold, any wire not being of the plaintiff's manufacture, having a tally or label attached thereto with the plaintiff's trade mark, or a mark in imitation thereof, or only colourably differing therefrom, stamped or impressed thereon, or otherwise in any manner having the said trade mark, or a mark in imitation thereof, or only colourably differing therefrom, attached thereto. That the defendants may deliver up to be cancelled all tallies, labels, and papers in their possession, or in the possession of their servants or agents, having the said trade mark so in colourable imitation of the plaintiff's as hereinbefore mentioned; and also all tallies, labels, and papers in their possession, or in the possession of their servants or agents, having the plaintiff's trade mark, or any mark in imitation thereof, or only colourably differing therefrom, stamped or impressed thereon, and also all dies for stamping or impressing the same; and that the defendants may pay all the costs of the suit" (a).

12. GUINNESS *v.* ULLMER, 10 L. T. (Old Series), 127.

Engraving Blocks for Printing Forged Labels—Injunction.

Injunction restraining the defendant, &c., "from cutting, engraving, casting, or making, and from causing to be cut, engraved, cast, or made, and also from using or permitting to be used, and from selling or otherwise disposing of or parting with any blocks or plates adapted for printing labels or sheets of labels in imitation of the label furnished by Sparkes Moline to and used by the agents appointed by him for sale of the plaintiffs' stout, as in the plaintiffs' bill mentioned, or any of them, or differing only colourably therefrom. And also from selling or otherwise disposing of, and from delivering over or parting with any of such blocks or plates as are now in their possession, custody, or power, to any person other than the plaintiffs or such person as they shall appoint to receive the same" (b).

(a) Wood, V.-C., made a decree in the terms of the prayer of the bill. See 1 De G. J. & S. 196; Lord Westbury, C., affirmed the decree. As to the account, see also *Foster v. Megevan*, Pemberton, 4th ed. 492; and the full decree in *Ford v. Foster*, Seton, 4th ed. 236. As to order restraining exportation of goods with forged trade marks, see *Henderson*

v. Jorss, Seton, 4th ed. 236. As to order restraining the bringing into the market of imported goods with forged trade marks, see *Upmann v. Elkan*, L. R. 12 Eq. 140; 7 Ch. 130; *Rivero v. Norris*, Seton, 4th ed. 236; *Del Valle v. Mayer*, *ib.*; *Moct v. Pickering*, 6 Ch. D. 770-1; 8 *ib.* 372.

(b) Shadwell, V.-C. of Eng.